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ABSTRACT OF REPORTED CASES

RELATING TO

TRADE MARKS

(BETWEEN THE YEARS 1876 AND 1892 INCLUSIVE).

WITH THE STATUTES AND RULES.

BY

JAMES AUSTEN-CARTMELL, M.A.,

OF LINCOLN'S INN, BARRISTER-AT-LAW.

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TO
THE RIGHT HONOURABLE
THE LORD JUSTICE
SIR NATHANIEL LINDLEY,

THIS WORK

IS

BY PERMISSION

Most Respectfully Dedicated.

PREFACE.

IN this volume an attempt has been made to present in a convenient form the salient portions of reported Trade Mark Cases decided between the beginning of the year 1876 (in the course of which the Trade Marks Registration Act, 1875, came into operation) and the end of the year 1892. Under the heading of Trade Mark Cases have been included cases dealing with unregistered as well as registered trade marks.

In making extracts from judgments, it has in several instances been found necessary, in order that the extract may read connectedly, to slightly alter or add to the words of the judge as appearing in the report from which the extract is taken. These alterations and additions have been indicated by their being included in square brackets, thus [].

My best thanks are due to my friend RALPH GRIFFIN, Esq., the Registrar of Trade Marks, for the many valuable suggestions he has from time to time made to me during the preparation of this volume.

J. AUSTEN-CARTMELL.

6, NEW SQUARE, LINCOLN'S INN,
July, 1893.

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LIST OF ABBREVIATIONS.

A. C.	Law Reports, Appeal Cases.
B. & Ad.	Barnewall and Adolphus' Reports.
B. & C.	Barnewall and Cresswell's Reports.
C. A.	Court of Appeal.
C. D.	Chancery Division.
Ch. D. & Ch.	Law Reports, Chancery Division.
Ch. App. or L. R. Ch. App.	Law Reports, Chancery Appeals.
D. J. & S.	De Gex, Jones, & Smith.
Eq.	Law Reports, Equity.
H. L.	House of Lords.
H. L. (L. R.) or L. R. H. L.	Law Reports, House of Lords.
H. L. C.	House of Lords Cases.
L. J. Ch.	Law Journal (Chancery) Reports (New Series).
L. J. P. C.	Law Journal (Privy Council) Reports (New Series).
L. T.	Law Times Reports (New Series).
My. & Cr.	Mylne & Craig's Reports.
P. C.	Privy Council.
Q. B. D. & Q. B.	Law Reports, Queen's Bench Division.
R. P. C.	Reports of Patent, Design, and Trade Mark Cases issued by the Patent Office.
Sebastian or Seb.	Sebastian's Law of Trade Marks, 3rd Edition.
Seb. Dig.	Sebastian's Digest of Cases of Trade Marks, &c.
T. M. R.	Trade Marks Rules.
The Act of 1875	38 & 39 Vict. c. 91.
The Act of 1876	39 & 40 Vict. c. 33.
The Act of 1877	40 & 41 Vict. c. 37.
The Act of 1883	46 & 47 Vict. c. 57.
The Act of 1888	51 & 52 Vict. c. 50.
The Acts of 1883 to 1888	46 & 47 Vict. c. 57, as amended by 51 & 52 Vict. c. 50.
W. R.	Weekly Reporter.

STATUTES RELATING TO TRADE MARKS.

THE TRADE MARKS REGISTRATION ACT, 1875.

38 & 39 VICT. C. 91.

An Act to establish a Register of Trade Marks.

[13th August, 1875.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

38 & 39
VICT.
C. 91.

1. A register of trade marks as defined by this Act, and of the proprietors thereof shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by this Act until and unless such trade mark is registered in pursuance of this Act.

Registra-
tion of
trade
marks.

2. A trade mark must be registered as belonging to particular goods, or classes of goods ; and when registered shall be assigned and transmitted only in connexion with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill, but subject as aforesaid registration of a trade mark shall be deemed to be equivalent to public use of such mark.

Character-
istics of
registered
trade
mark.

3. The registration of a person as first proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of this Act as to its connexion with the goodwill of a business.

Title of
first pro-
prietor of
a trade
mark.

38 & 39
VICT.
C. 91.

Title of
proprietor
claiming
by trans-
mitted
proprietor-
ship.

Rectifica-
tion of
register.

4. Every proprietor registered in respect to a trade mark subsequently to the first registered proprietor shall, as respects his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.

5. If the name of any person who is not for the time being entitled to the exclusive use of a trade mark in accordance with this Act, or otherwise in accordance with law, is entered on the register of trade marks as a proprietor of such trade mark, or if the registrar refuses to enter on the register as proprietor of a trade mark the name of any person who is for the time being entitled to the exclusive use of such trade mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the court that the register may be rectified; and the court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the register, and may award damages to the party aggrieved.

Where each of several persons claims to be registered as proprietor of the same trade mark, the registrar may refuse to comply with the claims of any of such persons until their rights have been determined by the court, and the registrar may himself submit or require the claimants to submit in the prescribed manner their rights to the court.

The court may, in any proceeding under this section, decide any question as to whether a mark is or is not such a trade mark as is authorised to be registered under this Act, also any question relating to the right of any person who is party to such proceeding to have his name entered on the register of trade marks, or to have the name of some other person removed from such register, also any other question that it may be necessary or expedient to decide for the rectification of the register.

The court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.

Whenever any order has been made rectifying the register the court shall by its order direct that due notice of such rectification be given to the registrar.

Restric-
tions on
registry of
trade
marks.

6. The registrar shall not, without the special leave of the court, to be given in the prescribed manner, register in respect of the same goods or classes of goods a trade mark identical with one which is already registered with respect to such goods or classes of goods, and the registrar shall not register with respect to the same goods or classes of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or classes of goods as to be calculated to deceive,

It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a court of equity ; or any scandalous designs.

38 & 39
VICT.
c. 91.

7. Subject as aforesaid, a register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct ; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the registry of trade marks, and as to notices to be given by advertisement before the registration of trade marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade marks, and as to the fees to be charged for registration, and also as to the continuance of a trade mark on the register or otherwise, and as to the removal from the register of any trade mark, as to notices, and as to the persons entitled to inspect the register, and as to any proceedings to be taken to obtain the judgment or leave of the court in any matter in which the judgment or leave of the court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

Establishment of registry and general rules.

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament ; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

8. The certificate of the registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.

Certificate of registrar to be evidence.

9. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers Company"), and the marks or devices (in this Act called "Sheffield corporate marks") assigned or to

Provision as to Cutlers Company and

38 & 39
VICT.
c. 91.

Sheffield
corporate
marks.

be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows :

- (1.) Within the prescribed time and in the prescribed manner the Cutlers Company shall at their own expense deliver to the registrar under this Act copies of all Sheffield corporate marks in force at the time of such delivery :
- (2.) When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the registrar under this Act ; and such mark or device shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade mark as belonging to any goods or class of goods specified in section two of the Cutlers Company's Act of 1860, notice of such application, with a copy of such trade mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers Company ; and such trade mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice :
- (3.) Upon the assigning of any such mark or device, or the registration of any such trade mark as aforesaid, notice of the assignment or registration shall, within the prescribed time and in the prescribed manner, be given to the registrar under this Act, or to the Cutlers Company, as the case may be :
- (4.) The registrar under this Act, without the special leave of the court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the registrar as aforesaid, register a trade mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive :
- (5.) The master, wardens, searchers, and assistants of the Cutlers Company, shall not assign to any person a mark or device identical with any trade mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers Company as aforesaid or so nearly resembling the same as to be calculated to deceive :
- (6.) Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade mark under this Act, in respect of any particular goods

or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark :

38 & 39
VICT.
c. 91.

- 7.) Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.

O. For the purposes of this Act :

Defini-
tions.

A trade mark consists of one or more of the following essential particulars ; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or

A written signature or copy of a written signature of an individual or firm ; or

A distinctive device, mark, heading, label, or ticket ;

[there may be added to any one or more of the said particulars any
ers, words, or figures, or combination of letters, words, or figures ;
)

Any special and distinctive word or words or combination of figures
letters used as a trade mark before the passing of this Act may be
istered as such under this Act.

‘ Prescribed ’ means prescribed by general rules made in pursuance of
s Act ; and

‘ Court ’ means any of Her Majesty’s superior courts of law or equity
Westminster, or any court to which the jurisdiction of such courts
y be transferred, or any one or more of such courts which may be
lared to be the court for the purposes of this Act by such general
es as aforesaid ; but the provisions of this Act conferring a special
isdiction on the court as above defined shall not, excepting so far as
h jurisdiction extends, affect the jurisdiction of any court in Scotland
Ireland in causes, actions, suits, or proceedings relating to trade
rks ; and if the register requires to be rectified in consequence of any
ceedings in any such court in Scotland or Ireland, due notice of such
nirements shall be given to the registrar, and he shall rectify the
ister accordingly.

11. This Act may be cited for all purposes as the Trade Marks
gistration Act, 1875.

Short title
of Act,

THE TRADE MARKS REGISTRATION AMENDMENT ACT, 1876.

39 & 40 VICT. c. 33.

An Act for the Amendment of the Trade Marks Registration Act, 1875.
[24th July, 1876.]

39 & 40
VICT.
c. 33.

38 & 39
VICT. c. 91.

WHEREAS by the Trade Marks Registration Act, 1875, in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act :

And whereas by reason of the number of trade marks, and especially by reason of the difficulties attending the registration of trade marks in relation to textile fabrics, it has been found impossible to complete the registration of existing trade marks within the time specified by the said section ; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act :

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Amend-
ment of
s. 1 of the
principal
Act.

1. There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by that Act until and unless such trade mark is registered in pursuance of that Act, and in place thereof be it enacted that—

From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused as hereinafter is mentioned.

Saving of
marks and
devices not
capable
of being
registered
under Act.

2. When an application by any person to register as a trade mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade mark, which has been in use as a trade mark before the passing of the recited Act, has been refused, it

shall be the duty of the registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.

39 & 40
VICT.
c. 33.

3. This Act may be cited for all purposes as the Trade Marks Registration Amendment Act, 1876.

Short
title.

THE TRADE MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 VICT. c. 37.

An Act for extending the Time for the Registration of Trade Marks, in so far as relates to Trade Marks used in Textile Industries.

[6th August, 1877.]

WHEREAS by section one of the Trade Marks Registration Amendment Act, 1876, it is provided that from and after the first day of July one thousand eight hundred and seventy-seven a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the Trade Marks Registration Act, 1875 (referred to in such Amendment Act and in this Act as the principal Act), until and unless such trade mark is registered pursuant to the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in which a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused, is in the said Act thereafter mentioned :

40 & 41
VICT.
c. 37.

39 & 40
VICT. c. 33.

38 & 39
VICT. c. 91.

And whereas by reason of the difficulties attending the registration of trade marks used in the textile industries it has been found impossible to complete the registration of such trade marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid :

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

1. In so far as relates to the registration of trade marks used in the textile industries, but not further or otherwise, section one of the Trade Marks Registration Amendment Act, 1876, shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and

Extension
of time for
registra-
tion of
trade
marks
used in
textile in-
dustries.

40 & 41
VICT.
c. 37.

after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."

Definition
of "trade
marks
used in
the textile
indus-
tries."

Short title
of Act.

2. The expression in this Act "Trade marks used in the textile industries" means the trade marks relating to goods comprised in classes 23 to 35, both inclusive, of the First Schedule to the rules under the Trade Marks Registration Acts, 1875—76, dated September 1876.

3. This Act may be cited for all purposes as the "Trade Marks Registration Extension Act, 1877," and this Act and the Trade Marks Registration Amendment Act, 1876, and the Trade Marks Registration Act, 1875, may be cited together as the "Trade Marks Registration Acts, 1875—77."

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 & 47 VICT. C. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.]

46 & 47
VICT.
c. 57.

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.
PRELIMI-
NARY.

PART I.
PRELIMINARY.

Short
title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division
of Act
into parts.

2. This Act is divided into parts, as follows :—

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

Com-
mence-
ment of
Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

PART IV.

TRADE MARKS.

46 & 47
VICT.
c. 57.*Registration of Trade Marks.*

62.—(1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(2.) The application must be made in the form set forth in the First schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connexion with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court : and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned. Limit of time for proceeding with application.

64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars : Conditions of registration of trade mark.

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or
- (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or
- (c.) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2.) There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight

46 & 47
VICT.
c. 57.

hundred and seventy-five may be registered as a trade mark under this part of this Act.

Connexion
of trade
mark with
goods.

Registra-
tion of a
series of
marks.

65. A trade mark must be registered for particular goods or classes of goods.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade
marks
may be
registered
in any
colour.

Advertise-
ment of
applica-
tion.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller.

Opposition
to regis-
tration.

69.—(1.) Any person may within two months of the first advertisement of the application, give notice in duplicate at the patent office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within two months after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.

70. A trade mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

46 & 47
VICT.
c. 57.

Assign-
ment and
transmis-
sion of
trade
mark.
Conflict-
ing claims
to regis-
tration.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court.

72.—(1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

Restric-
tions on
registra-
tion.

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Further
restriction
on regis-
tration.

74.—(1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

Saving for
power to
provide for
entry on
register of
common
marks as
additions
to trade
marks.

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

(2.) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.

46 & 47
Vict.
c. 57.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

Registration equivalent to public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Register of Trade Marks.

Register of trade marks.

78. There shall be kept at the patent office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Removal of trade mark after fourteen years unless fee paid.

79.—(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen

ears the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

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(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee the comptroller may without removing such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered.

Fees.

80. There shall be paid in respect of applications and registration, and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Fees for
registration,
&c.

Sheffield Marks.

81. With respect to the master, warden, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

Registration
by
Cutlers'
Company
of Sheffield
marks.

- (1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):
- (2.) The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall

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have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875 :

- (3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :
- (4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :
- (6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day :
- (7.) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :
- (8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :

- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned : 46 & 47
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c. 57.
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court.
- (13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

PART V.

GENERAL.

Patent Office, and Proceedings thereat.

82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office. Patent
Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller

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may, in his absence, be done by or to any officer for the time being that behalf authorised by the Board of Trade.

Officers
and clerks.

83.—(1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the salaries and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of
patent
office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not
to be
entered in
registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust express implied or constructive.

Refusal
to grant
patent,
&c., in
certain
cases.

86. The comptroller may refuse to grant a patent for an invention or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of
assignments and
transmissions
in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in design, or trade mark, as the case may be, shall, subject to any right appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner in respect of any other personal property.

Inspection
of and extracts
from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed
copies

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of

from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

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c. 57.

to be received in evidence.

Rectification of registers by court.

90.—(1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

Power for comptroller to correct clerical errors.

(a.) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or

(b.) Correct any clerical error in the name style or address of the registered proprietor of a patent, design or trade mark.

(c.) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

92.—(1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alteration of registered mark.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a

Falsification of entries in registers,

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c. 57.

copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Exercise
of discre-
tionary
power by
comp-
troller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of
comp-
troller
to take
directions
of law
officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate
of comp-
troller to
be evi-
dence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applica-
tions and
notices by
post.

97.—(1.) Any application, notice, or other document authorised or required to be left made or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision
as to days
for leaving
documents
at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declara-
tion by
infant,
lunatic,
&c.

99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly correspond-

ing thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

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c. 57.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Transmis-
sion of
certified
printed
copies of
specifica-
tions, &c.

101.—(1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

Power for
Board of
Trade to
make
general
rules for
classifying
goods and regu-
lating
business of
patent
office.

- (a.) For regulating the practice of registration under this Act;
- (b.) For classifying goods for the purposes of designs and trade marks;
- (c.) For making or requiring duplicates of specifications, amendment[s], drawings, and other documents;
- (d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents;
- (e.) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents;
- (f.) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad;
- (g.) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as herein-after mentioned) be of the

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same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual
reports of
comp-
troller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

Inter-
national
arrange-
ments for
protection
of inven-
tions,
designs,
and trade
marks.

103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation

of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark :

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c. 57.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act : Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act :

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Provision
for colo-
nies and
India.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act ; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

105.—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Penalty on
falsely re-
presenting
articles
to be
patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word “ patent,” “ patented,” “ registered,” or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to

Penalty on
unauthor-
ised as-
sumption
of Royal
arms.

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believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland; Ireland; &c.

Saving for
Courts in
Scotland.

[107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

Summary
proceed-
ings in
Scotland.
Proceed-
ings for
revocation
of patent
in Scot-
land.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

109.—(1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reserva-
tion of
remedies
in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.]

General
saving for
jurisdic-
tion of
courts.

111.—(1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and the "Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall

be served on the comptroller, and he shall rectify the register accordingly.

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VICT.
c. 57.

112. This Act shall extend to the Isle of Man, and—

Isle of
Man.

- (1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts ;
- (2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court ;
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal ; Transitional Provisions ; Savings.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Repeal and
saving for
past opera-
tion of
repealed
enact-
ments, &c.

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act ;
or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114.—(1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

Former
registers to
be deemed
continued.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

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C. 57.

Saving for
existing
rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for
preroga-
tive.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General
defini-
tions.

117.—(1.) In and for the purposes of this Act, unless the context otherwise requires,—

“Person” includes a body corporate :

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England :

“Law Officer” means Her Majesty’s Attorney-General or Solicitor-General for England :

“The Treasury” means the Commissioners of Her Majesty’s Treasury :

“Comptroller” means the Comptroller General of Patents, Designs, and Trade Marks :

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act :

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as herein-after defined, are deemed to be one British possession for the purposes of this Act :

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORM F.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

You are hereby requested to register the accompanying trade mark,
*In Class — Iron in bars, sheets, and plates; in Class — Steam
engines and boilers: and in Class — Warming apparatus*, in the
name of (a) _____, who claims to be the proprietor
hereof.

Registration Fees enclosed £ _____ s.

To the Comptroller,
Patent Office, 25, Southampton Buildings, Chancery Lane, W.C.

(Signed)

(a) Here
insert
legibly the
name,
address,
and busi-
ness of the
individual
or firm.

Note.—If the trade mark has been in use before August 13, 1875, state length of
ser.

46 & 47
VICT.
c. 57.

THE THIRD SCHEDULE.

Enactments Repealed.

Section
113.

38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.

THE PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

48 & 49 VICT. C. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

48 & 49
VICT.
c. 63.

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present parliament assembled, and by the authority of the same, as follows :

Construc-
tion and
short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amend-
ment of
s. 103 of
46 & 47
Vict. c. 57.

6. In subsection one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

51 & 52 VICT. c. 50.

Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, herein-after referred to as the principal Act :

51 & 52
VICT.
c. 50.

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Amend-
ments of
46 & 47
Vict. c. 57.

3.—(1.) In subsection two of section sixty-two of the principal Act the words “the patent office in the prescribed manner” shall be substituted the words “such place and in such manner as may be prescribed.”

S. 62, as
to applica-
tion for
registra-
tion.

(2.) To the same section of the principal Act the following subsection shall be added :—

“(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.”

9. In section sixty-three of the principal Act for the words “the application shall be deemed to be abandoned” shall be substituted the words “the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

S. 63, as
to limit
of time
for pro-
ceeding
with appli-
cation.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely—

“64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :

S. 64, as
to fancy
words.

“(a.) A name of an individual or firm printed, impressed, or woven “in some particular and distinctive manner ; or

“(b.) A written signature or copy of a written signature of the “individual or firm applying for registration thereof as a “trade mark ; or

51 & 52
VICT.
c. 50.

“(c.) A distinctive device, mark, brand, heading, label, or ticket ;

“(d.) An invented word or invented words ; or

“(e.) A word or words having no reference to the character
“quality of the goods, and not being a geographical name.

“(2.) There may be added to any one or more of the essential pa
“ticulars mentioned in this section any letters, words, or figures,
“combination of letters, words, or figures, or of any of them, but th
“applicant for registration of any such additional matter must state
“his application the essential particulars of the trade mark, and mu
“disclaim in his application any right to the exclusive use of the add
“matter, and a copy of the statement and disclaimer shall be entered
“the register.

“(3.) Provided as follows :

“(i.) A person need not under this section disclaim his own name
“the foreign equivalent thereof, or his place of business, bu
“no entry of any such name shall affect the right of a
“owner of the same name to use that name or the foreig
“equivalent thereof :

“(ii.) Any special and distinctive word or words, letter, figure,
“combination of letters or figures, or of letters and figur
“used as a trade mark before the thirteenth day of Augu
“one thousand eight hundred and seventy-five, may b
“registered as a trade mark under this part of this Act.”

S. 67, as
to colours
of trade
marks.

11. In section sixty-seven of the principal Act the words “
colours ” shall be added after the word “colour” in each place whe
that word occurs.

S. 68, as
to adver-
tisement
of appli-
cations.

12. In section sixty-eight of the principal Act after the wo
comptroller shall be added the words “unless the comptroller refuse
entertain the application.”

S. 69, as
to oppo-
sition to
registra-
tion.

13.—(1.) In subsection one of section sixty-nine of the principal A
for the words “two months” shall be substituted the words “on
month or such further time, not exceeding three months, as th
comptroller may allow.”

(2.) In the same subsection the word “first” shall be omitted.

(3.) In subsection two of the same section for the words “tw
months” shall be substituted the words “one month.”

(4.) For subsections three and four of the same section the followi
subsection shall be substituted ; namely,

“(3.) If the applicant sends such counter-statement the comptroll
“shall furnish a copy thereof to the person who gave notice of oppositio
“and shall, after hearing the applicant and the opponeut, if so require
“decide whether the trade mark is to be registered, but his decisio
“shall be subject to appeal to the Board of Trade, who shall, if require

r the applicant and the opponent and the comptroller, and may
ke an order determining whether, and subject to what conditions
any), registration is to be permitted.

51 & 52
VICT.
c. 50.

4.) The Board of Trade may, however, if it appears expedient,
er the appeal to the court, and in that event the court shall have
isdiction to hear and determine the appeal, and may make such
er as aforesaid.

(5.) If the applicant abandons his application after notice of opposi-
n in pursuance of this section he shall be liable to pay to the
onent such costs in respect of the opposition as the comptroller may
ermine to be reasonable.

(6.) Where the opponent is out of the United Kingdom he shall
e the comptroller an address for service in the United Kingdom."

l. In subsection two of section seventy-two of the principal Act
ollowing words shall be added at the beginning of the subsection,
ly, "except as aforesaid," and for the words "so nearly resembling "
be substituted the words "having such resemblance to."

S. 72, as
to restric-
tions on
registra-
tion.

l. In section seventy-three of the principal Act the word
lusive" shall be omitted.

S. 75, as
to restric-
tion on
registra-
tion.

l. For subsection two of section seventy-four of the principal Act
ollowing subsection shall be substituted ; namely,

2.) The applicant for registration of any such addition must, how-
r, state in his application the essential particulars of the trade
rk, and must disclaim in his application any right to the exclusive
of the added matter, and a copy of the statement and disclaimer
ll be entered on the register.

S. 74, as
to addi-
tions to
trade
marks.

Provided that a person need not under this section disclaim his own
ne or the foreign equivalent thereof, or his place of business, but no
ry of any such name shall affect the right of any owner of the same
ne to use that name or the foreign equivalent thereof."

l. For section seventy-five of the principal Act the following section
be substituted ; namely,

Application for registration of a trade mark shall be deemed to be
ivalent to public use of the trade mark, and the date of the
lication shall for the purposes of this Act be deemed to be, and as
n the first day of January one thousand eight hundred and seventy-
to have been, the date of the registration."

S. 75, as
to effect
of regis-
tration.

l. After section seventy-seven of the principal Act the following
on shall be added and numbered 77A ; namely,

n an action for infringement of a registered trade mark the court
d judge may certify that the right to the exclusive use of the trade
k came in question, and if the court or a judge so certifies, then in

Certificate
as to ex-
clusive use
and costs
thereon.

51 & 52
Vict.
c. 50.

“any subsequent action for infringement the plaintiff in that action, c
“obtaining a final order or judgment in his favour, shall have his fu
“costs, charges, and expenses, as between solicitor and client, unless th
“court or judge trying the subsequent action certifies that he ought
“not to have the same.”

Amend-
ments of
46 & 47
Vict. c. 57.

19.—(1.) In subsection five of section seventy-nine of the principal Act, for the words “the five years” shall be substituted the words “or year.”

S. 79, as
to removal
of trade
mark from
the
register.

(2.) To the same subsection the following words shall be added namely, “unless it is shown to the satisfaction of the comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.”

S. 81, as
to Sheffield
marks.

20.—(1.) For subsection two of section eighty-one of the principal Act the following subsection shall be substituted :

“(2.) The Cutlers’ Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers’ Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers’ Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers.”

38 & 39
Vict. c. 91.

(2.) In subsections three and eight of the same section, for the words “on cutlery, edge tools, or on raw steel, or on goods made of steel, of steel and iron combined, whether with or without a cutting edge” shall be substituted the words “on metal goods.”

(3.) For subsection seven of the same section the following subsection shall be substituted :

“(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers’ Company, and to all matters relating thereto ; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers’ Company, the office of the Cutlers’ Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively ; and notice

“every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers’ Company : Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.”

51 & 52
VICT.
c. 50.

(4.) To the same section the following subsections shall be added ; namely,—

“(14.) For the purposes of this section the expression ‘metal goods’ means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

“(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the comptroller.”

21. In section eighty-seven of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

S. 87, as
to entry of
assign-
ments,
&c.

22. In section eighty-eight of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

S. 88, as
to inspec-
tion.

23. In section ninety of the principal Act, after the words “of the name of any person,” shall be added the words “or of any other particulars.”

S. 90, as
to rectifi-
cation of
register.

24. To section ninety-one of the principal Act the following sub-section shall be added ; namely,

“(d) Permit an applicant for registration of a design or trade mark
“to amend his application by omitting any particular goods
“or classes of goods in connexion with which he has desired
“the design or trade mark to be registered.”

S. 91, as
to correc-
tion of
errors.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A ; namely,—

Proceed-
ings of
Board of
Trade.

“(1.) All things required or authorised under this Act to be done by,
“to, or before the Board of Trade, may be done by, to, or
“before the President or a secretary or an assistant secretary
“of the Board.

“(2.) All documents purporting to be orders made by the Board of
“Trade and to be sealed with the seal of the Board, or to be
“signed by a secretary or assistant secretary of the Board, or
“by any person authorised in that behalf by the President of
“the Board shall be received in evidence, and shall be deemed
“to be such orders without further proof, unless the contrary
“is shown.

51 & 52
Vicr.
c. 50.

“(3.) A certificate, signed by the President of the Board of Trade,
“that any order made or act done is the order or act of the
“Board, shall be conclusive evidence of the fact so certified.”

Jurisdic-
tion of
Lanca-
shire
Palatine
Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A ; namely,—

“The Court of Chancery of the County Palatine of Lancaster shall,
“with respect to any action or other proceeding in relation to trade
“marks the registration whereof is applied for in the Manchester Office,
“have the like jurisdiction under this Act as Her Majesty’s High Court
“of Justice in England, and the expression ‘the court’ in this Act
“shall be construed and have effect accordingly.

“Provided that every decision of the Court of Chancery of the
“County Palatine of Lancaster in pursuance of this section shall be
“subject to the like appeal as decisions of that court in other cases.”

Construc-
tion of
principal
Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Com-
mence-
ment of
Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short
title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

[Ratifications exchanged at Paris, June 6, 1884.]

I.

INTERNATIONAL CONVENTION.

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries that is to say :—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Núñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalia de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic: M. Paul Challemel-Lacour,

Senator, Minister for Foreign Affairs ; M. Hérisson, Deputy, Minister of Commerce ; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala : M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Italy : M. Constantin Ressman, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c. ;

His Majesty the King of the Netherlands : the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Portugal and the Algarves : M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c. ;

The President of the Republic of Salvador : M. Torres-Cañedo, corresponding member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Servia : M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c. ;

And the Federal Council of the Swiss Confederation : M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the Protection of Industrial Property ;

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :—

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of Industrial Property.

ARTICLE II.

The subjects or citizens *or* [of] each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantage that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

ARTICLE III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

ARTICLE V.

[The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.]

ARTICLE VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognized International Exhibitions.

ARTICLE XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885 at Rome.

ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

(Signed)

(L.S.)	BEYENS.
(L.S.)	VILLENEUVE.
(L.S.)	Duc DE FERNAN-NUNEZ.
(L.S.)	P. CHALLEMEL-LACOUR.
(L.S.)	CH. HÉRISSON.
(L.S.)	CH. JAGERSCHMIDT.
(L.S.)	CRISANTO-MEDINA.
(L.S.)	RESSMAN.
(L.S.)	Baron DE ZUYLEN DE NYEVELT.
(L.S.)	JOSE DA SILVA MENDES LEAL.
(L.S.)	F. D'AZEVEDO.
(L.S.)	J.-M. TORRES-CAÏCEDO.
(L.S.)	SIMA M. MARINOVITCH.
(L.S.)	LARDY.
(L.S.)	J. WEIBEL.

II.

FINAL PROTOCOL.

ON proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows :—

1. The words “Industrial Property” are to be understood in their broadest sense ; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. [Under the word “patents” are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.]

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals,

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII., shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely :—

1st class	25 units.
2nd class	20 „
3rd class	15 „
4th class	10 „
5th class	5 „
6th class	3 „

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class	.	.	.	France, Italy.
2nd class	.	.	.	Spain.
3rd class	.	.	.	Belgium, Brazil, Portugal, Switzerland.
4th class	.	.	.	Holland.
5th class	.	.	.	Servia.
6th class	.	.	.	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralize information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement which will be distributed to all the Administrations. It will interest itself in all

matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations, or by Societies or private persons will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next conference is to be held will make preparations for the transactions of that conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed)

BEYENS.

VILLENEUVE.

Duc DE FERNAN-NUNEZ.

P. CHALLEMEL-LACOUR.

CH. HÉRISSON.

CH. JAGERSCHMIDT.

CRISANTO-MEDINA.

RESSMAN.

Baron DE ZUYLEN DE NYEVELT

JOSE DA SILVA MENDES LEAL.

F. D'AZEVEDO.

J.-M. TORRES-CAÍCEDO.

SIMA M. MARINOVITCH.

LARDY.

J. WEIBEL.

III.

ACCESSION OF HER MAJESTY'S GOVERNMENT TO THE CONVENTION
SIGNED AT PARIS MARCH 20, 1883.

THE Undersigned, Ambassador Extraordinary and Plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and formally engages, as far as regards the President of the French Republic and the other High Contracting Parties, to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

The Undersigned makes this Declaration on the part of Her Britannic Majesty with the express understanding that power is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

In witness whereof the Undersigned, duly authorized, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.

DECLARATION OF ACCEPTANCE OF ACCESSION.

HER Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by Her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which Declaration is word for word as follows:

(Here is inserted the text of No. III, in English.)

The President of the French Republic has authorized the Undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other High Contracting Parties to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the Undersigned, duly authorized, has drawn up the present Declaration of Acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

TRADE MARK CASES.

RE ADAMS' TRADE MARKS.

[February, 1892. 9 R. P. C. 174 ; 66 L. T. 610.]

Trade Mark—"Patent"—*Act of 1883, s. 92.*

MOTION for leave to strike out word "Patent" from a label registered in 1876 as an old mark.

The label in question contained the words "J. Adams' Patent Composition for Cleaning and Polishing Furniture, &c., Sheffield." The Applicants (who were the owners of the trade mark) were unable to trace any patent for the composition in question, though they believed one formerly existed.

Motion refused.

KEKEWICH, J.—I have no hesitation in saying that in all substantial terms—and I use the word "substantial" instead of "essential"—an old mark must be registered and must stand as it was used before 1875, and that to register marks on any other principle, and to attempt to alter them on any other principle, would be a departure from the whole scheme of the Acts, from 1875 downwards. The scheme of these Acts was to preserve the rights of those who had acquired trade marks before 1875 within certain limits specified in each successive Act, while at the same time much stricter rules were laid down for trade marks after that time. 9 R. P. C.
176, l. 31.

The word "Patent" means not necessarily that there is now current a patent of protection, but that the article in question is one of those articles which had the merits of utility and novelty, and therefore received the protection of the Crown by Letters Patent. It is an important item in a trade mark, and it is an important item in advertisement, which a trade mark of course is. 9 R. P. C.
176, l. 50.

His Lordship referred to Act of 1883, s. 92 (*supra*, p. 17), and said :— I think the proper conclusion from that section is, that as regards an old mark the Court must look into the whole case and not be limited to consider whether it is an essential particular or 9 R. P. C.
177, l. 11.

not. The word "Patent" may or may not be—I do not pause to consider how far it may possibly be brought within the description of the essential particulars in Section 64. We will put that aside, and consider that it is not an essential particular. Yet it is an important particular, and in the discretion of the Court I think that that alteration ought not to be made. I think it would be departing from the ancient character of the mark to say, that that which was registered as a "Patent" article should now go to the world in future registered as an article which has never been patented.

RE AINSLIE & COMPANY'S TRADE MARK.

[March, 1887. 4 R. P. C. 212.]

Trade Mark—"Persons aggrieved"—*Act of 1883, s. 90.*

Motion by Ewer Son & Chancellor (of London), wholesale dealers in wines and spirits, to expunge from the register the name "Ben Ledi" (the name of a well known Scotch mountain), which had been registered in 1886 as a new trade mark for whiskey by Ainslie & Co. (of Leith), wholesale wine and spirit merchants and whiskey blenders. The case was admitted to fall within the decision of the C. A. in *Van Duzer's Trade Mark* (*infra*, p. 334), but the Respondents contended that the Applicants were not persons aggrieved within s. 90 of Act of 1883, for this reason, that there was an agreement on the part of the Applicants not to sell under the trade mark "Ben Ledi" any whiskey except what the Applicants obtained from the Respondents, with a cross agreement on the part of the Respondents not to sell any whiskey in England except through the agency of the Applicants.

Motion granted.

4 R. P. C.
214, l. 4.

CHITTY, J.—More particularly the argument is founded on this, that the Applicants are not persons aggrieved within the 90th section; but the Applicants are persons who carry on a business in whiskey, and are therefore *primâ facie* persons aggrieved; and after having heard the facts so far as material to the point stated to me, there is no ground for displacing that *primâ facie* case. Then the argument is made to turn more particularly on this agreement. * * * I am at a loss to discover how any such agreement as this can displace the Applicants' right to have the Register of Trade Marks disencumbered of that which is not a trade mark at all.

AMERICAN TOBACCO COMPANY v. GUEST.

[February, 1892. 9 R. P. C. 218; (1892) 1 Ch. 630; 61 L. J. Ch. 242;
66 L. T. 257; 40 W. R. 364.]

Trade Mark—Innocent Infringer—Costs.

Motion in action to restrain infringement.

In *January*, 1892, the Defendants (wine and cigar merchants) purchased 500 cigarettes worth 17s. 6d. under a mark which was an infringement of the Plaintiffs' trade mark for cigarettes, believing them to be (though they were not so in fact) of the Plaintiffs' manufacture.

The Plaintiffs without giving the Defendants notice issued a writ and served notice of motion for an injunction to restrain infringement.

The Defendants in an affidavit sworn on the day before that for which notice of motion was given, stated they were willing to abide by any order of the Court, and submitted they ought not to pay the costs. The Plaintiffs were not ready to bring on their motion on the day for which notice was given, and brought it on the following motion day.

The Judge refused to order the Defendants to pay the costs.

STIRLING, J.—I confess I think this is not a sort of action that ought to be encouraged. If persons find a trade mark is being pirated, surely it is not the small retailers who ought to be punished. An endeavour ought surely to be made to prosecute those who set these things upon the market; and although I agree that an injunction ought to go and that it is the right of the Plaintiffs to obtain their injunction, yet I cannot think it is the duty of the Court in every case in which a small retail dealer who has innocently (and I think that the Defendants in this case have acted innocently) happened to purchase a small quantity of the spurious goods, to fix him with the costs of an action. There is no authority to that effect, and, on the contrary, I should be disposed to follow the judgment, with which I entirely agree, in *Upmann v. Forester*. (His Lordship referred to the decision in *Upmann v. Forester* (*infra*, p. 331), and proceeded:—) In that case there being that large amount of goods, CHITTY, J., made an order for payment of the costs. Here there are only 500 cigarettes, valued at 17s. 6d., and I think that under those circumstances I am justified in excepting, as I think CHITTY, J., would have excepted, this case from the operation of the rule which he laid down in *Upmann v. Forester*, by saying that there ought to be no costs.

9 R. P. C.
220, l. 35.

9 R. P. C.
220, l. 51.

RE ANDERSON'S TRADE MARK.

[C. A., August, 1885. 54 L. J. Ch. 1084.]

Trade Mark—Registration—Words “Publici Juris”—Act of 1875, ss. 6 and 10.

Summons by the Liebig's Extract of Meat Company Limited, that the Registrar might be directed to refuse an application by R. W. Anderson to register as a new trade mark under the Act of 1875, in reference to “Extract of Meat,” a device consisting of a portrait of Baron Liebig, with the word “Brand” above and the words “Baron Liebig” below the portrait. “Extract of Meat” (which was invented by Baron Liebig) was a product that any one in the trade could sell under the title of “Liebig's Extract of Meat,” which was *publici juris* (*Liebig's Extract of Meat Company v. Hanbury*, 17 L. T. 298). Chitty, J., directed the Registrar to refuse the application (26 Ch. D. 409). Appeal to the C. A. (Lord Esher M.R., Bowen, and Fry, LJJ.)

Appeal dismissed.

54 L. J.
Ch. 1085.

LORD ESHER, M.R.—That phrase [Liebig's Extract] cannot be a distinctive mark; and it has been held [55 L. T. 206] that the word “Baron” if added to the words “Liebig's Extract” makes no difference. Does then the addition of the picture alter the case? I think that it does not, for the picture is really the same as the words. The picture does not add anything, and it is open to any one engaged in this trade to use it. Nor does the use of the word “Brand” above the picture alter the case, for it is open to any one engaged in this trade to use that word; and it would be unfair to the trade to allow one person to say that he is the only person entitled to use that word. This mark, therefore, is not a distinctive device, mark or label within the meaning of 38 & 39 Vict. c. 91; and this appeal must be dismissed. It has been said that the Company which objects to the registration has done the very thing which it now objects to in the case of R. W. Anderson; but even if that be so, still it affords no reason why this Court should direct the Registrar to register such a device as this.

BOWEN, L.J.—The only question which I desire to discuss is whether this device is a distinctive device or label within 38 & 39 Vict. c. 91; and it appears to me that this device cannot be registered under that Act, as it is but the simple description of an article which everyone in the trade may sell. A description may be in words or by a picture. Baron Liebig's extract of meat is *publici juris*—all persons are entitled to make it and sell it. The

picture is identified as that of Baron Liebig, so that the words and the picture only describe the same thing, and as this device is merely the description of a common article which everybody may sell, I am of opinion that the objection is valid, and that this appeal must fail.

FRY, L.J.—I am of the same opinion. * * *

Although it is not necessary to decide the point, I desire to add that it has been admitted that this device was never used before the application was made to register it as a trade mark; and in order that it may not be supposed that in such case such a device can be registered, I would say that it is not clear that in the circumstances such as these, such a device can be registered as a trade mark.

ANDERSON v. LIEBIG'S EXTRACT OF MEAT COMPANY, LIMITED.

[November, 1881. 45 L. T. 757.]

Trade Mark—Slander of Title—Interlocutory Injunction.

Motion :

In August, 1881, the Plaintiff commenced business as a vendor of "Liebig's Extract of Meat," in connection with which he used a trade mark claimed by the Defendant Company. The Defendant Company thereupon sent circulars to the Plaintiff's clients stating that the Plaintiff was not authorized to use the trade mark in question and threatening legal proceedings; and they also commenced actions against the Plaintiff, and various of his clients, but did not move in any of these actions for an interlocutory injunction.

The Plaintiff, having commenced an action against the Defendant Company to restrain the issue of the circulars, moved for an injunction.

Motion refused.

CHITTY, J.—Now, there are two points raised. The first question is, whether the Defendants are or are not acting *bond fide* in writing such letters as the one I have read. So far as I can see at the present moment, the proceedings of the Defendants are entirely *bond fide*, and I think there is no case made on this interlocutory application on which I can interfere on the ground that the proceedings of the Defendants are malicious. The next point is this: it is said, and rightly said, that, according to the judgment in *Halsey v. Brotherhood* (45 L. T. 640), the Court will interfere by injunction where statements are made with

45 L. T.
758.

reference to the infringement of a patent, or the invasion of a trade mark and the like, if it is proved to the satisfaction of the Court that those statements are untrue.

45 L. T.
759.

I am of opinion, as the case now stands, that there is no proof on the part of the Plaintiff, who is moving, that these statements are untrue. * * The *bona fides* [of the Defendants] is shewn by this, that a complaint is made against the present Plaintiff on the 4th Oct.; that they issued their writ against him on the 31st, and since then they have issued several writs, not against the smaller men engaged in a business of this kind, but against the larger men; and they seem to me to be prosecuting those actions with due diligence. I dissent entirely from the proposition that the Plaintiff in this case is entitled to an injunction solely upon the ground that the Defendants have not thought fit to move for an injunction in their action [against the Plaintiff.]

ANGLO-SWISS CONDENSED MILK COMPANY v. METCALF.

[January, 1886. 3 R. P. C. 28 ; 31 Ch. D. 454 ; 55 L. J. Ch. 463 ;
34 W. R. 345.]

Trade Mark—Infringement—Fraud—Rectification—Act of 1875.

Motion in action to restrain infringement and motion to rectify. The Plaintiffs, who had since 1867 manufactured and sold condensed milk, registered in 1877 a new trade mark for "condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee," consisting of the figure of a woman obviously intended for a milk-maid or dairy-maid. The use by the Plaintiffs of this trade mark led the public to inquire for and order the Plaintiffs' condensed milk under the name of the Dairy-maid milk or the Dairy-maid Swiss milk. In 1883 the Defendant, with full knowledge of all the facts above stated, registered for "butterine and other fatty substances used as food or ingredients for food," a trade mark consisting of a half length stencil figure of a woman with the words "Dairy-maid." The figure did not resemble the figure in the Plaintiffs' trade mark. The Defendant did not at first but did ultimately use this trade mark for condensed milk.

An interlocutory injunction was granted on the motion in the action, and on the motion to rectify an order was made confining the Defendant's registration to goods other than condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee.

3 R. P. C.
30, l. 29.

KAY, J.—It is quite true neither the words Milk maid nor Dairy maid are any part of the Plaintiffs' trade mark. These

words Milk maid and Dairy maid, were names which the public, looking at the trade mark, affixed to this particular kind of milk.

* * * The Defendant does not in any of his affidavits deny that, at the time when he registered the trade mark which I am going to refer to next, he was aware that this Swiss condensed milk, of which the sale is enormous, as is proved, was being sold and enquired for under the name of the Dairy maid milk or the Dairy maid brand. He does not deny that, and therefore I must take it that he, a tradesman in a similar kind of business, was perfectly well aware of that fact.

His lordship then stated the facts as to the Defendant's trade mark and the use of it upon tins of condensed milk and continued :—

It is very likely that a tradesman who buys the Defendant's tins of milk to sell again may know perfectly well the distinction between them and the Plaintiffs', but are they or are they not calculated to deceive people who know the Plaintiffs' condensed milk by the terms "*Milk-maid*" or "*Dairy-maid*" brand, and who go to retail shops and enquire for it in that way? I have not the faintest doubt about it. It is not only calculated to deceive, but there seems to me to be no reason whatever why the Defendant should have done that which he has done except with the design and intention of committing a direct fraud upon the Plaintiffs, and to enable him to acquire some of their custom and to pass off his goods as and for those of the Plaintiffs. To my mind the evidence proves that there was a direct intention to commit a fraud.

31 Ch. D.
458; 3
R. P. C.
31, l. 59.

THE APOLLINARIS COMPANY v. HERRFELDT.

[C. A., October, 1887. 4 R. P. C. 478.]

Trade Mark—Infringement—Five Years' Registration—Act of 1875, s. 3.

Motion in action to restrain infringement.

In *February*, 1876, the *Apollinaris Company* registered as a trade mark (for their well known mineral water) the word "*Apollinaris*," but long before 1876 "*Apollinaris Water*" had acquired a great reputation in England. In *April*, 1876, the owners of a certain spring in the Kronthal in the Taunus Mountain, which had been formerly known as the Salzquelle, re-named the spring "*The Apollinis Spring*," and after a time commenced to sell in England the water from it with a label which, though quite distinct from the *Apollinaris Company's* label, contained in prominent type

twice repeated the statement that the water came from the Kronthal Apollinis Spring.

Injunction granted.

4 R. P. C.
481, l. 15

CHITTY, J. dealing with the evidence said :—The Plaintiffs give evidence which is not conclusive evidence for the trial, but they give evidence of that class which is always admitted on motion and by way of challenge to the other side to the effect that the term “Apollinis” was adopted in the year 1876, when the term “Apollinaris” was well known in the market with reference to the Plaintiffs’ water, for the purpose of deception ; and strange to say, though the owners of the spring which supplies the water sold by the Defendants in this country have come forward on behalf of their agents and made affidavits, there are no affidavits by the owners giving any explanation whatever of that change of name.

4 R. P. C.
482, l. 14.

As it at present stands, the admissible evidence on the part of the Plaintiffs—admissible on a motion by way of challenge, though not sufficient for the purposes of the trial—induces me to hold, as I do hold, that the change of name was made with a view to obtain the benefit of the Plaintiffs’ trade.

Appeal to the C. A. (Cotton, Lindley and Lopes, LJJ.).

The Defendants contended that the word “Apollinaris” could not be registered. They also relied on the judgment of the German Court, which had refused an injunction on a similar application of the Plaintiffs in Germany.

Appeal dismissed.

4 R. P. C.
483, l. 39.

COTTON, L.J.—In my opinion if a Defendant desires to avail himself of that defence and to show that the trade mark, though on the register, ought not to have been there, and could not properly have been registered as a trade mark, he ought to raise that point by a motion to take the mark off the register, and that has been so decided, although [the Defendants’ Counsel] thought it had not been. * * * If he does so [move], and if [the mark] is taken off the register, of course the Plaintiff loses his trade mark ; but if it has been on the register for more than five years, in my opinion, in the absence of such a motion a Plaintiff, having his trade mark on the register, is entitled to ask the Court to protect him in the enjoyment of that trade mark. That is the substance of the Act, which provides that after five years it shall be sufficient evidence of his title to the mark as a trade mark.

4 R. P. C.
487, l. 10.

LINDLEY, L.J.—Then it is said, “Well, but in Germany the Plaintiffs have no such right.” I do not know anything at all

about the German law relating to trade marks, but as to the exclusive use of the word "Apollinaris" the Plaintiffs' right here is a right given to the Company by the English Statute relating to the registration of trade marks, and what we have to consider is the English title or the title by the English law to the use of that name.

Their Lordships directed that the form of the injunction awarded should be as follows:—"That the Defendants, Messrs. *Herrfeldt & Campbell*, their servants, agents, and workmen, be restrained until judgment in this action or further order from using the word "Apollinis" or any other word only colourably differing from the word "Apollinaris" upon any labels or corks used by them in the course of their trade in any mineral water, and also from offering for sale or selling or otherwise disposing of any mineral water in bottles bearing the word "Apollinis."

4 R. P. C.
488, l. 31.

RE THE APOLLINARIS COMPANY'S TRADE MARKS.

[C. A., December, 1890. 8 R. P. C. 137; (1891) 2 Ch. 186; 65 L. T. 6.]

Trade Mark—Persons Aggrieved—Disclaimer—Word "Trade Mark"—Act of 1875, ss. 5 & 10—Act of 1883, s. 90.

Motions by a company called in this abstract "*The Vichy Company*" to expunge the following trade marks registered by the *Apollinaris Company*:—

(i.) Nos. 9026, 6356, and 6357, registered in connection with "Hunyadi Janos Water." (ii.) Nos. 2076, 4122, registered in connection with "Apollinaris Water." (iii.) Nos. 45096, 45097, and 48933, registered in connection with "Friedrichshall Water."

(i.) No. 9026 consisted of the words "Hunyadi Janos," and was registered as an old mark in 1876.

Nos. 6356 and 6357 were registered in 1876 as new marks. These marks consisted of labels on which were printed a picture of General Hunyadi Janos, and certain letter press stating that amongst other things the water came from the Hunyadi Janos Spring, of which one *Saxlehner* was the proprietor. The facts are fully stated by Fry, L.J. who delivered the judgment of the Court (Lindley, Bowen and Fry, LJJ.).

Fry, L.J.—With regard to this application two questions arise. The first is, whether the Applicants, the *Vichy Company*, are persons aggrieved within the meaning of the 5th section of the Statute of 1875, which governs the law with regard to these trade marks; and, if it be found that they are persons aggrieved, the second

8 R. P. C.
159, l. 14.

question arises, namely, whether the marks ought to be removed from the register. The facts which are relevant to the first question, as we find them, are shortly as follows—that this spring was the property of a certain Mr. *Saxlehner*, and that before the year 1876 sales were made to a large extent by *Saxlehner* to various persons, including, amongst others, the firm of *Ingram & Royle*, who were the predecessors in business of the *Vichy Company*. On the 14th of *February*, 1876, a contract was entered into between *Saxlehner* and the *Apollinaris Company*, by which the sole right of selling the water in England and elsewhere, except on the Continent of Europe, was granted to the *Apollinaris Company* for ten years, and *Saxlehner* undertook to refuse to execute orders for England. The period of that contract was subsequently extended to the year 1900. After the contract had been entered into, *Ingram & Royle* continued to deal in the Hunyadi Janos waters, purchasing them from the *Apollinaris Company*. In *June* and *September* of 1876, and, therefore, shortly after entering into this contract for the supply of the waters to the *Apollinaris Company*, the three marks in question were registered in England by that company. In the year 1885, *Ingram & Royle* sold their business to the *Vichy Company*, and about the same time, or shortly afterwards, the *Apollinaris Company* refused to supply the *Vichy Company* or *Ingram & Royle* with the waters in which that firm had previously dealt. Thereupon, *Ingram & Royle* obtained some cases of the water from English dealers, but that course of business was stopped by the intervention of the *Apollinaris Company*, relying upon their trade marks, and by their requiring as a condition of their sale of the water to dealers in it, that they would enter into an undertaking not to sell this water to *Ingram & Royle*. Further than that, it appears that certain small parcels of water reached England. * *

With regard to an article known as “Artificial Hunyadi Janos,” that is to say, an artificial water made in imitation of the natural Hunyadi Janos, and the lozenges which were made from the salts of the water, it appears that there was a manufacture and sale in this country. That manufacture and sale were not very large, but those again were stopped by the intervention of the *Apollinaris Company*, and we have evidence, at least in two cases, of that having occurred—the cases of *Condy* and *Struve*. We find, further, that the dealing in the natural and artificial Hunyadi Janos waters was within the business of the *Vichy Company*, who were general dealers in natural and artificial waters,

and that as a fact the *Vichy Company* did desire to deal in England certainly in the natural Hunyadi Janos waters. From the actual evidence of small parcels of this water being brought into this country, till stopped by the *Apollinaris Company*, and from the general course of trade, we conclude that there was a possibility of getting the water in small quantities and that that supply might, and very probably would, have increased if it had not been checked and stopped by the *Apollinaris Company* by threats of actions based on the trade marks. There was, in short, a runlet which, unimpeded, might have grown into an important stream. On any bottles which the *Vichy Company* might have obtained in this way they would, in our opinion, have been entitled to use the labels which signified that the bottles contained Hunyadi Janos water, and that they had come from Mr. *Saxlehner's* spring. But the registration of the trade mark, registered in the name of the *Apollinaris Company*, would have prevented them from exercising this right. Are the *Vichy Company* persons aggrieved? Now we approach this question on the assumption, which is necessary of course to answer this question, that the trade mark was wrongly on the register, and further, with these two observations: in the first place, that the question is merely one of *locus standi*; and in the second, that the words "person aggrieved" appear to us to have been introduced into the Statute to prevent the action of common informers or of persons interfering from merely sentimental notions, but that they must not be so read as to make evidence of great and serious damage a condition precedent to the right to apply. Further, we are of opinion that whenever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes or, with reasonable probability will in the future exclude a rival from a portion of that trade into which he desires to enter, that rival is an "aggrieved person." Again, if the effect produced, or likely to be produced, by the wrongful trade mark, is not the exclusion, but the hampering of a rival trader, that rival trader, again, is in our opinion, a person aggrieved. A man in the same trade as the one who has wrongfully registered a trade mark and who desires to deal in the article in question is *prima facie* an "aggrieved person." This may be rebutted by showing that, by reason of some circumstances entirely independent of the trade mark, the person complaining never could carry on any trade in the article; but the burden of tendering such proof is on the man who claims the mark, and here

that burden has not been discharged. It is impossible to say how much of the difficulty under which the Appellants have laboured has been due to the trade mark, and how much to other circumstances. We therefore conclude that the *Vichy Company* are aggrieved persons.

Now, with regard to the merits of the three trade marks, it is obvious that they must be treated separately. As to mark 9026, that case is abandoned on its merits by the Respondents, and therefore that mark fails. As to the next two marks, 6356 and 6357, they may be taken together, because the same considerations apply to the two. * * These labels, we conclude, and it is not, in fact, in dispute, were *Saxlehner's*, and according to the contention of the *Apollinaris Company* were registered by them with *Saxlehner's* authority. * * If *Saxlehner* did give his consent to this registration, that did not, in our opinion, justify putting his mark on the register. In the first place, the label must be a distinctive label under section 10 of the Statute of 1875 ; that is, a label distinguishing the goods of the person claiming it from all others, whereas, in fact, this mark did not distinguish the bottles sold by the *Apollinaris Company* from any others of *Saxlehner's*, but, on the contrary, represented them as *Saxlehner's* bottles. That appears on the face of the mark. And again, the *Apollinaris Company* were not persons entitled to the exclusive use of it, either under the Statute or otherwise at law. They had not used it, and so had no right at law. A person who puts another's trade mark on the register cannot be a person entitled under the Act. We are not concerned here with a case in which an importer may use the mark of a manufacturer with an addition indicative of the goods having been imported by him, but the mark of a manufacturer pure and simple cannot rightly be assumed by an importer from that manufacturer, or by a person who buys from that manufacturer, unless indeed where all the goods of the manufacturer go to that importer or that dealer. If they did not, other goods of the manufacturer might reach the hands of other dealers, who might justly affix to them the manufacturer's mark. Now, for this purpose, the owner of a natural source of an article which nature manufactures is in the same position as a manufacturer by the hands of his workpeople. If *Saxlehner's* assent would justify the registration, it would follow that a manufacturer in Paris using a trade mark well known in England could allow A. to register it as his trade mark, and thereby prevent B. and C., who bought from the Paris maker, from selling in England.

Marks expunged.

(ii.) No. 2076 was registered in 1876 as an old mark, and consisted of the word "Apollinaris." No. 4122 was also registered in 1876 as an old mark, and consisted of "Apollinaris Brunnen" between two concentric circles and an anchor in the inner circle. The facts are fully stated in Fry, L.J.'s judgment.

FRY, L.J.—With regard to these two marks, again the same classes of questions arise, and the first question is, "Are the *Vichy Company* aggrieved persons?" The facts which are relevant to this inquiry are shortly these. The Apollinaris spring is one which has been long known, and the water has been in the market for many years. In the year 1852 a certain Mr. *Kreuzberg* was the owner of it, and in the year 1873 he contracted with the *Apollinaris Company* to supply them with this water, and granted to them the exclusive sale in Great Britain. In the same year he died, and his representative sold his interest in the spring to the *Actien Gesellschaft*, a joint stock company in Germany, and in the year 1876 the registration took place of the two marks which are now in controversy. In the year 1881, that is four or five years after the registration, another contract was entered into between the *Apollinaris Company* and the *Actien Gesellschaft*, under which the *Apollinaris Company* obtained the right to all the waters produced by the spring for a period of fifty years, determinable on certain contingencies, and in 1885, as we already know, the *Vichy Company* bought *Ingram & Royle's* trade, and again, in the same year, as in the case of the Hunyadi Janos waters, shortly after that event the *Apollinaris Company* refused to supply the *Vichy Company* with these waters. Now, as regards the question of rival trading, the case stands differently from that of the Hunyadi Janos; for here all the water from the spring comes into the hands of the *Apollinaris Company*, and it may be that they could not object to the use, by any person purchasing this water, of the marks in question. In this case the importer has become the master of the whole produce, and it seems to us, therefore, doubtful whether the *Vichy Company* were aggrieved after the monopoly contract of 1881; but in the interval between the year 1876, when the mark was registered, and the year 1881, when that contract was entered into, they appear to us to have been aggrieved as rival traders.* * In our judgment, the *Vichy Company* have a real head of grievance and are aggrieved persons for this reason. On the 4th of *April*, 1885, the *Apollinaris Company* applied to register three marks for "mineral and aerated waters," which are the marks numbered 44,218, 44,219 and 44,220. They

8 R. P. C.
161, l. 36.

are what have been known in the course of this discussion as the "Malay Marks." That application was opposed by the *Vichy Company*, and in March of the following year, in answer to that opposition, Mr. Prince, on behalf of the *Apollinaris Company*, swore an affidavit and set out the two marks now in question, 2076 and 4122, and swore that the *Apollinaris Company* were entitled to the exclusive use of these marks. In other words, the *Apollinaris Company* alleged that they were the owners of these marks, and asked the Court thence to infer that they had a right to have other marks registered, to which the *Vichy Company* objected. On this ground the *Vichy Company* say that they are aggrieved. To which the *Apollinaris Company* reply: "Our contention was idle, and that it did not follow because we had these marks, therefore, we were entitled to the others," and they have urged that a bad argument is an injury to no one. In our opinion, when one trader uses the fact of registration as any part of his case against another trader in any legal proceedings, that second trader is aggrieved, and this is not the less so because that trader may have other means of defending himself. If the owner of the registered trade mark says to a defendant in a litigation: "I am the owner of this registered trade mark, and therefore you are doing me a wrong," the person attacked ought to be at liberty to reply two things: first, "You ought not to be on the register," and, secondly, "Even if you ought, I have done you no wrong." The completeness of the second line of defence ought not to preclude the attacked person from availing himself of the first. If I am assailed with the conclusion of a syllogism I am at liberty, both in logic and in law, to defend myself by denying both or either of the two propositions which are alleged in support of the conclusion, and I am aggrieved if I am unjustly deprived of that right. This liberty of defence is a matter of great importance to a litigant. Suppose a person be sued for an infringement of the trade mark 2076, he will have a short and immediate answer to the action if he can attack the trade mark, for it is admitted that the registration cannot be justified on the merits. The inquiry whether, if the registration stands, he has infringed the mark might be a long and expensive one, to which, in our opinion, he ought not to be driven, even though he may be able to succeed upon it. The practical conclusion of this view is, we think, a sound one. It will stop the practice of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means

to intimidate or coerce other traders, and then at the Bar alleging that the threat was idle and that the persons against whom it was used were not aggrieved thereby. For these reasons we conclude that the *Vichy Company* are "aggrieved persons" within the meaning of the Act. We come then to discuss the merits. With regard to No. 2076, * * it has been abandoned on the merits by the Respondents. With regard to the mark 4122, * * that mark has been used in several ways by *Kreuzberg* and the *Actien Gesellschaft*, who are his successors, from the year 1868 to 1876. It has been used on the corks alone, it has been used on stone bottles with the name and address of *Kreuzberg*, and it appears to have been used in other ways—on glass bottles, capsules, and a certain pamphlet in a way that it is not necessary to describe further with exactitude. To this mark numerous objections have been urged. One objection is based upon the allegation, made by the *Apollinaris Company* when they applied to register, that it had been used two years before the 21st of March, 1876, whereas in fact it never was used by the *Apollinaris Company*, but was used by *Kreuzberg*. At the date of the registration the *Apollinaris Company* had no monopoly of the spring and no right to prevent any person who purchased from *Kreuzberg* or the *Actien Gesellschaft* from using *Kreuzberg's* trade marks. If the registration had been by *Kreuzberg* it would have been right, but the registration by the importer from *Kreuzberg* was wrong. Again, if the mark registered had been one which indicated the importer it might have been maintained, but an importer has no right to appropriate to himself a mark which, as in this case, both by user and express statement on its face, asserts itself to be a mark of the producer or of the owner of the place of origin, because at the time of the registration the mark was an old one, and of course could not be registered as a new one; it was an old one of *Kreuzberg's* and therefore could not be registered as an old one of the *Apollinaris Company*. It was the mark of the producer, and could not be registered as the trade mark of the importer, who had no right to the whole produce of the spring. The case, in our opinion, therefore comes within the fifth section of the Act of 1875, and we find that the *Apollinaris Company* were not at the time of registration entitled to the exclusive use of the mark. * * On behalf of the *Apollinaris Company* an argument was addressed to us to this effect, that as they had in the year 1881 become the sole owners of the produce of the spring, they could now get these marks on the register, and that we ought not to

remove marks which as soon as we have taken off, can be put on again. But even assuming that the Respondents are *prima facie* entitled now to be placed on the register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the Applicant for registration. For the reasons which I have given, we, therefore, allow the appeal with regard to these two trade marks, and make an order for the rectification, with costs to be paid by the Respondents.

(iii.) No. 45,096 was registered in 1885 as a new mark and consisted of a label on which was printed (together with a great deal of other letter press) "Friedrichshall" in large letters with a scarlet disc marked with the words "Trade Mark" underneath. No. 45,097 was registered in 1885 as an old mark, and consisted of the word "Friedrichshall." No. 48,933 was registered in 1885 as a new mark and consisted of a large "F" in old German form transfixed by an arrow. The facts are fully stated in Fry, L.J.'s judgment.

8 R. P. C.
163, l. 49.

FRY, L.J.—Now, again, the first question is whether the *Vichy Company* are aggrieved persons. The language of the two statutes, those of 1875 and 1883, appears to us to be entirely the same upon this question, and therefore the question really is the same under the two statutes. The short facts which are necessary to be stated with regard to this part of the case are these, that in the year 1763 this spring was discovered, and that during the whole period now in question a certain Mr. *Oppel* was the owner of the spring, and a firm of *Charles Oppel & Co.* worked it; that the water had been known in the market for years, it had been largely dealt in by *Ingram & Royle*, who are the predecessors in title of the *Vichy Company*, and that there were artificial Friedrichshall waters and Friedrichshall salts, both known in the market, though not to any very large extent. Then, as I have already mentioned, in the year 1885 the *Vichy Company* purchased *Ingram & Royle's* business, and on the 9th of May of that year *Oppel* entered into a contract with the *Apollinaris Company*, which gave to them the exclusive right, in Great Britain and elsewhere, of purchasing and dealing in this water so far as that right could be given by *Oppel*. In pursuance of, and to give effect to that contract, the practice seems to have been adopted by *Oppel* of placing upon the bottles which were sold, either here or on the continent, a notice

prohibiting so far as he could, the export of the water from the continent. Then, down to the year 1885, the *Vichy Company* had bought from *Oppel* direct. In that year the sale was stopped, except as to purchases abroad of bottles which were used abroad by the *Vichy Company*, and except that up to the year 1885 the *Vichy Company* bought from the stocks of the holders in England and resold in England to some extent; and it is also evident there had been a certain sale of artificial Friedrichshall water. Now the cases of the *Apollinaris Company v. Snook*, and the *Apollinaris Company v. Herrfeldt*, show the way in which the presence of these marks was used by the *Apollinaris Company* to hamper the trade in these waters; and without going further over that ground, we conclude in this case the *Vichy Company* were aggrieved as rival traders. But, further than that, there are facts which give rise in our opinion to a similar ground of grievance to that which we have already mentioned in the case of the *Apollinaris* water, for, in an application to register a trade mark relating to the Friedrichshall salts, the *Vichy Company* were Opponents, and they were again met by the *Apollinaris Company* setting up the two marks 45,096 and 45,097, and in an application for another label as to waters, which was opposed by the *Vichy Company*, they were again met by the *Apollinaris Company* setting up the third mark 48,933 against them as part of their title. On both those grounds therefore we hold that the *Vichy Company* are aggrieved persons.

I then come to the merits. With regard to No. 45,097, it is admitted the mark cannot remain on; and I cannot help observing that it is the third of the marks we are dealing with in these applications the registration of which, it is admitted, is so wrong on the merits as to be incapable of being argued. With regard to the mark 45,096, several objections were raised by the *Attorney-General*. One was that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is "trade mark"—not saying *a* trade mark, not saying part of *the* trade mark—but an assertion pointing to the conclusion that it, and it alone, is *the* trade mark, and therefore, that the label, as a whole, is not the trade mark. Such would have been the impression produced (I am speaking for myself) on my own mind had I approached the reading of that label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a

registered trade mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark. With regard to this point it was contended before us that our conclusion is inconsistent with the decision in *Hudson's Case* (*infra*, p. 168), where undoubtedly the point, or a similar point, might have been raised. * * But the point, though probably open, was not really in controversy and not really raised. The fact of the arm and dolly being described on the label as "trade mark" was referred to in the judgment, but only in connection with the main argument, which turned on the use of the words "Carbolic Acid Soap Powder." We do not feel, therefore, that there is anything in that decision which binds us in the present case. As my brother, Lord Justice BOWEN, reminds me, the very absence of argument—learned counsel in that case not arguing that point in fact—prevented our deciding it, and it might be an indication of their view that in that case the words "trade mark" would not be deceptive. Another question might probably be raised with reference to the word "Friedrichshall," whether it had been in common use and was prominently set forth in this label. Did it or did it not require disclaimer or raise any objection under the 73rd section of the Statute? It was not a word, in our opinion, additional to the trade mark within the meaning of sect. 74. * * With regard to the mark 48,933, which is the German letter F impaled by the arrow, we find that that is the material part of a label which was devised and used by *Oppel* on the continent, that this label was registered by him on the continent in the year 1885, and that in *November* of the same year an application was made to register this F in this country. Now, it was admitted that this had never been separately used in this country. There was no evidence of any user of this label or any intention to use it in this country, and it is clear to us, and was, in fact, admitted, that there was no intention to use the mark in this country, but that it was intended to support and give effect to the monopoly contract, by stopping persons importing into England water sold in Germany with the marks which had been registered by *Oppel* in Germany. The argument was put very high by the Respondent's Counsel. They maintained that a person without ever using, having used, or intending to use, or having any connection with a trade in which there might be used, a label or other trade mark, may register that, and preclude all other persons from using it, without ever using it himself or intending to use it. That argument appears to us to be entirely untenable. It was

(1891) 2
Ch. 233,
8 R. P. C.
165, l. 8.

further argued that the contract entered into between *Oppel* and the *Apollinaris Company* was one of which every purchaser abroad must have notice, and every person who bought to import into this country must also have notice, and that no person who took with notice could lawfully import into this country. It is difficult, perhaps impossible, to believe that this argument can prevail. If it can, a fetter hitherto unthought of will be placed on the commerce of this country. But, again, if it can ever prevail, it must do so by force of the contract and notice, and no one, in our opinion, can use the Trade Marks Act for the purpose of supporting such a cause of action. The object of that Statute is to protect trade marks—that is, marks placed on goods to indicate their origin or their selection, or their importation or some other trade qualification, and thereby to give information with regard to those goods to all persons trading in them. They are marks under which the trader trades. It may well be that in the case of new marks the intention to use as a trade mark may be presumed; but when it is apparent, as it is here, by the evidence and the admissions at the Bar, that there is no such intention, but that the registration is directed to a different end, then the entry has, within the meaning of section 90, been made without sufficient cause, and ought to be expunged.

RE ARBENZ' APPLICATION.

[C. A., March, 1887. 4 R. P. C. 143; 35 Ch. D. 248; 56 L. J. Ch. 524; 56 L. T. 252; 35 W. R. 527.]

Trade Mark—Fancy word not in common use—Act of 1883, ss. 64 & 69.

On 5th August, 1884, *Adolph Arbenz* of Birmingham applied to register the word "Gem" as a trade mark for air-guns in Class 19. The application was opposed by *Charles Osborne & Co.* of Birmingham. The ordinary steps having been taken under s. 69, KAY, J. (3 R. P. C. 345) directed the registration, which was forthwith proceeded with by the Comptroller.

Appeal to the C. A. (Cotton, Lindley and Lopes LJJ.), heard by special leave, the notice of appeal having been given more than 21 days after KAY, J.'s order had been passed and entered, upon the Appellants undertaking not to take proceedings (if unsuccessful in the appeal) for rectification on the ground of the mark being improperly on the register.

Appeal allowed on the ground that in August, 1884, the word Gem had become descriptive of a particular class of gun, and was therefore not a fancy word,

4 R. P. C.
146, l. 35. COTTON, L.J. referring to an argument by the Respondent with regard to the Act of 1883, sect. 69, said :—The objection before us is brought forward under sect. 69. As I understand, it was said that the only question to be considered is the right as between the Applicant and the Opponent treating that which is sought to be registered as a mark which can properly be registered, subject to any question of right as between the Applicant and the Opponent. Sect. 69 does undoubtedly apply to any question as between the Applicant and Opponent, but in my opinion it is not confined to that. * * * In my opinion when under sect. 69 any opposition does come before the Court it is bound to enter into all the considerations which must be determined in order to see whether the particular mark or word can rightly be on the register.

4 R. P. C.
148, l. 30. In my opinion * * as regards the registration of this word "Gem," there is this fatal objection to it that it is a word which in *August*, 1884, had become descriptive of a particular make and class of gun. Therefore it cannot be considered as a fancy word. And independently of that I am bound to say that in my opinion in the modern usage of the word "Gem" it practically has ceased to be a fancy word. It would originally, undoubtedly, in the English language as applied to guns, be considered as a fancy word, but we know how many words get what may be called a slang meaning, and frequently we hear things spoken of as "Gems" not as indicating that they are in any way connected with precious stones or jewels, but that they are very good.

4 R. P. C.
148, l. 48. LINDLEY, L.J.—I am of the same opinion. Whether speaking generally and apart from evidence the word "Gem" as applied to air-guns could be registered as being "a fancy word not in common use" appears to me, I confess, more doubtful than it does to the other members of the Court. But in this particular case the evidence shows conclusively that the word "Gem" was not a fancy word as applied to air-guns at the time Mr. *Arbenz* sought to register it.

4 R. P. C.
150, l. 4. LOPES, L.J.—It is contended that the word "Gem" was not a fancy word. It is not necessary in this case to decide that point, but I do not hesitate to say that in my opinion the word "Gem" comes within the decisions of this Court recently delivered, I mean in the case of the *Melrose Hair Restorer and Electric Velveteen* (*infra*, p. 334).

RE ATKINS' TRADE MARK.

[C. A., April, 1886. 3 R. P. C. 164.]

Trade Mark—Descriptive words—Disclaimer—Act of 1875.

Motion to expunge.

In 1877, *Atkins* registered for "Filtering Apparatus" a trade mark consisting of four cross arrows fixed in a centre with the words "The Sanitary Filter, easily cleaned" round them. BACON, V.-C. refused a motion by an alleged infringer to rectify the register by expunging the words "The Sanitary Filter, easily cleaned," or, in the alternative for the entry of a disclaimer of any exclusive right to the use of such words. The trade mark was now vested in a company.

Appeal to the C. A. (Cotton, Bowen and Fry, L.JJ.) who dismissed the appeal, the Respondents stating they did not claim any exclusive right to use the words in question except as part of their trade mark.

COTTON, L. J.—In my opinion this case is quite governed by that case (*Re Hudson's Trade Mark, infra*, p. 168), in which we expressed our opinion that we registered the label, with the words upon it on the ground that by registering a label with common words upon it the person who registered could not gain any right to the exclusive use of those common words, or of mere words of description put upon his label which he was entitled to register; and that really applies to this case. If Mr. *Atkins* had registered alone the words "The Sanitary Filter, easily cleaned," in my opinion that would have been a wrong registration. Those words ought not to have been put on the register in that form as a trade mark. But he has not done that. * * * Here there is a distinctive feature—spear heads—and there are words added. * * * The total trade mark is that which I have mentioned; the distinctive mark with the superadded words. 3 R. P. C.
165, l. 38.

RE THE AUSTRALIAN WINE COMPANY, LIMITED.

[January, 1885. 61 L. T. 427 n.]

Trade Mark—Assignment—Substitution of names—Act of 1883, s. 90.

Motion to expunge and substitute.

In 1880 *W. H. Burton* (who was the sole consignee in England of the wines grown at the "Auldana" vineyards in South Australia, under an agreement made in 1878 between himself and *Patrick Auld* the then owner of the vineyard) registered in his own name

the word "Auldana" as a trade mark in respect of wines, intending, as he stated on affidavit, to use the registration solely in protection of the wines coming from the Auldana vineyards during the continuance of the agreement constituting him consignee.

In 1878 the Auldana vineyards were foreclosed by *Auld's* mortgagees and were subsequently sold and assigned to the Applicants.

In 1882 *Burton* went into liquidation by arrangement and the agreement of 1872 came to an end. The trustee in the liquidation subsequently sold and assigned *Burton's* business and the trade mark to the *Australian Wine Company, Limited*, who procured themselves to be registered as the subsequent proprietors of the trade mark.

Upon motion under Act 1883, s. 90, CHITTY, J. ordered the name of the Company to be expunged from the register and the names of the Applicants to be inserted in lieu thereof.

61 L. T.
429 n.

CHITTY, J.—I think, as I have already said, that the name which was registered was registered in the first instance not merely for the benefit of the owner of the business as distinguished, if such a thing could be done, from the owner of the vineyards, but for the benefit of the owner of the vineyards, that is, *Mr. Auld*, and that by the assignment that has taken place the present Applicants are entitled to the benefit of the registration.

RE THE AUSTRALIAN WINE IMPORTERS' TRADE MARK.

[C. A., March, 1889. 6 R. P. C. 311; 41 Ch. D. 278; 58 L. J. Ch. 380; 60 L. T. 436; 37 W. R. 578.]

Trade Mark—Application to Register for wines—Opposition by owner of similar mark for spirits—Discretion—Act of 1883, ss. 62, 69, 72, 79—Costs.

Summons to proceed.

The *Australian Wine Importers Company, Limited*, applied in May, 1887, to register in respect of wines, a trade mark, the characteristic features of which were the well known device of the Golden Fleece and the words "Golden Fleece." The application was opposed by *I. C. Mason* of London, who was the owner of a trade mark, registered in 1882 for spirits only, consisting of the same device and words. *Mason* sold spirits in bond for export with this trade mark, but though he sold wines in bond for home consumption, he did not use the trade mark in connection with them.

41 Ch. D.
280,

KAY, J. dismissed the summons with costs, holding that the *Company's* trade mark for wines would, having regard to *Mason's*

trade mark for spirits, be calculated to deceive within sect. 72, sub-sect. 2 of the Act of 1883.

Decision affirmed by C. A. (Cotton, Lindley, Lopes, L.JJ.).

COTTON, L.J.—I think it [sect. 62] means to say that if the Comptroller should think that the trade mark is one which, having regard either to sect. 72 or sect. 73 of the Act, or on other grounds, ought not to be registered, then he has a discretion to register it, means being pointed out by which his discretion can be controlled. 41 Ch. D.
285.

The application to us now is not under that section, but under sect. 69, which applies in terms to an opposition being offered to the registration of the trade mark. * *

There may be various grounds of opposition, but if the opposition is grounded solely on sect. 72, then all the Court has to decide is, whether or not the trade mark sought to be registered comes within the terms of that section, because if it does, then the Comptroller cannot register it. The section says, "the Comptroller shall not register," so that such a trade mark is taken out of the possibility of registration. But in my opinion there may be other grounds upon which the Court may think that the trade mark ought not to be registered. I think that sect. 73 does not apply to the present case, because I agree with the view that the words, of which that section forbids the registration, must be words in which there is some misrepresentation, or words which of themselves are on some other ground disentitled to protection, and does not apply to words which are not objected to on any other ground than that they form part of an existing trade mark. But though that section does not apply, it furnishes some guide in determining under what circumstances, if there is no prohibition against registration, the Court still ought not to direct the registration, for it prohibits the registration of words which in themselves are deceiving. Then sect. 72, sub-sect. 2 provides—(His Lordship read the sub-sect. *supra*, p. 11). I think both of those sections point to this, that when the Court has a discretion, registration ought not to be ordered if the Court comes to the conclusion that the registration applied for is one calculated to deceive. If the Court decides that the case comes within sub-sect. 2 of sect. 72, then it is not a question of discretion, for the Court has no power to order registration, because the Comptroller, who is the person to register, is in such a case prohibited from registering.

Wine and spirits are, it is true, different goods. We are not, however, considering here how chemists would describe them, but whether manufacturers and merchants would look upon them as 41 Ch. D.
287.

being goods of the same description. They are goods which are generally sold by the same person, and they are both alcoholic. Although there are differences between them, they may fairly be considered as coming within the expression "the same description of goods." The descriptions of classes in the schedule to the rules are not the descriptions to which we are to refer for the purpose of construing the section, but we are to consider whether fairly and in a proper sense, these goods are to be considered "the same description of goods." And if it were necessary to decide the point, I should hold that the goods were of the same description.

41 Ch. D.
283.

But supposing that the goods are not of the same description so that the case cannot come strictly within the terms of sect. 72, sub-sect. 2, yet in my opinion the Court must have a discretion as to whether, though the registration is not prohibited, it is such a registration as the Court ought not to encourage by directing the Comptroller to go on. In my opinion it is. * * * Here, although when the *Company's* trade mark and *Mason's* are looked at side by side, one would not hold that they are so alike as to deceive, yet in my opinion, the use of a trade mark, the prominent part of which is the *Golden Fleece*, is, as KAY, J., held, calculated to deceive when applied to a description of goods similar to that in respect of which Mr. *Mason* has been using it.

41 Ch. D.
291.

LINDLEY, L.J.—Now for the purpose of deciding whether two sets of goods are of the same description we must not, as it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29 you will find that flax and hemp are in one class and jute in another, though all of them are fibrous and more or less of the same description for trade purposes. Supposing a man who deals in hempen goods and in flax goods too, have a trade mark for flax and hempen goods, it would be a strong thing to register an almost identical trade-mark on the application of somebody else in respect of jute goods. I take it that there you would have the same description of goods within sect. 72, sub-sect. 2, although the framers of the rules have classed these things in different classes. Then if you turn to class 22 you will find bicycles and railway carriages in the same class. Now for trade purposes can you have any goods more different than bicycles and railway carriages? Of course they are utterly different things, and yet they are put by the framers of these rules into the same class, so that we cannot be guided by

their classification in construing the words "same goods or description of goods," which are the words used in sect. 72. I am not sure that wines and spirits are different descriptions of goods. We must look at the question from a business point of view. They are both alcoholic, and they are generally sold in this country by the same people, and I am not sure that they are not the same description of goods. But whether they are so or not it seems to me that they are so uncommonly near the line that we ought not to depart from the view taken by KAY, J., and say to the Comptroller, "You must register in favour of these wine merchants, a mark which is already on the register in favour of a spirit merchant who is also a wine merchant."

On *Mason's* Counsel asking for costs of the proceedings before the Comptroller:

COTTON, L.J.—We cannot make any order as to the costs incurred before the matter came before the Court, unless the statute enables us to do so. Sect. 69 only requires the opponent to give security, and does not require any security to be given by the applicant, nor does it say, that the applicant shall, if he fails, pay any costs which were incurred by the opponent before the matter comes into Court. If the Taxing Master says that these are costs incident to the application to the Court, we will consider that hereafter, but I cannot on this application express an opinion that they are. Then sect. 90 in my opinion only applies to the costs of proceedings under that particular section, and it would be wrong to act upon that section in the present proceeding. We are not proceeding under that section. 41 Ch. D.
293.

BAKER v. RAWSON.

[August, 1890. 45 Ch. D. 519 ; 63 L. T. 306 ; 8 R. P. C. 89.]

Trade Mark—Element common to trade—Untrue statement of user—Person Aggrieved—Disclaimer—Act of 1875, ss. 3, 5, 16 ; Act of 1883, ss. 64, 74, 76, 90.

In 1877 the Plaintiffs (who were manufacturers of hardware goods at Sheffield) registered as a new mark (No. 7883) in Class 12 the representation of a lighthouse on a rock surrounded by waves within two concentric circles.

In 1888 the Plaintiffs registered in Class 12 as an old mark used for ten years prior to 1875 a label (No. 64,443) containing trade mark No. 7883, a picture of the Plaintiffs' works and certain letter-press. As a matter of fact the label had not been used

in its then form prior to 1877. In 1876 the Defendants (also manufacturers of hardware goods at Sheffield) registered in Class 12 a corporate mark granted to them in 1870, consisting of a winged cross, and in 1888 they applied to register as an old mark (No. 73,386) the winged cross surrounded (like the Plaintiffs' lighthouse) by two concentric circles, with a disclaimer of any exclusive right to the two circles.

This application was opposed by the Plaintiffs, who commenced an action for infringement against *Rawson Brothers*. The Defendants thereupon moved to expunge the Plaintiffs' trade marks. The action, the motion, and a summons to proceed with the registration of No. 73,386, came on for hearing together.

The action was dismissed without costs.

NORTH, J., directed the Plaintiffs' label (No. 64,443) to be expunged. Dealing with the misstatement made by the Plaintiffs on application, his Lordship said :—

45 Ch. D.
523 ; 8
R. P. C.
97, 1. 35.

The information which is to be given by an Applicant for registration is required for very important purposes, viz., for the purpose of seeing whether the mark is an old one or a new one—that is, used before or not till after the 13th of *August*, 1875, very different rights attaching to the mark if it was used before, or if it was not used till after that date. The Registrar of Trade Marks and the public were both directly misled by the statement which was made. The Registrar was prevented from considering the mark as a new mark, which it really was, when he was told that it was an old mark, and the discretion which the Act gives him was applied to an entirely wrong state of things. Then again the advertisement is published that the public may see it and that it may be known what opposition is made to the registration of the trade mark. That is a very important matter ; and in this again the public were deceived, and opposition was disarmed. It might well be that a person who, if he had been told that it was a new mark, would have seen that there was some ground upon which he could oppose its registration, would not feel that he had any chance of successful opposition with the knowledge he had, if the mark was, as stated, an old mark. In the first place, if it was an old mark, it would possibly carry back the applicant's user to a date earlier than the user of a similar mark by other persons, who, if they had been told that it was a new mark, would have come forward to oppose because their own marks were older. Then there is another very important matter to be borne in mind—viz., that no person opposing could, if it was an old mark, succeed

in his opposition unless he could shew that it had been used by at least three other persons besides himself before that time. The public therefore were entirely misled by the statement. Then I was told by the Plaintiffs' Counsel that the Act does not impose any punishment for such a misstatement. But in my view when a registration in a public register is obtained by misrepresentation the Court is bound to remove the mark from the register, and sect. 90 of the Act of 1883 gives ample jurisdiction for the purpose.

Then, are the Defendants justified in asking to have the mark removed? I think they clearly are. The Court may act "on the application of any person aggrieved—by any entry made without sufficient cause" in the register. Beyond all question the Defendants, who are registered in the same class, are "persons aggrieved" by the mark being on the register when it ought not to be there, when the fact of its being there is made a ground for bringing an action against them for infringement, as it is in the present case. Therefore this part of the Defendants' motion must be granted, and I must make an order that the label be removed from the register.

The Defendants' application to register No. 73,386 was refused.

NORTH, J.—The Defendants have had their trade mark, the winged cross, on the register from the year 1877 down to the present time, and they are now asking to register that mark again, *plus* the circles, *minus* the same. They ask that their well known trade mark may be registered with the addition of the circles accompanied by a note that the circles are not part of the trade mark. That application seems to me an absurd one. * * There is another ground upon which I could not allow the registration as an old mark of the two circles round the winged cross, without any thing else. There is no evidence that the Defendants' goods have ever been known by that mark. [*Re Spencer's Trade Marks (infra*, p. 318).]

45 Ch. D.
530; 8
R. P. C.
102, l. 30.

With reference to the Plaintiffs' trade mark, No. 7883, a note was directed to be added to the register that the two circles were common to the trade.

NORTH, J.—It was contended, on behalf of the Plaintiffs, that the application cannot be considered at all, because sect. 76 of the Act of 1883 says that after the expiration of five years the registration is to be conclusive evidence of the right of the person registered to the exclusive use of the trade mark. It is, however, well settled by *Re J. B. Palmer's Application (infra*, p. 261); *Re Leonards & Ellis's Trade Mark (infra*, p. 205); *Edwards v. Dennis (infra*,

45 Ch. D.
531; 8
R. P. C.
103, l. 23.

p. 117), and *Re Wood's Trade Mark* (*infra*, p. 349), that this bar does not apply when the trade-mark is one which should never have been registered at all. It is said that those cases were under sect. 5 of the Act of 1875 (which has been repealed), and that the words of that section are not to be found in sect. 90 of the Act of 1883. But I think the words of sect. 90 are large enough; and, moreover, *Re Wragg's Trade Mark* (*infra*, p. 353) was under the Act of 1883. Then it was said, that in the cases cited the whole of the mark had been in common use, and that they are not authorities for taking a mark off the register because part of it has been commonly used. I do not think this criticism is accurate, and, moreover, the question is whether the mark is properly on the register; if not, it ought not to be left standing unexpunged or uncorrected, whatever may be the particular reason why its registration in that form was improper. I think, therefore, that I am not precluded by sect. 76 from hearing the application.

I must next consider whether the trade mark in question could properly be registered under the Act of 1875. Sect. 10 of that Act provides that for the purposes of that Act a trade mark consists of certain essential particulars, including (which is all that is now material) "a distinctive device or mark," to which there may be added "any letters, words or figures or combination of letters, words or figures."

45 Ch. D.
532; 8
R. P. C.
104, l. 19.

In my opinion *Orr-Ewing v. Registrar of Trade Marks* (*infra*, p. 254) throws great light on this subject, and indicates the course which I ought to take. Messrs. *Orr-Ewing* there sought to register as trade marks certain labels which the committee of experts had placed in the second class. Those labels contained several features wholly ineffectual to create any distinctive devices, such as the green colour of the tickets, their triangular shape, the mode of printing the suspended curtain and the words "Prime Turkey Red," all of which had long been in common use in the trade upon similar articles. But they also contained certain animal figures, with the name and address of the firm added, which, to use the language of Lord Cairns, "constituted in each case a distinctive device within the meaning of the Act of 1875, and thus was a trade mark authorised to be registered under the Act." The House of Lords did not reject the application to register the labels because they contained some matter which was not distinctive, but they directed the Registrar to proceed with the application to register as trade marks the distinctive devices of animals on the labels with the name and address of the firm. * * *

Of course the Registrar is not familiar with all the marks in

common use in every trade, and he can only act upon the materials before him; and, the application having been duly advertised, and no one opposing, he, as a matter of course, allowed the registration. If he had known what we know now, he would have refused the application so far as it related to the circles, but would have granted it as to the rest. As granted it includes the circles, and the registration was, therefore, in my opinion, improper, though through no fault of the Registrar. And under sect. 90 I have jurisdiction to expunge or vary that entry. * * I certainly cannot leave the mark as it stands. I quite concur in PEARSON, J.'s observations in *Re Wragg's Trade Mark*, that so long as the mark remains on the register as at present, it apparently gives the Plaintiffs the exclusive right to use it; it would enable them, if they were minded to do what was unjust and fraudulent, to terrify other persons by informing them that they have no right to use circles which are common to the trade, because the Plaintiffs have improperly registered them as their own. I do not mean to suggest that the Plaintiffs have done anything fraudulent or, to their knowledge, unjust, but I cannot leave the mark as it stands in Class 12.

RE BANCROFT & COMPANY'S TRADE MARK.

[February, 1888. 5 R. P. C. 209.]

Trade Mark—Similar mark on Register belonging to Foreigner—Practice—Act of 1883.

Motion to proceed.

In 1887 *Bancroft & Co., Limited*, applied to register as an old mark a boar's head as a trade mark for lard. There being at that time an almost identical mark for lard on the register belonging to *Fairbank & Co.* of Chicago (registered in 1878 as an old mark), the Comptroller-General refused the application. On appeal by the Applicants to the Board of Trade, the matter was referred to the Court, and the Applicants served notice of motion on the Comptroller for an order to proceed.

STIRLING, J., refused (1 Dec. 1887) to hear the motion in the absence of *Fairbank & Co.* It appeared that the latter had no agent in England who would accept service of the notice of motion on their behalf, and the Judge accordingly made an order directing that notice of the proceedings be sent by registered letter to *Fairbank & Co.*, and that the motion should stand over till 26th January, 1888 (for form of order see 5 R. P. C. 210). *Fairbank*

& Co. replied that though they did not consent to the registration they did not propose to appear in Court.

STIRLING, J., upon proof being adduced that the Applicants' mark was an old mark made (10th *February*, 1888) an order that the Comptroller should proceed.

RE BARKER'S TRADE MARK.

[May, 1885. 53 L. T. 23.]

Trade Mark—Deception—Act of 1883, s. 90.

Motion to expunge.

In 1876 *Grant & Sons*, distillers, registered for cherry brandy (which had been manufactured by them since 1853) a trade mark consisting of a representation of two huntsmen in pink on horseback, one filling a glass from a bottle and the other waiting expectantly by, and the words "*Grant & Sons*," "*Morella Cherry Brandy*," and "*The Sportsman's Special Quality*." This trade mark was printed on the labels on *Grant & Sons'* bottles, and by 1884 that firm's cherry brandy had become known to the public as "*The Sportsman's*," "*The Huntsman's*," and "*The Hunter's Cherry Brandy*." In 1884 *Barker & Sons*, distillers, who had till then obtained cherry brandy from *Grant & Sons*, began to sell cherry brandy of their own manufacture, and registered as a trade mark therefor without opposition from *Grant & Sons*, the representation of a huntsman in pink standing beside his horse, raising a fox above his head, and surrounded by hounds, and the words "*Huntsman's Cherry Brandy*." *Grant & Sons* moved to expunge this trade mark on the ground that it was a colourable imitation of their own.

Trade mark expunged.

KAY, J.—The inference to my mind is irresistible that the trade mark in question was adapted and registered by the Defendants for the purpose of passing off their cherry brandy as that of the Plaintiffs. I can only say that the strongest possible evidence that the Defendants' trade mark is calculated to deceive is afforded by the Defendants themselves, as they have adopted it for the very purpose.

BARLOW v. JOHNSON.

[C. A., May, 1890. 7 R. P. C. 395.]

Trade Mark—Name of Article—Right to Register—Act of 1883, ss. 74, 76, 90.

Action to restrain infringement and passing off. Motion to expunge.

In 1879 the Plaintiffs (who were wholesale cotton spinners) began to manufacture a particular kind of Turkish towel, which they called "Osman." No one prior to 1886, except a former servant of the Plaintiffs named *Holt*, and afterwards the Defendants, ever made towels of the same kind, and the word "Osman" came to denote towels made by the Plaintiffs. In 1886 the Plaintiffs registered as a new trade mark for (amongst other things) towels a label (which they had used in connection with their towels since 1879), containing (amongst other things) a representation of Osman Pasha and the words "The Osman." The Plaintiffs' name did not appear on the label. The circumstances with regard to the manufacture by *Holt* and the Defendants of "Osman" towels were very complicated, but it was proved to the satisfaction of the Court that such manufacture was an attempt to supplant the Plaintiffs, that the Plaintiffs, upon discovering what *Holt* was doing, stopped him, but that they did not discover what the Defendants were doing till just before action brought. As a matter of fact the Defendants (who were wholesale dealers) both before and after 1886, sold towels of their own manufacture to retail dealers ticketed and invoiced as "Osmans," but having distinctive labels of the Defendants' own affixed to them. In the course of trade however the Defendants' labels would be removed by the retail dealers, who would pass the towels on simply as "Osmans." The Plaintiffs brought an action against the Defendants for infringement and passing off, and claimed the usual injunctions. At the trial of the action a motion by the Defendants to strike the word Osman out of the Plaintiffs' trade mark was also heard. The Defendants alleged that the word "Osman" as applied to Turkish towels was "common to the trade."

CHITTY, J., granted the injunctions claimed, and refused the Defendants' motion.

Appeal to C. A. (Cotton, Lindley, and Bowen, L.JJ.). Appeal dismissed.

COTTON, L.J.—But it is said, how can the Defendants be in any way attempting to deceive? The persons who buy in shops do not get the goods with their tickets upon them. The Defen-

7 R. P. C.
413, l. 28.

dants say, "We always sell our goods as our manufacture, with our labels upon them." Well, in my opinion, that is true. They do; and it cannot be that those who buy wholesale from them—that is, buy direct from the Defendants—can be misled into the belief that what they are buying from the Defendants have been made by the Plaintiffs. But this case is rather a peculiar one. Here the persons who buy from the Plaintiffs are not deceived. But may not other people be deceived?

7 R. C. P.
413, l. 47.

Although there is a difference between the present label used by the Defendants and that which is used by the Plaintiffs, yet that is not shown to those who will buy from the retail dealers; that is taken off, and if there was such a distinction between the two labels as to mark the difference between goods made by the Defendants and goods made by the Plaintiffs, the ultimate purchaser will not get that means of ascertaining whether or no the goods which he is buying, which are called "Osman," are the goods which are made by the Plaintiffs, or the goods which are not made by the Plaintiffs. Well, in my opinion, that is a ground that has been acted upon several times by this Court for restraining the Defendants from doing that which puts into the hands of others the means of deceiving those who are buying; and I cannot think the Defendants here could be ignorant that that would be the result.

7 R. P. C.
414, l. 40.

If the Defendants used this term so far as they used it in the market in consequence of their obtaining from the former servant of Plaintiffs the means of passing off their own goods—goods sold by them—as goods made by the Plaintiffs, it cannot be that that was a thing which one can call fair, or I may say even honest. Therefore, in my opinion, if the user in the market was only by that means, and in that way, it cannot be said to be common in the market with reference to this Act.

7 R. P. C.
417, l. 32.

BOWEN, L.J.—It is said that this is really like the "Valvoline" case (*infra*, p. 205), and the patent cases, and that we ought to come to the conclusion that "Osman" is a term which applies only to the article, and applies to the article, nevertheless, because it happens only to be manufactured in that particular shape by the Plaintiffs' firm. But be it observed that there is this difference between these patent cases and the present, that when an article which is patented is made by the patentee the name which is given to it, although it may incorporate in it the patentee's appellation, is a name which must apply to the article because nobody except the patentee does make that

article or can properly make it. Therefore, the name must mean the article. But in the present case anybody could make the towel and make it of exactly the same make, shape, and quality, if he had the skill, as the Plaintiffs. The name might therefore apply to distinguish the maker as well as the article, and that is exactly what the learned Judge thought, and as we think, thought rightly, was the true conclusion upon the facts here.

It is an injury to take a name understood in the trade as con- 7 R. P. C.
noting a particular maker, and to sell goods under it which are not 419, l. 2.
of that maker's make; and it is an injury none the less because the immediate vendee is not deceived. If the probable and natural result of that is that the immediate vendee though not deceived himself will use the name so as to deceive others—his ulterior vendees—it is an injury to take the name and use it in that way, and it is a fraud in equity if it is known by the person who takes it that that will be the ultimate and probable result.

Assuming there is no acquiescence, how can a man acquire a 7 R. P. C.
right by wrongful user? How can that which is in the eye of the 419, l. 15.
Court of Equity, fraudulent and injurious, defeat the rights of others unless there is acquiescence? But unless there was knowledge there could not be acquiescence. Though the points run together they are separate points, and it follows that at the time of the registration in 1886 there was no user except a wrongful and unknown user, as far as the Plaintiffs were concerned, of this name "Osman" by the Defendants. There was therefore not only no common user of it in the trade, but there was only a user which, as far as the Defendants were concerned, was wrongful. It is impossible that they can rely on that user.

RE BARROWS' TRADE MARK.

[C. A., April, 1877. 5 Ch. D. 333; 46 L. J. Ch. 725; 36 L. T. 780; 25 W. R. 564.]

Trade Mark—Words or devices indicating quality—Act of 1875, s. 5—Act of 1876.

Motion to rectify.

In 1876 *Barrow & Sons*, iron manufacturers, carrying on business at the Bloomfield Works, Tipton, Staffordshire, applied to register certain old trade marks consisting of the letters B B H (the initials of the old firm), and the words BLOOM and BLOOMFIELD, either alone or in continuation with certain words ("Plating, Special, &c.") denoting the quality of the iron or certain devices (a crown and a horse-shoe) admittedly common to the trade.

The Registrar refused registration, and this motion was launched by way of appeal.

MALINS, V.-C., granted the motion.

Appeal to Court of Appeal (Jessel, M.R., James and Baggallay, L.JJ.).

5 Ch. D.
365.

JESSEL, M.R.—It appears to me that the proper mode of registering the trade mark in such a case as the present, is as follows:—

Register B B H, used either alone or in combination with a crown or with a horse-shoe, or with a crown and horse-shoe, or with any other mark, device, or words signifying the quality of the iron.

The marks “BLOOMFIELD” and “BLOOM” would be registered in the same way.*

RE BATT'S TRADE MARK.

[August, 1889. 6 R. P. C. 493.]

Trade Mark;—Persons aggrieved—Act of 1883, ss. 64, 90.

Motion to expunge.

In 1885 *J. Batt & Co.* registered the words “The Brymbo Special” as a new trade mark for unwrought and partly wrought metals in Class 5. In 1889 the *Brymbo Steel Company, Limited*, who carried on business at Brymbo, in Wales, proposed to register the word “Brymbo,” which for many years prior to as well as after 1875 they had used as a trade mark upon the iron and steel goods manufactured by them, but were unable to do so owing to *Batt & Co.*'s mark. They thereupon moved as persons aggrieved under sect. 90 of the Act of 1883, to expunge *Batt & Co.*'s mark. *Batt & Co.* adduced evidence to shew they had adopted their mark innocently.

Mark expunged.

6 R. P. C.
495, l. 32.

CHITTY, J.—The Applicants plainly on the evidence are persons aggrieved. Upon that there can be no question, and [Counsel for the Respondents] in his argument had to admit that they were aggrieved at the present moment by this mark standing on the register, but he ingeniously tried to get out of that proposition by saying that he would remove their grievance altogether by confining the user of this mark to tin plates. As I say, that argument concedes the point that the Applicants are persons aggrieved; consequently they can make a motion.

* As to how this rule worked in practice, see Sebastian, 3rd ed. p. 375.

Then on the point as to whether, so far as the Respondents are concerned, they can maintain this as a trade mark at all, it is clear they cannot. It is not within the 64th section of the Act of 1883. * * *

The term, as far as the Respondents are concerned, is a clear geographical term which they have taken in ignorance, as they say, of what I should have thought would have been a matter of common knowledge in geography. The order therefore is made as asked, and without any such limitation as [Counsel] proposed, and with costs.

BENBOW v. LOW.

[June, 1881. 44 L. T. 875 ; 29 W. R. 837.]

Trade Mark—Three-Mark Rule—Identical Mark—Act of 1875, s. 6.

For many years previous to 1875 a firm of perfumers, of which both the Plaintiffs and Defendants were subsequently members, had sold soap in wrappers, each of which had a label on it bearing the words "Low's Highly Perfumed Brown Windsor Soap." It was decided in the action that the Plaintiffs and Defendants were both entitled to the use of this label. The Defendants having registered the label as their trade mark, opposed an application by the Plaintiffs to register what was in effect an identical label.

BACON, V.-C., directed registration.

BACON, V.-C., read from the shorthand notes of the judgment of JESSEL, M.R., in *Re Jelley* (*infra*, p. 187). " [In cases falling within the Act of 1875, sect. 6], you shall not register without the leave of the Court. But you may make your application, and the rule of the Court is to register up to three, but not more than three, even if they are identical, if they are old marks. Then if there are more than three applications to register we do not register them." Why? "Because they come under the classification of common property, so that if two or three people have used the same mark for twenty or thirty years the only thing is that you must come to the Court to prove it." Because Messrs. *Low* use the same trade mark, the identity of the trade mark is no objection to the registration. The identity in the case of more than three would be an objection, for very plain reasons, leading to confusion, and it would not be within the Act of Parliament; but up to three that is plain law, and not any new rule laid down by the commissioners or sanctioned by the Court, but a plain rule that the Registrar must register if the enjoyment is shown to

44 L. T.
877.

his satisfaction, and that the identity of a mark which he has registered forms no objection to his registering any other mark which the Applicant can lawfully claim.

RE BIEGEL'S TRADE MARK.

[May, 1887. 4 R. P. C. 525 ; 57 L. T. 247.]

Trade Mark—Similarity—Calculated to deceive—Acts of 1883, s. 90.

Motion to expunge.

Younger & Co. of Edinburgh, brewers, who were the owners of an old trade mark registered in 1876 in Class 43 for fermented liquors (which included beer), discovered that *Biegel* had registered in 1886 a new trade mark, No. 54,557, for bottled beer.

The principal characteristic of both trade marks was a triangular device. In the centre of *Younger's* device was a triangular white space. The centre of *Biegel's* device was filled with a stag's head, but would otherwise have been an hexagonal space. An illustration of both marks is given in 4 R. P. C. 525, 526.

It appears that *Biegel's* intention was to sell his beer in Singapore (where he had established a trade), and that if his trade mark was registered in England, he would more easily obtain registration in Singapore. *Younger & Co.* moved to expunge so much of *Biegel's* trade mark as consisted of a triangular device.

Motion granted.

4 R. P. C.
526, l. 28.

CHITTY, J.—The question that I have to decide is one of fact, and that is to be decided partly in accordance with the evidence given in the case of persons acquainted with the trade, and acquainted specially with matters of this kind, and also in accordance with what the Judge of fact considers upon comparing the two trade marks fairly is the result.

4 R. P. C.
528, l. 37.

What has to my mind to be considered is, as is laid down in fact by the C.A., the legitimate user by the Respondent of his trade mark, and by legitimate user, I mean, such a user as he could rightly make of his trade mark. Under the provisions of the Act of Parliament, not being bound to use this in any particular colour, he can still retain this outline, this design in all respects, and he can colour it in any way he thinks fit. He cannot colour it so as to entirely obliterate the design, but he can colour it in any manner he chooses, keeping these outlines, and curiously, when the devices which I have before me are compared with those in *Worthington's case* (*infra*, p. 351) the resemblance is very striking. * * *

The late M. R. whose experience in these matters was very large,

considered that *Worthington's* trade mark might be so used ; and I understand him to mean, and I certainly take the C. A. as holding, used legitimately in such a manner as to be calculated to deceive, and that could only be done, as it was stated particularly by the present M.R., by colouring.

Now, colour *Worthington's* and colour *Biegel's*, and it appears to me that in each case there is not an obliteration wholly of the design, but there is that which brought *Worthington's* to such a point of resemblance to *Bass's* that the judges, both the late M. R. and the majority of the C. A., thought it was calculated to deceive, and in my opinion, adopting a similar process, and still remembering of course that I have to decide this case on its own special facts, I think that there is in the fair user of the Respondents such a degree of resemblance as brings it within the principle I have stated. 4 R. P. C.
529, l. 9.

BLAIR v. STOCK.

[March, 1884. 52 L. T. 123.]

Trade Mark—Calculated to deceive—Act of 1875, ss. 5, 6—Costs.

The Plaintiff was the owner of a registered trade mark for whiskey, part of which consisted of the words "Strathmore Blend." The Defendant subsequently registered a trade mark for whiskey containing the words "Strathmore Finest," but different in other respects from the Plaintiff's trade mark.

The Plaintiff brought an action against the Defendant for infringement and passing off, and also moved to expunge the word "Strathmore" from the Defendant's trade mark.

The action and motion were tried together.

It was shewn that (a) the Scotch place "Strathmore" was unconnected with whiskey, (b) the Plaintiff's whiskey was known and ordered as "Strathmore" whiskey.

KAY, J., held that the use of the word "Strathmore" in connection with whiskey by any person other than the Plaintiff would be calculated to deceive. Injunction granted to restrain the Defendant from using the word "Strathmore" either as a description of his whiskey or otherwise.

Register rectified as asked.

KAY, J., after stating that the word "Strathmore" had been honestly selected by the Defendant, said: I am sorry that I am obliged in a case of this kind to order that the Defendant must pay the costs. * * * If any body comes here and insists that he 52 L. T.
125.

has a right to use a trade mark which the Court is bound to come to the conclusion is calculated to deceive, so that he has no right to use it, I have no choice in the matter but to order him to pay the costs of an action which he has so thought fit to defend.

RE BRADLEY'S TRADE MARK.

[March, 1892. 9 R. P. C. 205.]

Trade Mark—Combination Mark—Distinctive—Act of 1883, s. 64, sub-s. 1 (c).

Motion to rectify.

In 1886 *Charlotte Helena Bradley* (trading as *Worth et Compagnie*) registered as a new mark a device, consisting of a double oval, and the words "Worth's Corsets" (in ordinary type), between the lines of the two ovals.

In 1888 she commenced an action for infringement against one *Tighe*, who thereupon moved to expunge her trade mark.

It was proved that the double oval was in common use in the corset trade.

Mark expunged.

9 R. P. C.
207, l. 15.

CHITTY, J.—The result then is that neither of the component parts of the trade mark satisfies the condition of one of the essential particulars required by the 64th section, and therefore, if this were all, the mark must be removed from the register.

But the argument is that, though neither of the particulars is within the 64th section, the mark must be looked at as a whole, and being looked at as a whole it is brought within the subsect. (c), because as a whole it is distinctive. This point was raised before PEARSON, J., in *Price's Patent Candle Company's* case (*infra*, p. 277), and without success. It is quite true that the trade mark must be looked at as a whole, but we must find in the whole one, at least, of the essential particulars; and not one of the essential particulars, in my opinion, can be found in this mark. The addition of the name "Worth," which is the trade name of the Respondent, neither makes the mark as a whole better nor worse. Under the Act of 1888, as is well known, the name of the person registering or carrying on the trade may be placed on the mark; and under that Act of 1888, which only represents the development of the law by the Legislature, there is no necessity for disclaiming the name. Of course I am speaking of the name printed in ordinary type. Consequently the mark is reduced in this case solely to the band or double oval, and the result is

unfortunately it may be for the Respondent, that the mark cannot stand on the register, and I am bound by PEARSON, J.'s decision in *Price's Patent Candle Company's* case. It has been argued that that has been overruled, simply by the Court of Appeal, and the Master of the Rolls particularly,* having said that you are to look at the trade mark as a whole. There was no intention when that observation, which is a just one having regard to the context and subject-matter of the judgment, was made, to overrule PEARSON, J.'s decision; and since I am called upon by the argument of the Respondent to pronounce my own opinion on the matter, I think that PEARSON, J.'s decision was right.

RE BRANDRETH'S TRADE MARK.

[August, 1878. 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 231.]

Trade Mark—Costs of Proceedings before Registrar—R. S. C., 1875, O. LV.—Act of 1875, s. 7—T. M. R., 1876, r. 16.

A summons for the registration of the word "Porous" as a trade mark for *Alcock's* Porous Plasters having been refused with costs, a question arose whether the Court had jurisdiction to order the Applicant to pay, in addition to the costs of the summons, the costs of the parties opposing the registration incurred before the Registrar of Trade Marks prior to the issue of the summons from the Judge's Chambers.

JESSEL, M.R., held there was no such jurisdiction.

JESSEL, M.R.—The Rules of Court, 1875, Order LV. provide ^{9 Ch. D. 619.} that "the costs of and incident to all proceedings in the High Court shall be in the discretion of the Court," that is, the Court has only a discretion as to costs of proceedings that have actually come into the High Court. The moment, therefore, a case under the Trade Marks Registration Acts comes into the High Court there is no doubt the Court has jurisdiction as to costs from that time, but proceedings in the Registrar's office are not "proceedings in the High Court." It seems to me the 16th rule of the Trade Marks Rules, 1876 (*infra*, p. 390), is the only rule applicable to the case, and upon the construction of that rule, I hold that, upon the Opponents giving security for costs as therein provided, the case then, and not till then, "stood for the determination of the Court," and accordingly that the Court must confine itself to ordering the Applicant to pay his Opponents' costs from that time.

* See *Pinto v. Badman*, *infra*, p. 270; *Richards v. Butcher*, *infra* p. 287.

RE BROOK'S TRADE MARKS.

[July, 1878. 26 W. R. 791.]

*Trade Mark—Representative Registration—Certificate—Act of 1875, ss. 5, 10—
Act of 1876, s. 2.*

Motion to rectify.

In this case *The Manchester Committee of Experts** had placed in the first class as entitled to registration, twenty-four marks for cotton goods belonging to Messrs. *J. Brook & Brothers* of Meltham Mills, manufacturers of cotton sewing thread.

The Registrar of Trade Marks admitted six of these marks to separate registration. Acting however on the authority of *Re Barrows* (*supra*, p. 75) he grouped together the remaining eighteen marks (the distinguishing and principal feature of each being a goat's head, and "*Brook's*") and refused to register more than one of them, that one to be selected by the applicants, and registered as representative of the eighteen, with the following note:—"Used either as shewn or in combination with certain words, numerals, &c., commonly used by the trade to denote quality, quantity, length, &c.," or "used either as shewn or in combination with certain words, numbers, or abbreviations commonly used by the trade to denote the nature, quality, quantity, thickness, colour, length, weight, or uses of the articles marked."

The Registrar refused to give a certificate under the Act of 1876, s. 2, of refusal to register, but offered the following certificate:—

"I, Henry Reader Lack, clerk to the Commissioners of Patents, Registrar of Trade Marks, hereby certify that of
is entered on the Register of Trade Marks as proprietor of a trade
mark for in class for registration of which mark
application was made on the day of 18 .

"A representation of the said mark is shewn upon the label annexed hereto."

This motion was made for the purpose of effecting the registration of all the eighteen marks. The Commissioners of Patents had issued instructions that the Committee of Experts and the Registrar were to disregard "borders."

26 W. R.
793.

HALL, V.-C.—In my opinion an applicant is not entitled, in every case, to require that all his trade marks be registered individually.

I consider that this must be deemed to be the law, having

* See *infra*, p. 291.

regard to *Barrows'* case (*supra*, p. 75). In each case where the Registrar objects to individual registration and requires representative registration, it must be considered whether the case is one which admits of representative registration. In determining this, we must, I consider, disregard the colouring of the trade marks, and all the surrounding lines, edges, and borders of the labels or tickets. It seems to me, therefore, that all that remains that can be considered to properly constitute the trade marks, in each of the eighteen cases, is either the goat's head or "*Brook's*," and that, if these be sufficiently registered, with the proposed additional words, which I think comprise all other elements of the marks, there will, by representation, be a registration of each one of the eighteen marks. It would, however, I think, be the most correct mode of representative registration of the eighteen marks to register the goat's head separately, and "*Brook's*" separately, with the proposed additional words to each. * * * *

The Registrar, having been willing to give the Applicants a certificate in the following form (his Lordship referred to the certificate), and it not being, when the case was argued before me, desired to retract this offer, I say I think it reasonable to ask for, and proper to give, the certificate, and this irrespective of its being required for registration abroad. The certificate might be framed so as to be a certificate as to one mark only, or so as to include all the eighteen marks, or so as to include some of the marks, the others being included in separate certificates or a separate certificate. I throw out for consideration whether, if the Applicants should so desire, there might not be added to the register an explanatory statement such as this:—"This trade mark not only is a register of the trade mark itself, but also by representation registers the other trade marks shewn in a label annexed to a certificate dated the of under the hand and seal of Henry Reader Lack, Chief Clerk to the Commissioners of Patents, Registrar of Trade marks." This might be either in addition to, or in substitution for, the Registrar's proposed addition.

RE BRYANT & MAY'S TRADE MARK.

[August, 1890. 8 R. P. C. 69 ; 59 L. J. Ch. 763.]

Trade Mark—Essential Particulars—Acts 1883 to 1888, s. 64, sub-s. 1 (c).

Summons to proceed.

In 1889 *Bryant & May Limited*, who had obtained the only gold medal granted for matches at the Barcelona Exhibition, applied to

register in Class 47, as a new mark for wax vestas, a yellow label (intended to go round the match box) on the upper part of which was a representation of the obverse and reverse of the same medal with "Gold Medal, Universal Exhibition of Barcelona" (in ordinary type) written below in Spanish. Below this again were the words "*Bryant & May's* Royal Wax Vestas, London" (in ordinary type), and there were here and there over the label flourishes of the most ordinary kind. The application stated, "The essential particular of the Applicants' mark is '*Bryant & May's*' and the general arrangement of the label." The application was opposed by *Bell & Co.* and was refused by the Comptroller-General. The Applicants appealed to the Board of Trade, who referred the matter to the Court.

Registration refused.

The Applicants' affidavits put forward as a special feature the representation of the medal. It was shewn, however, by the Opponents, that it is a common practice in the match trade to place on match boxes, labels with scrolls and medals imprinted thereon.

8 R. P. C.
73, l. 15.

NORTH, J., referred to the Acts of 1883 to 1888, s. 64, sub-sect. 1 (c), and said :—Now, is this a distinctive device, mark, brand, heading, label, or ticket? We must bear in mind, first of all, that if it contains other matters which are not essential, the Applicant is bound in his application for the registration to state what the essential particulars are, and to disclaim the others. Now, all that he has stated to be the essential particulars here in his application are, first, the name, which I have pointed out is not within the section at all, because the name is not printed in any particular or distinctive manner; and, further, "the general arrangement of the label." There is not a reference there of any sort whatever to what is put forward as the particular special feature, namely, the obverse and reverse of a particular medal, one only of which in this class was granted at a particular exhibition. That is entirely new, and the description and disclaimer required by the Act are not found in it. It is clear that the ground of the application is something which is clearly not described as an essential particular as described by the Act. * * * * * As I pointed out, the only thing shewn on the face of the label itself, that could be in any way distinctive, is this gold medal with the words below it; but the exhibits produced show—and it is notorious in trade marks generally—that medals are the commonest things possible, and from the exhibits before me I have no doubt they are extremely

common in this particular thing. In my opinion there is nothing whatever distinctive in the back and front view of the medal, or the descriptive words "Gold Medal, Universal Exhibition of Barcelona," which accompany it.

RE BURGOYNE'S TRADE MARK.

[February, 1889. 6 R. P. C. 227; 61 L. T. 39.]

Trade Mark—Fancy Word—Act of 1883, s. 64, sub-s. 1 (c).

Summons to proceed.

On the 29th of Dec. 1887, *P. B. Burgoyne*, trading as the Australian Vineyards Association, applied to register the word "Oomoo" as a trade mark for wine and spirits. The application was opposed by *W. W. Pownall*, trading as the Australian Wine Co., on the ground that he was the registered owner of a trade mark, consisting of a representation of the bird "Emu" and of the word "Emu," and that the word "Oomoo" was so like the word "Emu" as to be calculated to deceive. On the matter coming before the Court, the Judge held that on this point the opposition failed. In reply, however, to *Pownall's* first objection the Applicant stated that the word "Oomoo" was an aboriginal (Australian) sound signifying "choice," a statement that was at once seized upon and amplified by *Pownall*, with the view of shewing that the word "Oomoo" was not a fancy word in common use as applied to wine. Affidavits were filed on both sides and the parties were cross-examined. It appeared that an Australian wine was exhibited in the Colonial and Indian Exhibition of 1886 under the title of "Oomoo," but no other instance could be brought before the Court, of the use of the word in either Australia or England.

Registration allowed.

CHITTY, J. :—Then I have to consider the Applicant's case on the well-known 64th section of the Act of 1883, Is the word a fancy word not in common use? The word "Oomoo" expresses nothing to the ordinary Englishman. The word "Oomoo" is obviously meaningless with reference to wine. Nobody ever heard up to this moment—at least, Englishmen have not up to this moment habitually used the term; and nobody that I know of has ever asked for a glass of "Oomoo." The term itself appears on the face of it to be a fancy term manufactured out of four "o's" and one "m." Then is it less a fancy word because some one has

6 R. P. C.
231, l. 41.

heard that the term "Oomoo" has been used by the Aborigines of Australia? I should say not. Words that are used in the European languages may be known in this country; and I have already given a judgment in the *Bocköl* case (*Re Davis & Co.'s Trade Mark, infra*, p. 105), with reference to that point; but if you take a word, say from the centre of Africa, and prove that it has been used simply by the inhabitants there, it appears to me that you have not gone any distance on the way to shew that the word is not a fancy word.

6 R. P. C.
232, l. 3.

I come to the conclusion that the word, if it does mean "choice," or if it ever meant "choice" in the aboriginal language of Australia, does not mean "choice" to an ordinary Englishman, or to a sufficient number of Englishmen, in this country to enable me to say that it has any meaning. I think it is a meaningless word (within the fair principle which the C. A. adopted in the *Electric Velvet* case (*infra*, p. 334), with reference to wines and spirits. As to there growing up a trade in "Oomoo" with the Aborigines of the Australian continent, I think that is far fetched, and a great deal too fanciful a notion for me, sitting here as a Judge, to proceed upon.

Well then, is it in common use? The evidence shews it is not.

RE THE BURHAM BRICK, &C., COMPANY'S TRADE MARK.

[July, 1892. 9 R. P. C. 422.]

Trade Mark—Old Mark—Act of 1883, s. 92.

The Burham Brick, &c., Company, who were the owners of two old trade marks, each of which contained at the top the words "Burham Works" and at the bottom the words "Murston Works," applied for leave to strike out these words, and to substitute for "Burham Works" the word "Burham," and for "Murston Works" the word "Works."

STIRLING, J., granted the application.

BURLAND v. BROXBURN OIL COMPANY ;
RE BURLAND'S TRADE MARK.

[July, 1889. 6 R. P. C. 482 ; 42 Ch. D. 274 ; 58 L. J. Ch. 816 ; 61 L. T. 618 ;
38 W. R. 89.]

*Trade Mark—Distinctive word common to the trade—Disclaimer—Act of 1883,
ss. 64, sub-s. 1 (c), 74, sub-s. 1 (b) and 2, and 90.*

Motion in action to restrain infringement and passing off. Cross motion to rectify.

In 1888 the Plaintiff registered, as a new trade mark for a laundry preparation, a label on which were printed the word "Washerine" (several times), the signature of the firm *F. A. Burland & Co.* and laudatory matter and directions for use. This preparation the Plaintiff sold in bottles to which the label was affixed. The Defendants also sold a laundry preparation which was in a solid form or tablet, and was sold in boxes. On the outside of the boxes were the words "Broxburn Washerine," with a picture and other embellishments which were distinct from anything on the Plaintiff's bottles. Inside the boxes were directions for use which stated that this "Washerine" was made by the *Broxburn Oil Company, Limited*.

The Plaintiff's motion was refused. Upon the Defendants' motion an order was made directing the Plaintiff to disclaim the word "Washerine."

CHITTY, J.—The term "Washerine," according to the decisions, which it is not necessary I should go through, on the Act of 1883, is a term which is not obviously meaningless, but is a descriptive term. It is the ordinary English "Wash" with a very ordinary termination added to it, such as may be found in many other instances which are given in the affidavits on the part of the Defendants. It is a common termination. Such a word as that is not a fancy word within the 64th Section of the Act of 1883.

Then in regard to the second part of the motion, what is there? What have the Defendants done? Why nothing, except use this term. The Plaintiff has no proprietary right in the term at all. * * * So that the second part of the case resolves itself simply into this, that the Defendants are using a term in which the Plaintiff has no proprietary right whatever, and are using it to designate the goods they sell. The goods, no doubt, to a certain extent, are in competition. There is not a sign against

6 R. P. C.
485, l. 56.

6 R. P. C.
486, l. 6.

the Defendants that what they are doing is calculated to deceive the public.

6 R. P. C.
487, l. 50.

Undoubtedly, the Respondent has a good trade mark with reference to the written signature of the firm, and he says that he is entitled to register with that, without any disclaimer, the term "Washerine," as being, as I have said before, a mere simple addition to the trade mark, and a word in respect of which he can claim no rights. * * * * His Lordship read sect. 74, sub-sect. 1, and said:—

6 R. P. C.
488, l. 3.

It is clear from some portions of the subsequent part of the enactment that something which can be registered as an addition to the trade mark is not part of the trade mark, because the subsequent enactment contains a provision for a disclaimer of some of this additional matter, and if on the face of the register the person registering, disclaims a part of the addition, it is plain that that part of the addition so disclaimed is not part of the trade mark.

His Lordship, after reading sect. 74, sub-sect. 1 (b), continued:—

6 R. P. C.
488, l. 19.

Now, staying there for one moment, the term distinctive, as has been pointed out by Mr. *Sebastian* in his book, is not consistent with the rest of the section, because if the word is common to the trade, it is not distinctive. Therefore, I take it, it means any word which is *prima facie* distinctive, or which otherwise might be distinctive. Of course directly it is really found to be common to the trade it ceases to be distinctive; but I think the meaning of it must be a word which is *prima facie* distinctive.

6 R. P. C.
488, l. 28.

Then, in the case before me, the word "Washerine" clearly was inserted on the Register, as is shown by the evidence before me, as a distinctive word; and I take it that this part of the enactment "any distinctive word" relates back to the 64th Section, where the term "fancy word or words not in common use" occurs, and as I read that section—and in conformity with what I understand to be *COTTON, L.J.'s** opinion upon it—the word "distinctive" runs through the whole of the sub-sect. (c), so that the phrase stands "a distinctive fancy word or words not in common use."

6 R. P. C.
488, l. 44.

I have to ascertain what is the meaning of the phrase "common to the trade," and the Respondent's argument is that those words are not used in their grammatical signification, but that they mean in common use in the trade. * * The argument in support of the interpretation of the words "common to the trade" as being equivalent to "commonly used in the trade" is founded on the

* See *Re Waterman's Trade Mark*, *infra*, p. 339.

third proviso of this 74th Section. * * It would have been a question whether user by three or four, or five or six persons would have made a word or combination of words common to the trade, and the proviso is introduced merely for the purpose of settling that question, which might have been a difficult one of fact, and saying that where you have user in the trade by more than three persons, then the name so used shall be deemed to be common to the trade. But that is only a particular case, and it has not the effect of defining the meaning of the term. * * The phrase "common to the trade" is not to be interpreted otherwise than according to the ordinary rules of grammar, and I think "common to the trade" means exactly what it says. I cannot really make use of a better term, but I can make use of a term which I think exactly corresponds with the meaning—I do not say it is better—that it is "open to the trade."

RE THE CALIFORNIAN FIG SYRUP COMPANY'S TRADE MARK.

December, 1888. 6 R. P. C. 126 ; 40 Ch. D. 620 ; 58 L. J. Ch. 341 ; 60 L. T. 590 ; 37 W. R. 268.]

Trade Mark—Registration abroad—Act of 1883, s. 103—International Convention, 1883, Article 6.

Motion to proceed.

In 1885 the above-mentioned Company registered a trade mark in the United States, and in 1888 they applied to the Comptroller to register the same trade mark in England. The Comptroller refused registration ; and on appeal to the Board of Trade the matter was referred to the Court.

Registration refused.

The International Convention (*supra*, p. 33), though acceded to by some countries, in *March*, 1883, was not acceded to by Great Britain till 1884.

STIRLING, J., read and discussed the Act of 1883, sect. 103, sub-sect. 1 (*supra*, p. 20) and continued :—I cannot see that there is any doubt as to the meaning of that provision ; it is an essential of the application under that part of the section that the Applicant should apply within four months from the time of his applying for the protection in the foreign State with which the arrangement is in force.

6 R. P. C.
129, l. 8.

Then I pass on to sub-sect. 3 :—"The application for the registration of a trade mark under this section must be made in

the same manner as an ordinary application under this Act." Again I can see no doubt there that the words "application under this section" refer to what is mentioned in the prior part of the section. There is no new application mentioned or referred to there. Then comes the proviso which gives rise to the doubt, and that is this:—"Provided that in the case of trade marks any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act." Now, reading that in the ordinary way and applying the ordinary rules of construction thereto, it is simply a qualification of the previous part of sub-sect. 3; and the previous part of sub-sect. 3 having provided that the application must be made in the same manner as an ordinary application under the Act, this part goes on to relieve the foreigner who applies in this country for registration from certain of the liabilities of subjects of this country and provides that any trade mark, the registration of which has been duly applied for in the country of origin, may be registered under this Act.

Now I am not going further in this case than is necessary for a decision of the particular point before me, and I am not going to express any opinion as to how far that proviso extends or from what liabilities it emancipates a foreigner.

6 R. P. C.
129, l. 39.

But I must notice the argument which was addressed to me, which is founded on this, that the convention which was entered into in *March*, 1883, between certain States, but to which Her Majesty was not at that time a party, does apparently provide, in Article 6, that every trade mark duly registered in the country of origin shall be admitted for registration and protection in the form originally registered in all the countries of the union. By that article Her Majesty is now bound. Certainly, according to my construction of the Act, the Act does not afford the means of carrying out that article, and it will no doubt be for Her Majesty's Government to consider—and seeing the Attorney-General here I have no doubt they will consider—what legislative steps ought to be taken to give effect to that article if necessary. But with that I have nothing to do.

RE THE CARTER MEDICINE COMPANY'S TRADE MARK.

June, 1892. 9 R. P. C. 401; (1892) 3 Ch. 472; 61 L. J. Ch. 716; 41 W. R. 13.]

Trade Mark—Acts 1883 to 1888, ss. 64, 103—International Convention, 1883.

Motion to proceed.

In 1891 the Carter Medicine Company (an American Company) registered in the United States a trade mark, consisting of the words "Carter's Little Liver Pills" printed in plain block type.

In 1892, the company applied to register the same mark in England, disclaiming the words "Carter's Pills." The Comptroller refused registration—Appeal to Board of Trade—Appeal referred to Court.

Registration refused.

The trade mark admittedly did not fall within the Acts of 1883 to 1888, s. 64, and the only question was, whether the registration in America entitled the Applicants to registration here.

NORTH, J., referred to the International Convention, 1883 (*supra*, p. 33), the Act of 1883, s. 103 (*supra*, p. 20), and the circumstances existing at the date of the passing of the Act of 1883.

The result was this, that a person applying in America for a patent would have not only to obtain one there, but to take proceedings to secure his rights here at the very first moment before any person in America could obtain information as to the nature of his invention. Many a person obtained a patent in one country and failed to get it in others, because he had been anticipated by persons who used greater expedition, but who had no merits of their own. Then the Act goes on to provide that if any such future arrangements for mutual protection are made, then any person who has "applied for protection for any invention, design, or trade mark shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act in priority to other Applicants." It does not mean therefore that he is to be entitled out and out to registration, but that what is secured to him is priority over other Applicants.

9 R. P. C.
403, l. 44.

With reference to the proviso at the end of s. 103, sub-s. 3, his Lordship said :—We are not to test it by considering what the law requires in a foreign country, but we are to consider what has been actually done with respect to the matter; and "the registration of which has been duly applied for" means an application made—not that it is to be tested by the law of the country there,

9 R. P. C.
405, l. 22.

but that if application is made there, then application may be made here. The application there may fail, and the application here may fail. In my view the meaning of the section is that, in either case, it is the application which is justified here where there has been a due application there.

9 R. P. C.
405, l. 35.

This section applies not only to where there has been registration, but to where there has not, and where only an application has been made; and in that case, where there is no test that you can fall back upon in that way, we should have all the evils of having to investigate in this country whether the application made there was a due application according to American law or not. Under these circumstances I cannot accede to the application made.

CHEAVIN v. WALKER.

[C.A., May, 1877. 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. 938.]

Trade Mark—"Patent."

Action to restrain infringement.

Since 1867, the Plaintiff had manufactured and sold filters each of which bore a tablet with the words "*G. Cheavin's Improved Patent Gold Medal Self-cleaning Rapid Water Filter, Boston, England,*" stamped on it; above these words was a medallion containing the royal arms, surrounded by a band or garter with the words "By Her Majesty's Royal Letters Patent." The filters were generally known and asked for in the trade and by the public as *Cheavin's* filters.

The Plaintiff's filters were made in accordance with a patent taken out by the Plaintiff's father and himself in 1862, but which had expired in 1862.

The Defendants were formerly in the Plaintiff's employ and were now manufacturing and selling filters made upon the principle of the Plaintiff's filters, and bearing externally so close a resemblance to them that the difference between them was not perceptible except upon a close examination.

The Defendants placed upon their filters a tablet or inscription bearing the following words:—"S. Cheavin's Patent Prize Medal Self-cleaning Rapid Water Filter, improved and manufactured by *Walker, Brightman & Co., Boston, England.*"

BACON, V.-C., granted an injunction.

Appeal to the C. A. (Jessel, M.R., James and Baggallay, L.JJ.)

Appeal allowed.

JESSEL, M.R.—The first question which we have to consider is, whether the Plaintiff has any trade mark at all. I am of opinion that he has no trade mark. What he uses is an inscription which he chooses to place or bake on his filters, and which tells its own story. * * It is not possible to say that such an inscription is a trade mark. The second question is with regard to the effect of the use of the word “patent” by the Plaintiff. The question was fully discussed in the case in the House of Lords, *Leather Cloth Company v. American Leather Cloth Company*, 11 H. L. C. 543, and I have nothing to add to what was there said. No doubt a man may use the word “patent” so as to deceive no one. It may be used so as to mean that which was a patent, but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark. Protection only extends to the time allowed by the statute for the patent, and if the Court were afterwards to protect the use of the word as a trade mark, it would be in fact extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade mark.

But further, no man can claim a trade mark in a falsehood. It is a falsehood to represent that the patent is still subsisting. Therefore the Court has to consider, in the present case, whether there is such a false representation on the Plaintiff’s filters. Above the inscription there is a medallion consisting of the royal arms surrounded by a circular band or garter containing the words, “By Her Majesty’s Royal Letters Patent.” That appears to me to be a representation that the patent is an existing patent. And on that ground alone I think the Plaintiff ought not to succeed in this action.

As to the third ground relied on by the Plaintiff, that supposing the inscription not to be a trade mark, it is an advertisement, which the Defendants have fraudulently imitated, I cannot see any fraudulent imitation in the Defendants’ label.

His Lordship read the Defendants’ label, and continued :—

That is to say, that the filter is manufactured according to *Cheavin’s* expired patent by *Walker, Brightman & Co.* I can see no fraudulent imitation in that statement. Fraud is the founda-

5 Ch. D.
862.

5 Ch. D.
863.

tion of all this branch of jurisdiction, and unless fraud is proved, this Court ought not to interfere.

5 Ch. D.
863.

JAMES, L.J.—I am of the same opinion. It is clear that on the expiration of this patent, it was open to all the world to manufacture the article which had been patented; that is the consideration which the inventor gives for the patent; the invention becomes then entirely *publici juris*. The Plaintiff, and also the Defendants, had a right to tell the world that they were making the article according to the expired patent, and both parties have done this. It is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a trade mark. Whatever is mere description is open to all the world. In the present case the Plaintiff's label was nothing more than a description, and he cannot therefore have protection for it as a trade mark.

RE CHORLTON & DUGDALE'S TRADE MARK.

[July, 1888. 53 L. T. 337; 34 W. R. 60.]

Trade Mark—User—Act of 1875, s. 10.

Motion to expunge.

In 1876 *Chorlton & Co.* registered as an old mark in respect of Spring Mattresses, the words "Excelsior Spring Mattress." In 1883 they commenced an action for infringement against Messrs. *Billington Brothers*, who thereupon moved to expunge the trade mark from the register, on the ground that the word "Excelsior" had not been used as a trade mark before the passing of the Act of 1875.

It was proved that *Chorlton & Co.* and their predecessors in title had manufactured spring mattresses under a patent granted in 1871, and that the name "Excelsior Spring Mattress" was used upon bill-heads, circulars, invoices and advertisements, to describe the particular kind of mattress manufactured under that patent, that the firm had had made a flexible indiarubber stamp with the words "The Excelsior Spring Mattress, *Wood's Patent*," and with it stamped the wood-work of all the mattresses they sold. They also had had a photograph taken of one of the mattresses with a label attached to it, upon which the only word visible in the photograph was "Excelsior," and used the photograph largely in applying for orders.

The mattress had been very extensively advertised by the name "Excelsior."

Motion refused.

PEARSON, J., referred to *Re Palmer's Trade Mark* (*infra*, 34 W. R. p. 261), and said:—I am bound by the decisions to say, that there must be a user of the trade mark in the ordinary sense of the word user, and that I am not at liberty to interpret the provision of the Act, as indicating that any name which a trader had used with regard to his goods,—not affixing a label to them, not putting it as a trade mark upon his goods, but simply using it as a name under which he sold his goods—could, under this section of the Act, be registered as a trade mark to which he was entitled. In this case, therefore, I must look and see what user there has been; but looking into *Palmer's* case (*ubi supra*), I come to the conclusion that slight user is sufficient. For in that case the Court asked the parties for some evidence of user, and would have been satisfied if one label had been produced; but it was not produced, and therefore they decided against the trade mark. * * * *

I think that it is quite sufficient evidence of user to have found that, at all events on more than one occasion, the Respondents, and their predecessors in title, did use that word and exhibit it in type so to speak—for that photograph is a photograph of type—upon the goods which they sold.

RE CHRISTIANSEN'S TRADE MARK.

[C.A., February, 1886. 3 R. P. C. 54.]

Trade Mark—Evidence—User—Act of 1883, s. 90.

Motion to expunge.

In 1882, *C. Christiansen* of Norway, match manufacturer, registered in England a new trade mark consisting of the word "Medals," two spaces or "lamps" (per Lord ESHER, M.R.), each of which could be filled up with 2 medals placed one on the top of the other, a cross in the centre and the word "Taendstikker" underneath.

In 1884, the *Nitedals Company*, a Norwegian match manufacturing company, registered in England an old trade mark consisting of the word "Nitedals," two "lamps" each filled up with two medals placed one on the top of the other, an ornament somewhat resembling a cross and the word "Taendstikker" underneath. An illustration of both marks is to be found 3 R. P. C. p. 55.

On motion by the *Nitedals Company* to expunge *Christiansen's* mark, it was proved that the Respondent's mark was intended to be

and was in fact used in the course of trade with medals in the blanks. As to the probability of deception the evidence was conflicting. No case of deception was proved.

CHITTY, J., refused the motion (3 R. P. C. 56), but on appeal the C. A. (Lord Esher, M.R., Lindley and Lopes, L.JJ.) reversed his decision and expunged *Christiansen's* trade mark.

3 R. P. C.
59, l. 50.

Lord ESHER, M.R., referred to his judgment in *Re Worthington's Trade Mark* (*infra*, p. 351) and said :—Are you to look at the marks as printed, or are you to look at the marks as they will probably be used in the course of trade? In my opinion you are to look at them as they will probably be used in the course of trade.

3 R. P. C.
60, l. 10

If so used in the course of trade with the medals in, is the mark so like the Appellants' marks which are used with medals in them, that it would be calculated to deceive?

Now how are we to try that question? First of all it has been held that a Judge in trying that question would not be entitled, contrary to the will of the parties, to say, "I will judge of these things by my eyesight only without hearing any evidence at all."

* * But now let us consider how you are to use that evidence. It is quite true that you must not try it exclusively by your eyes. It is equally true to my mind that you must not try it exclusively by the evidence. You must use both. You are called upon to decide what in your belief and conscience you think as to whether one thing is so like another as that it will be calculated to deceive; and as you are an intelligent being yourself or supposed to be, you must use your eyes and your thoughts, and not go blindly and act upon evidence which is given by people. Therefore you must look upon it with your eyes and with your own powers of thought and opinion accompanied with, and, if the evidence is satisfactory to you, directed by, the evidence which is given. But when you come to consider the evidence, you being the person to decide on the effect of it, must not only look at what people say but you must exercise your own opinion as to whether what they are saying is sensible or can be accepted. If a man was to come and tell me that a horse was like a cat, he might swear it, and you might get fifty persons to swear it, but I should not act on such evidence, because it is pure nonsense.

3 R. P. C.
61, l. 28.

Now let us see what it is we are to consider. We are to consider whether the one trade mark is so like the other trade mark that it is calculated to deceive. What is the trade mark? The trade mark is not the distinguishing feature of the trade

mark. The trade mark is not one part of the matter. The trade mark is not in the one case "Medals" and in the other case "Nitedals." That is not the trade mark. If you say that, you strike out all the rest. The trade mark is the whole thing, the whole picture on each. You have therefore to consider the whole.

Now calculated to deceive whom? * * It is not a person who carefully looks at it who is to be regarded, it is a person who only looks at it in the ordinary way: what is the ordinary way? We know that people who go in and buy a box of matches do not look at it in a very particular and careful way, and do not turn it round to see the mark. Now this is the case of a man who asks for one or the other; but supposing a man goes into a shop having in his own mind to buy one or the other, and sees them both together on the counter, is there anything which would draw his attention from one to the other? After hearing the evidence, and taking into account the evidence but also looking at these things, the conclusion of fact to which I come is, that he might be easily deceived and take up the thing which he did not mean to take up. Therefore, putting it in what way you will, I am of opinion that, if these things are used in the ordinary way and looked at in the ordinary way by ordinary people, there is likely to be a mistake. 3 R. P. C.
62, l. 4.

LINDLEY, L.J.—I have come to the same conclusion. I think, if we look at the two boxes as they are sold and issued in the trade, the resemblances between the two are so great that, although there are differences which might be detected, yet those differences are not so obvious as to make the whole dissimilar. * * * * If the dissimilarity is so small and the common features are so numerous that the two as a whole are similar, the dissimilarity goes for nothing, and the more there is that is common and similar the more difficult it is to make the dissimilarity striking. When you look at the whole, then it appears to me, I confess, that the dissimilarity is not enough to make the whole dissimilar. 3 R. P. C.
63, l. 3.

The present application is to strike off the Respondents' trade mark. I did at one time feel some difficulty about that, because the registered trade mark is by no means so similar to the Appellants' mark as the two boxes are; but I think that the view taken and expressed by the Master of the Rolls is correct, that you must look at these things, which are registered, as they are intended to be used and as they will be used, in the trade. 3 R. P. C.
63, l. 48.

3 R. P. C.
64, l. 6. LOPES, L.J.—I am of opinion that we must look at the registered trade mark of the Respondent as if filled up with what was intended to be placed there, and which in the course of business and of trade would be put there.

RE HENRY CLAY AND BOCK & COMPANY'S TRADE MARK.

[July, 1892. 9 R. P. C. 449 ; (1892) 3 Ch. 549 ; 67 L. T. 614.]

Trade Mark—Old Mark—Alteration—Act of 1883, s. 92.

Motion.

A registered trade mark consisted of the words "La Paz de China De A. L. Habana" enclosed in an oval. The mark was an old one. A. L. were the initials of the registered proprietor.

The mark was subsequently transferred to *Julian Alvarez* and then to *Henry Clay and Bock & Co. Limited*, who now applied to alter the trade mark by substituting "Julian Alvarez" for "A.L." The Comptroller-General opposed.

Motion refused.

9 R. P. C.
451, l. 6.

KEKEWICH, J.—CHITTY, J., has distinctly said in *Phillips' Trade Mark* (*infra*, p. 268), referring to *Guinness' case* (*infra*, p. 139), that the 92nd section authorizes such an addition as he allowed in the last-mentioned case, *Guinness' trade mark* being an old mark. I am content without further inquiry to consider that the 92nd section does allow an addition to or alteration in an old mark. As I have already said, it would be difficult to limit the words to new marks ; but when you approach old marks you do so from this point of view. Those who have registered old marks were not bound to comply with the Act now in force, nor were they bound to comply with the Act before in force as regards the details—what are called essential particulars ; but user before 1875 was the test, and provided that that user was established, the trade mark was allowed to be registered, and, if I may say so, rightly, without regard to the essential particulars required for the registration of a new mark. The consequence of that is put by CHITTY, J., in his first reason in *Phillips' Trade Mark* (*infra*, p. 268), where he says (I am reading from (1891) 3 Ch. p. 143), "First, because the mark being claimed as an old mark ought to be registered just as it was used, and to strike out the words 'Trade Mark' would, in the circumstances of a case, be to allow an alteration, which, although it may be in a non-essential particular, would be a material alteration."

9 R. P. C.
451, l. 31.

Then it may be said that that goes too far ; that some alteration

or addition is allowed, and may be reasonably necessary. True : that seems to me to follow, and *Guinness' case* (*infra*, p. 139) was a good example of that.

What I am asked to do here is this : The proprietor of a trade mark has sold his business, or bequeathed it ; or in another case, not here, it may have passed by bankruptcy to the trustee, and the trustee may be carrying on the business for the benefit of the creditors, and, according to the argument—the only argument which could support the present application—on every such occasion the new proprietor would be entitled to come to the Court and say, “This trade mark had formerly the name of the original proprietor on it ; the proprietor is now changed. It was John, it has now become James ; I must alter John into James.” [Or it might be said, “The proprietor] was a man of one name, he has sold it to a man of an entirely different name with different initials, or a different abbreviation, and it must be altered in order to preserve the trade mark in the new proprietor.” That seems to me to be entirely inconsistent with the idea of an old trade mark altogether, and I fail to see any urgent reason for the alteration. We all know how business is carried on in the name of old firms, notwithstanding that those who originally composed the firm have died or retired long since ; and if I were to grant this present application, I might in a very short time be called upon to grant another.

COLLEY *v.* HART.

[November, 1888. 6 R. P. C. 17.]

Trade Mark—Threats—Act of 1883, s. 32.

Motion in action to restrain threats.

Hart was the owner of a trade mark for a holder of paper for a toilet requisite, and of a patent for reeling and perforating such paper. In 1888 he issued a circular stating that *Colley* was infringing his trade mark and patent, and threatening proceedings against all infringers. *Colley* commenced an action to restrain such threats.

NORTH, J.—This is an action founded, so far as it relates to the infringement of the patent, on the 32nd sect. of the Act of 1883. So far as it relates to trade mark it is not founded upon that section or upon any other legal right that I know of that the Plaintiff has. Therefore as to the trade mark I cannot make any order.

RE COLMAN'S TRADE MARKS.

[April, 1891. 8 R. P. C. 209 ; (1891) 2 Ch. 402 ; 60 L. J. Ch. 550 ;
64 L. T. 507 ; 39 W. R. 488.]

Trade Mark—Word "*Trade Mark*"—*Acts of 1883 to 1888*, ss. 64, 92.

In 1888, Messrs. *Colman* registered several labels under the Act of 1883 as new marks, all of which had as part thereof a bull's head with the words "Trade Mark" in juxtaposition.

In consequence of the remarks of FRY, L.J., in *Re The Apollinaris Company's Trade Marks* (*supra*, p. 51), Messrs. *Colman* now moved for leave to expunge the words "Trade Mark" from their labels.

Leave granted on terms of Messrs. *Colman* entering on the register a statement of the essential particulars of each trade mark, and a disclaimer of any exclusive right to the added matter (if any) to the satisfaction of the Comptroller with the right of appeal to the Court.

8 R. P. C.
212, l. 4.

KEKEWICH, J.—It seems to me clear that the Applicants have in their registered trade mark signified that the bull's head is, as the A.-G. said, one of the essential parts of the trade mark, and I think they have done more. I think they have said, putting into English what we are familiar with as schoolmen [in] Latin, that the bull's head is that without which the trade mark is not. It is not only that it is one of the essential parts, but that the other essential parts by themselves would not give them sufficient protection, and, therefore it seems to me that at any rate they are justified in entertaining the doubt, and they have placed the Comptroller and the Court in a difficulty, because they seek to alter that which up to this time they represented in the way which I have stated. Now when the words "Trade Mark" are expunged, that is to say, when the application has been granted, what will remain as the essential part? Who can tell?

8 R. P. C.
212, l. 22.

It seems to me that some such considerations must have been present to the mind of the draftsman of this sect. 92 which is in the Act of 1883, and remains in the Act of 1888, because what the application may be directed to, is the addition or alteration of a mark in any particular, not being an essential particular within the meaning of the Act, and the preservation of the essential particulars is a necessary incident to the application.

8 R. P. C.
212, l. 31.

It is quite true that when [a statement of the essential particulars has in each case been entered on the register] the public will not be informed, as I understand, not even in the Trade Marks Journal, not certainly in the certificate; the label will go forth to the world as a whole, and as being as a whole the trade mark; but there will

RE COLMAN'S TRADE MARKS.

be this important result, that if Messrs. *Colman* thereafter come to protect themselves against infringement, then they will not be entitled to say this or that is an essential part. They will be bound down by the declaration which it is suggested they should make now, and what they now declare to be essential will be essential, and what they do not declare to be essential will not be essential.

RE THE TRADE MARKS OF LA COMPAGNIE GÉNÉRALE D'EAUX MINÉRALES ET DE BAINS DE MER.

[July, 1891. 8 R. P. C. 446 ; (1891) 3 Ch. 451 ; 60 L. J. Ch. 728 ;
40 W. R. 89.]

Trade Mark—Practice—Service out of Jurisdiction—R. S. C., 1883, *Ord. V.* r. 9 (c) ; *Ord. XI.* r. 1 ; *Ord. XII.* r. 30 ; *Ord. LXVII.* r. 5—*Act of 1883*, s. 90.

Motion to set aside service of notice of motion.

The above named Company (being a French Company, and having no place of business in the United Kingdom) were the owners of trade marks registered in England. A notice of motion to expunge these trade marks, addressed to *La Compagnie* and the Comptroller, was served on behalf of Mrs. *E. Saxlehner*, on *La Compagnie*, by leaving it at their Paris address. The original notice bore an endorsement of service upon *La Compagnie*, in the same form as a writ of summons. No leave was obtained for such service.

Service set aside.

STIRLING, J.—I shall begin by considering what the effect of such a notice of motion would be if it were served on some one within the jurisdiction. It would be notice to a person within the jurisdiction, whether a foreigner or not, that the Court was going to be called upon to exercise the jurisdiction conferred on it by the Patents and Trade Marks Acts, 1883 to 1888, with regard to the rectification of the register. 8 R. P. C. 448, l. 47.

His Lordship read the Act of 1883, sect. 90 (*supra*, p. 17), and said :—The service of this notice in accordance with the rules of the Court upon a person within the jurisdiction would, under *Ord. LXVII.* r. 5, be the basis of all subsequent proceedings with reference to the exercise of the jurisdiction of the Court, and in the exercise of that jurisdiction, by virtue of sect. 90, on the hearing of the application, an order might be made with reference to costs. The Court has full power to make such order with respect to the costs of the proceedings as it thinks fit, and therefore if the Court on the hearing of this motion, assuming it to have been brought against a person within the jurisdiction of the Court, thought the 8 R. P. C. 449, l. 5.

case was one in which justice required that costs—not merely of the Applicant but also of the Comptroller, who was a necessary party to the application by virtue of the rule—ought to be borne by the Respondent, it has full jurisdiction to make it; and in the case of any person within the jurisdiction of the Court, the service of this notice would be ample to found the jurisdiction of the Court for making such an order.

8 R. P. C.
449, l. 32.

But it is said, that this is not really service of any document on which further proceedings are to be based, and could not be made the foundation of any further order against the person on whom it is served. If the person on whom it was served was within the jurisdiction, it could be made the basis of such proceedings. An order might be made, as I have pointed out, against him personally for payment of costs. Why, then, is it different as regards a foreigner? It may be that the Court, in the exercise of its jurisdiction, might take a different view with reference to the acts of a foreigner, from what it would do with reference to the acts of a person residing within the jurisdiction, but that would go to the Court's discretion in the exercise of its jurisdiction, and does not affect the question of jurisdiction to award costs conferred by the Act. I do not think that this can be treated simply as a notice, as is alleged, to the Respondents that something is going to be done which affects their interests. The document which is served is a formal document.

His Lordship, after reading Ord. V. r. 9 and Ord. LXVII. r. 5, continued :—

8 R. P. C.
450, l. 1.

So that, if it was to be served according to the rules, the proceeding to be observed was as nearly as may be the mode of service of a writ of summons.

Referring to the way in which *La Compagnie* had been served with the notice of motion, his Lordship said :—

8 R. P. C.
450, l. 10.

So that exactly the same process as would be adopted for the service of a writ has been taken. It seems to me that that was intended to be not merely a notice that something was going to be done which would affect them, but that the jurisdiction of the Court was to be invoked as against the Respondents to that notice of motion, exactly as if they had been resident within the jurisdiction.

His Lordship, after ordering that the name of *La Compagnie* should be struck out from the notice of motion, fixed a day for hearing the motion, and directed that a letter should be sent to *La Compagnie* with a copy of the notice of motion, to state that an application would be made on the day fixed affecting their interests.

COMPANIA GENERAL DE TOBACOS v. REHDER.

[April, 1887. 5 R. P. C. 61.]

Trade Mark—Old Mark—Act of 1883.

Motion in action to restrain infringement.

In 1882 the Spanish Government, who had hitherto had a monopoly of the manufacture of cigars in the Philippine Islands, discontinued such manufacture (which accordingly became open), but upon such discontinuance they granted a lease of their manufactory at Cavite, the seaport of Manila, to the Plaintiffs, and sold to them their stock in trade and the goodwill of their business as cigar manufacturers. The trade marks used for many years by the Spanish Government in connection with their Cavite manufactory consisted of (1) a label containing a complicated device and certain words, and (2) the word "Cavite."

The Plaintiffs subsequently registered, as old marks for cigars, the word "Cavite" (1885) and a label (1886), which was held by the Court to be a reproduction of the Government label (the only alterations being in one or two small particulars in the device, and in some of the words).

The Plaintiffs subsequently discovered that the Defendants were selling cigars in boxes bearing a label which closely resembled the Plaintiffs' registered label, and which also comprised the word "Cavite."

The Defendants admitted that their label was taken from the Government label, but alleged that the Plaintiffs had not any exclusive right to that label. They suggested also that "Cavite" could not be the subject of a trade mark, as it was the name of a distinct place where cigars, including those of the Defendants, were made.

KAY, J., held, upon the evidence, that the Plaintiffs were entitled to the trade marks used by the Spanish Government, and granted an injunction.

KAY, J.—I have no kind of doubt about this. It is said that there is no evidence of any one having been deceived. That is true, but on looking at these two labels for myself, I have no kind of doubt that a label like this used by the Defendants would be calculated to deceive any purchaser in the market who had been accustomed to buy the Cavite cigars of the Plaintiffs, and who, enquiring for a Cavite cigar, had a box of this kind, with this label of the Defendants at the end of it, handed to him.

5 R. P. C.
65, l. 25.

5 R. P. C. 65, l. 46. Then, it appears that recently the Plaintiffs have registered both their label and the word "Cavite." It is said that registration is not good. I am not going to decide that question now. I leave that as an open question to be dealt with when any objection to the registration is made before me.

5 R. P. C. 66, l. 12. The Plaintiffs have registered these words, and the registration gives them, *prima facie*, a right to treat them as a trade mark by the terms of the Act. But I do not rely upon that. What I rely upon is, the evidence of user, which shows that the marks had been used by the Plaintiffs and their predecessors in title for a very long time to distinguish goods of their manufacture, and these Defendants by imitating so closely the label, and using this word "Cavite" in a conspicuous manner, are, in my opinion, doing that which the Court always restrains, namely, attempting to pass off their goods as the goods of the Plaintiffs.

Of course, I have nothing to do with the cigars. They may sell cigars in any way they like, except with this label and this word "Cavite."

CONDY v. TAYLOR.

[May, 1887. 56 L. T. 891.]

Trade Mark—Retail sale under manufacturers' trade mark—Act of 1875.

Action.

The Plaintiffs manufactured and sold in casks a disinfectant known as "Condy's Fluid," which words they had registered as their trade mark under the Act, 1875. The Defendants sold "Condy's Fluid" (purchased in bulk from the Plaintiffs, but alleged by them to be adulterated) in bottles labelled "Condy's Fluid (crimson), warranted genuine." The Plaintiffs brought an action for infringement and passing off. The case as to adulteration broke down. Action dismissed with costs on higher scale.

56 L. T. 892.

KEKEWICH, J.—The Plaintiffs are entitled to protect their trade mark, and with regard to this part of the case, a point has been raised which is entirely new. The Defendants are selling only genuine Condy's Fluid; and, in my opinion, a manufacturer who sells to a dealer in bulk an article generally sold and used in small quantities, without any restriction on its disposal, must be taken to authorise the dealer to sell the article in small quantities as being the manufacture of his vendor. The sale, and the sale in small quantities, is the necessary result of the transaction.

CURTIS & HARVEY v. PAPE.

[March, 1887. 5 R. P. C. 146.]

Trade Mark—Infringement—Passing off.

Motion in action to restrain infringement and passing off.

The Plaintiffs in this case were entitled to a monopoly of the words "Diamond Sporting Powder," and the description of gunpowder by the name "Diamond," or a device of a diamond, was universally taken to mean the Plaintiffs' gunpowder. The Plaintiffs had also registered, as old marks, trade marks the principal ingredients of which were the word "Diamond," and the device of a diamond. The Defendants had, in execution of orders for "Diamond Sporting Powder," described in some instances by the word and in another by the device, supplied his own gunpowder, together with an invoice on which was printed the device of a diamond with a "K" on it. The Plaintiffs moved for an interlocutory injunction.

NORTH, J., held that the Defendant must be restrained from selling, &c., gunpowder, not of the Plaintiffs' manufacture, as or for the Plaintiffs' goods by the use of the word "Diamond" or the device of a diamond. 5 R. P. C. 148.

NORTH, J.—In my opinion the sale of the Defendant's powder as "Diamond Powder" which is *Curtis & Harvey's*, is a breach of their right. They are entitled to the use of a diamond for gunpowder, whether it is described by the letters or by the word "Diamond," or by a picture of it. I am not considering the question of trade mark at all. It does not seem to me necessary to decide this case at present upon that footing. It may be that any question, as to whether what they have done is an infringement of the trade mark, is a larger matter. It is not necessary now to decide that, and I certainly should not decide by anticipation more than is necessary for the present purpose. 5 R. P. C. 149, l. 40.

DAVIS & COMPANY v. STRIBOLT & COMPANY.

RE DAVIS & COMPANY'S TRADE MARKS.

[October, 1888. 6 R. P. C. 207 ; 59 L. T. 854.]

Trade Mark—Fancy word—Norwegian name—Act of 1883, s. 64, subs. 1 (c).

Motion in action to restrain infringement of trade marks consisting of the words "Boköl" and "Bokol," and registered in 1886 by the Plaintiffs, as new trade marks for beer.

Cross motion by the Defendants to expunge Plaintiffs' trade marks.

At the date of the registration, the words were well known terms in the Norwegian and Swedish languages, and were used to describe a particular class of beer.

The Defendants' motion was acceded to, and the Plaintiffs' motion was dismissed.

6 R. P. C.
212, l. 19.

CHITTY, J.—Now I will assume in favour of the Plaintiffs, that the Plaintiffs were the first importers of the article, and the first persons who put the article on the English market under the name of Boköl. In the argument at the Bar it was admitted, and must have been admitted, that the French, German, or Italian words for beer, or a particular class of beer, could not be properly registered here as fancy words for beer brewed in France, Germany, and Italy, and imported into this country. But an attempt was made to distinguish such cases on the ground that the Scandinavian languages are less known in England than the languages of those countries I have mentioned. This argument was founded on the supposed test of the knowledge of an ordinary Englishman. If the argument were well founded, the importer into this country of any foreign article not previously known in this country, could restrain anyone else from using the name by which it was called in the country where it was produced. There must be many foreign wines, to take an example, which are unknown in this country. If their names were connected with or taken from the general name of a district where the vines grew, such names would clearly not be fancy words within the Act, although the name of the district was unknown here. It would be a strange conclusion to hold that the general name of a district would not be a fancy word, but that the general name of the article in the country where it was produced would be. There is no such test as that which has been suggested to be in the Act—that is, the knowledge of a particular language or the knowledge with regard to the subject matter of an average Englishman. It is plain no such proposition could be maintained. A word which is not obviously an unmeaning word to an Englishman of ordinary intelligence, is not a fancy word. That proposition is good, and so it would be good if you strike out from the proposition that part which relates to the ordinary Englishman. But to say that every word is a fancy word, because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained. There

are many good English words descriptive of articles which are unknown to an average Englishman, taking rather a high standard.

Now for the sake of caution and limiting my proposition to the European languages, I am of opinion that in reference to an article produced in a foreign country, and imported into England where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article, is not a fancy word within the meaning of the Act. Fancy plays no part in the creation or composition of the word, or in its application to the article.

RE DUNN'S TRADE MARK.

[H. L. June, 1890. 15 A. C. 252; 63 L. T. 6; 39 W. R. 161; 7 R. P. C. 311.]

Trade Mark—Words calculated to deceive—Act of 1883, s. 73.

Summons to proceed with opposed application.

In 1887, *W. G. Dunn* (the Respondent) applied to register as a new trade mark a label representing a woman holding up a dish of cakes, with the words "*Dunn's Fruit Salt Baking Powder*," "*The Cook's Best Friend*." The application was opposed by *J. C. Eno* (the Appellant), on the grounds: 1st, that the mark was an infringement of his registered trade mark "*Fruit Salt*;" 2nd, that the use of the term "*Fruit Salt*," as proposed by the Respondent, was calculated to deceive. The Respondent took out a summons that, notwithstanding the opposition, the application might be proceeded with by the Comptroller, disclaiming any right to the exclusive use of the words "*Fruit Salt*." *Eno* claimed to be the inventor of a powder known as "*Fruit Salt*," in respect of which in 1877 he registered the words "*Fruit Salt*" in Class 3, as an old trade mark for a "proprietary medicine for human use," and in 1878 the same words as an old trade mark in Class 42 for a "dry preparation for making a non-intoxicating beverage." *Eno* was also the registered owner of a trade mark for the above-mentioned "dry preparation," consisting of a label on which was a device of grape leaves and grapes, surrounding (amongst other things) the words "*Eno's Fruit Salt*."

It was proved that the term "*Fruit Salt*" had not been used prior to *Eno's* adoption of it, as descriptive of any substance; that *Eno* adopted the term for the purpose of describing his powder; and that, at the time *Dunn* applied for his trade mark, *Fruit Salt* had become well known by the public and was largely dealt in as

an article of commerce. It was also proved that before this litigation was contemplated, two persons at least used *Eno's Fruit Salt* with success as baking powder.

Upon the hearing of the summons before KAY, J., the Appellant being unable to prove that "Fruit Salt" had been used as a trade mark before the passing of the Act of 1875, submitted to an order to remove the two first of his trade marks from the register and confined his opposition to his second ground.

KAY, J. (41 Ch. D. 439 ; 6 R. P. C. 148), dismissed *Dunn's* application.

6 R. P. C.
151, l. 15.

KAY, J., dealing with the Comptroller's discretion under the Act of 1883, said :—The question whether the Comptroller shall, in the exercise of the discretion which the Act gives to him, register a trade mark, is a very different question from any other questions upon a trade mark made that can be raised. He is quite within his duty, and he is quite entitled, in my opinion, if he thinks that—either because there are words in it, the exclusive use of which would be calculated to deceive, or otherwise (those are the words of the Act)—there is sufficient reason to say, "No, I do not think it is proper to register this trade mark."

The C. A. (Lindley and Fry, L.JJ. ; Cotton, L.J. dissenting), reversed this decision, and made an order that the Comptroller should proceed with the application (41 Ch. D. 444 ; 6 R. P. C. 379).

6 R. P. C.
382, l. 48.

COTTON, L.J.—In my opinion, [the trade mark in question] is calculated to deceive within the meaning of the section to which I have referred—namely, the 73rd section. The late M.R. said, in *Re Horsburgh* (*infra*, p. 166), that that section must be confined to cases where the words were in themselves deceptive. I cannot agree with that. If the words are deceptive, though they are not in themselves deceptive—and it is rather difficult to see how a word can in itself be deceptive, unless you know the facts, and that they are an incorrect representation, or it is shewn that they are false—but if for any reason, even with reference to another trade mark, they are deceptive, in my opinion the case comes within clause 73. Although it is different from clause 72, which points to the likeness of the two trade marks which are registered, or attempted to be registered, yet I think this does come within sect. 73, and that it is the duty of the Court if it is so satisfied, not to order registration, and to prevent such a trade mark from being registered.

6 R. P. C.
383, l. 17.

LINDLEY, L.J.—I am sorry to say that in this case I take a

different view of the rights of the parties to that expressed by COTTON, L.J. The view which appears to me to be correct turns really on the true construction of sect. 73, and the application of that to the facts of the case. * * When you come to study that section it appears to me that the object of it is this : to forbid the registration of any words as part of a trade mark the exclusive use of which would be deemed disentitled to protection in a Court of Justice, by reason of their being calculated to deceive or otherwise. What we have got to ask ourselves in reference to that section is this : whether we can say that the exclusive use by Mr. *Dunn* of these words "Fruit Salt" would be deemed disentitled to protection in a Court of Justice, by reason of their being calculated to deceive. 6 R. P. C.
383, l. 53.

Now the proper interpretation of that section has been discussed before, and I think myself that the late M.R., in *Horsburgh's* case, put upon that section the true construction. One must not forget in construing that section that there is a section immediately preceding it which protects persons already upon the register in respect of their trade marks. "The Comptroller shall not register, with respect to the same goods or description of goods, a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive." That section adequately protects Mr. *Eno* himself, and, of course, if Mr. *Dunn* were seeking to register a trade mark which falls within that sect. 72, he would not obtain liberty to do it. But the two trade marks are so essentially different that even Mr. *Eno* does not say that the trade marks are so like one another as to enable him to keep Mr. *Dunn* off the register by means of sect. 72. He is forced back on sect. 73. If I am right in thinking that sect. 73 ought to be construed in the way in which it was construed by the late M.R., and the way in which, I think, the language of the section compels us to construe it, then I think that Mr. *Dunn* is not within it. That is to say, looking at his proposed trade mark, if he had the exclusive use of those words, or the words "Fruit Salt," you cannot say that the exclusive use of those words would be deemed disentitled to protection in a Court of Justice on any ground whatever. Therefore, not giving Mr. *Dunn* credit for having taken the words "Fruit Salt," apart from Mr. *Eno's* use of the words—because I think he selected them because he thought they would be useful to him, and, as I say, he has sought to obtain the benefit of the words, although not the benefit of the trade—it appears to me

that he is not hit by either of those sections, and that therefore he cannot be shut off the register.

I am quite aware that Mr. *Eno* has brought a mass of evidence to show that "Fruit Salt" means "*Eno's* Fruit Salt"; but I cannot overlook the fact that Mr. *Eno* has himself done that which, I think, he had no business whatever to do. He has procured himself to be registered in respect of the words "Fruit Salt" alone, and he was on the register in respect of those words for some years; and it is only when his right to those words is challenged, and he finds it untenable, that he drops it. But what is the effect of that? The effect of that is to have given him an advantage which in point of law he was not entitled to at all, and he is not now entitled to avail himself of the consequences of that illegal proceeding in order to extend his monopoly. I do feel the danger, which the Lord Justice does not think so much of, that if we decide this matter in favour of Mr. *Eno* we shall be giving him that which he is not entitled to; that is to say, the exclusive right to the use of the words "Fruit Salt," whether in connection with baking powder or anything else which can be brought within the classes in which Mr. *Eno* is registered.

I am therefore of opinion that this appeal ought to succeed.

6 R. P. C.
334, l. 45.

FRY, L.J.—Whatever construction we may put on the 73rd section, whether the larger or the narrower one that has been suggested, the only question in the present case is this: whether the use of the words "Fruit Salt" by the Applicant, Mr. *Dunn*, is calculated to deceive. It is not suggested that that section of the Statute can apply for any other reason, and therefore the fundamental question in this case, and the only one on which I shall express a judgment is this: Are those words, "Fruit Salt," as used by Mr. *Dunn*, calculated to deceive? I am of opinion that they are not.

Appeal to the H. L. (Lord Halsbury, L.C., Lords Watson, Herschell, Macnaghten and Morris).

Appeal allowed (Lords Halsbury and Morris dissenting), and decision of KAY, J. restored.

Lord WATSON, after referring to Act of 1883, sects. 72, subs. 2, and 73 (*supra*, p. 11), said:—

7 R. P. C.
315, l. 52.

These prohibitory clauses cast upon the Applicant the duty of satisfying the Comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, he does not hold the same position which he would have occupied if he had been defending himself

against an action for infringement. There, the *onus* of shewing that his trade mark was calculated to mislead, rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed.

I do not suppose that persons intending to bake would buy *Eno's Fruit Salt*, or that persons desiring to indulge in an aperient drink would invest in *Dunn's Fruit-Salt Baking Powder*. But I do think that there would be a supposed connection between the two articles in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the Appellant's Fruit Salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder. 7 R. P. C.
316, l. 26.

It was argued that to give effect to these considerations would be equivalent to allowing the Appellant to appropriate, as his own property, two words in common use. The argument appears to me to underrate the resources of the English language, which are, in my opinion, quite sufficient to enable anyone honestly desirous of distinguishing his own goods, to use these words in a trade mark in such a manner as to prevent any possibility of their being connected with the Appellant's Fruit Salt. 7 R. P. C.
316, l. 43.

Lord HERSCHELL:—I give credit to the evidence, which I see no reason to differ from, that the idea suggested by the words to those engaged in commerce, and to the public at large, would be Mr. *Eno's* powder, and that alone. 7 R. P. C.
317, l. 29.

Assuming this to be so, the next question is, would the words in the collocation in which they are found in the proposed trade mark of the Respondent, viz., "*Dunn's Fruit-Salt Baking Powder*," be calculated to deceive. I do not understand it to have been doubted that if this language would induce the public to believe that *Eno's* Fruit-Salt powder was an ingredient of the baking powder or employed in its preparation, or that the Appellant was connected with the manufacture of the baking powder, the proposed trade mark would be open to objection. But it is said that there would be no danger of any such notion being acquired by the public, that an aperient medicine and a baking powder are such essentially different things that no one would imagine that the one could enter into the composition of the other. I think this is scarcely a fair statement of the case.

7 R. P. C.
317, l. 49. I may say at once that, in my opinion, the Appellant has no exclusive property in the words "Fruit Salt," and if it were proposed so to employ them that no reasonable person could suppose that they had reference to the Appellant's preparation such a use would be perfectly unobjectionable. For example, I cannot conceive anyone imagining that a "fruit-salt umbrella" was in any way connected with the article manufactured by Mr. *Eno*. And numberless similar illustrations might be given. But I am unable to arrive at the conclusion that Fruit Salt and baking powder are of so essentially different a character, that the one could not be supposed to enter into the composition of the other. The evidence appears to me to be cogent the other way.

7 R. P. C.
318, l. 4. It was said, I have no doubt truly, that the Appellant had never advertised or sold his preparation as a baking powder, and that his powder and the Respondent's were not likely to be sold, the one for the other. But this does not, to my mind, dispose of the evidence. Seeing that "Fruit Salt" would mean, in the eyes of the public, the Appellant's powder, and that it had occurred to people to use it for the purpose of baking, does it not seem highly probable that the words "Fruit-Salt Baking Powder" would convey widely the idea that the Appellant's powder was one of its principal ingredients? I cannot avoid the conclusion that it would, and that the proposed use of the words "Fruit Salt" would be calculated to deceive. But I do not think it is necessary to go so far as this. I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the Respondent as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the Statute. Those sections prohibit the registration of a trade mark in certain specified cases, but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion, whether to register or not, appears to me to be in all other cases plainly conferred. Of course this discretion must be reasonably and not capriciously exercised; but it is, in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it.

7 R. P. C.
318, l. 38. Lord MACNAGHTEN:—Ever since Courts of Equity have interfered to protect traders in the exclusive use of marks and words, which they have lawfully appropriated for the purpose of distin-

guishing their goods, it has been an established principle that this protection is not to be extended "to persons whose case is not founded in truth." That is said to be "a clear rule."

Unfortunately in the competition for business a trader not unfrequently endeavours to attract custom by representing that the goods which he offers for sale are different in origin, composition, or character from what they really are. The public are constantly tempted to buy one thing when they think they are buying another. It is not, as has been observed, the province of the Court to protect speculations of this kind. Between rival traders the application of the principle is necessarily a matter of extreme difficulty. But as between the innocent public and a trader seeking registration of a proposed trade mark, there is, I think, no room for hesitation or doubt. The Statute allows any person to oppose an application for registration, whether he has or has not a personal interest in the result. It declares that it is not lawful to register as part of, or in combination with, a trade mark, any words, the exclusive use of which would, by reason of their being calculated to deceive, be deemed disentitled to protection in a Court of Justice. It seems to me that in registering trade marks the principle to which the enactment so plainly refers ought to be applied without any qualification whatever, and that the Comptroller, to whom in the first instance is committed the "discretionary power," as it is termed in the Act, of registering a trade mark, ought to reject words which involve a misleading allusion or a suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood.

In the present case the evidence shows that the expression "Fruit Salt" has come to mean Mr. *Eno's* preparation, that at present it means nothing else, and that Mr. *Eno's* preparation is well known and very popular. Mr. *Dunn* adopts the expression "Fruit Salt," and gives it a prominent position among the words he seeks to register. I have no doubt that those words are calculated to deceive. They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. *Dunn's* advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. *Eno's* preparation. The object I think was, and, if Mr. *Dunn's* application were successful, the result, I am convinced, would be in some cases at any rate, to induce people to buy under an impression "not founded in truth," and not, perhaps, the less misleading because it is vague and indefinite,

and, it may be, incapable of bearing the very slightest examination. Mr. *Eno* has not and cannot have any exclusive property in the expression "Fruit Salt." The words of which it is composed are common English words; anybody may use them in any manner and in any connection he pleases, provided he takes care that the use to which they are applied is not calculated to deceive.

The learned Judges who were in favour of Mr. *Dunn* in the Court below seem to have come to the conclusion that Mr. *Dunn's* object was to obtain the benefit of the celebrity which the name adopted by Mr. *Eno* has acquired, but that it was not his object to steal Mr. *Eno's* trade. So far I am disposed to agree; but I do not think that those propositions cover the real question. The question is one between Mr. *Dunn* and the public, not between Mr. *Eno* and Mr. *Dunn*. It is immaterial whether the proposed registration is or is not likely to injure Mr. *Eno* in his trade. Equally immaterial, as it seems to me, is the fact that for a considerable time Mr. *Eno* had on the register as his trade mark the words "Fruit Salt." Mr. *Eno* may have gained some advantage to which he was not properly entitled; but that is hardly a reason for permitting Mr. *Dunn* to practise a deception upon the public.

RE EDGE'S TRADE MARK.

[March, 1891. 8 R. P. C. 207.]

Trade Mark—*Words calculated to deceive*—*Acts of 1883 to 1888*,
ss. 64, sub-s. 1 (e) 90.

Motion to rectify.

In 1889 *William Edge* registered as a new trade mark for blue the words "Edge's Filtered Blue" (in ordinary type). In 1888 he registered as a trade mark a label containing with other matter the words "Edge's Filtered Blue." *Messrs. Johnson & Co.* now moved to expunge the first mark, and in respect of the second mark to have a disclaimer entered of any exclusive right to the words "Filtered Blue."

Motion granted.

8 R. P. C.
209, l. 5.

STIRLING, J.—On the first trade mark I confess I do not feel any doubt.

8 R. P. C.
209, l. 9.

Under [sect. 64, sub-sect. 1 (e) of the Acts of 1883 to 1888] there has been registered "Edge's Filtered Blue." Now upon the ordinary construction of the English language I should say the word "filtered" is a word having reference to the character or quality of the goods; and if I were not to look beyond the alleged

trade mark itself I should have no hesitation in coming to that conclusion. But the ground on which it is said I ought not to remove the mark from the register is a most extraordinary one. Evidence is put in to show that the blue manufactured by the person who has registered the mark does not suffer any process of filtration at all, and that it has no relation whatever to the character or quality of the goods. If that is so, then it seems to me it is calculated to deceive, and ought to be removed on that ground. * * The first trade mark must be entirely removed from the register.

As regards the second, it follows from what I have said that there being no exclusive right to the use of the word "filtered," there ought to be a disclaimer with reference to the word "filtered," which appears on the other trade mark.

The Respondent must pay the costs of the motion.

RE EDGINGTON'S TRADE MARK.

BENJAMIN EDGINGTON, LIMITED v. JOHN EDGINGTON & COMPANY.

[July, 1889. 6 R. P. C. 513 ; 61 L. T. 323.]

Trade Mark—Act of 1875, s. 10.

Motion in action to restrain infringement. Cross motion by Defendants to expunge.

In 1878 *Griselda Archer*, widow and executrix of *Elisha Thomas Archer*, registered the words "Frigi domo" as an old trade mark in respect of a material made of wool and hair, intended to protect hothouses and plants from cold, which *Archer* had sold from 1854 till his death in 1877. The Plaintiffs were the successors in title of Mr. *Archer's* business and the assignees of the trade mark. The Defendants admitted that they had no defence to the action unless their motion succeeded. The Plaintiffs were unable to produce direct evidence of the use of the words *per se* as a trade mark before 1875. The evidence principally relied on by the Defendants was the statement made by *Archer*, in Nov., 1876, upon his application for another trade mark (namely "an arrow") for the same article (which he described as "a non-conducting article called by me 'Frigi domo,' &c."), to the effect that the arrow had been used by him as a trade mark for this article for three years prior to Nov., 1876. This trade mark was in fact registered and used by *Archer*.

Injunction granted and Defendants' motion refused.

6 R. P. C.
517, l. 23.

KAY, J.—It is not denied that the words in question are special and distinctive, or that, as was said by the C. A., in *Leonard and Ellis' Trade Marks* (*infra*, p. 205), the burden of proving that it was not used as a trade mark before 1875 is upon those who apply to alter the register, notwithstanding, as Lord SELBORNE remarks, the general rule is that no man is bound to prove a negative. On the other hand, it is admitted that the article may be made and sold by any one, the only objection being to the use of the registered words to describe it when made or sold by persons other than the Plaintiffs.

The real grounds of the application are:—(1) At the time when the registration was made the registered words had become the ordinary name of the canvas which I here have described, and (2), that they had not been used as a trade mark at any time. There is considerable evidence to show that the words were used as the name of the article, some of this consisting of documents, such as letters, testimonials, trade circulars, and the like dated before 1875, which seem to treat the words in question as the name of some article with which the public were familiar. This, however, according to certain dicta in the case to which I have referred, and also in *Thompson v. Montgomery* (*infra*, p. 325), would not, in the opinion of the Court of Appeal, be a fatal objection to the registration of a trade mark, which had been used as such before 1875. But the more important objection is the second: that these words were not used as a trade mark before that date.

6 R. P. C.
517, l. 59.

His Lordship discussed the evidence, and said:—Now the question on which I reserved judgment was, whether this evidence * * * is not sufficient to establish that the words in question were not used as a trade mark before 1875, or at any rate to shift the onus of proof, by throwing upon the Respondents (the Plaintiffs) the obligation of proving such user. But I am bound to remember that this trade mark of “Frigi domo” has been upon the register since 1878. *Archer* is dead, and so probably are other witnesses whose evidence might be material. This application is not made until the year 1889, and then under the stress of an action for an injunction against the Defendants, to restrain them from infringing this trade mark.

6 R. P. C.
518, l. 16.

Treating the burden of proof as being upon the Applicants, I am not satisfied that they have established either of the points upon which they rely.

EDWARDS v. DENNIS.
RE EDWARDS' TRADE MARK.

[C. A., August, 1885. 30 Ch. D. 454; 55 L. J. Ch. 125; 54 L. T. 112.]

Trade Mark—Registration for entire class—User for part of class—Assignment of goodwill—Act of 1875, ss. 2, 3, 4, 5, 10; Act of 1876, s. 1.

Action to restrain infringement. Summons to rectify.

In 1883, *T. E. Edwards* purchased, and had assigned to him, the goodwill of *Cromar, Scott & Co., Limited*, in the trade or business of galvanized iron merchants and manufacturers, including the right of the company to a trade mark, consisting of a figure of the god Neptune holding a trident, and the word Neptune. This trade mark had been registered by the company's predecessors in title in the business (*Cromar, Scott & Co.*) in 1878, in respect of all the goods in Class 5.

Neither *Edwards* nor the company had ever sold anything else except galvanized iron plates. *Cromar, Scott & Co.* had, it appeared, sold at times small quantities of galvanized wire, but without using the trade mark therewith. In 1884, *Edwards* commenced an action for infringement and passing off, against *W. P. Dennis* the English agent of a German firm *Felten & Guilleaume*, manufacturers of steel and iron wire, which *Dennis* sold in England under his principal's trade mark. This trade mark, which consisted of a trident between the letters F. & G., with the word Neptune underneath, had been registered in 1880 in Class 5, for steel and iron wire.

The action was tried at the Liverpool Assizes in December, 1884, before A. L. SMITH, J., who gave judgment for the Plaintiff. Appeal to the Court of Appeal, which stood over till BACON, V.-C., had disposed of a summons taken out by *Felten & Guilleaume* in June, 1885, for limiting the registration of *Edwards'* trade mark. BACON, V.-C., made an order limiting such registration to unwrought and partly wrought metals, other than steel and iron wire. Appeal to the C. A. (Cotton, Lindley and Fry, L.JJ.), who heard at the same time the appeal in the action.

The appeal in the action was allowed, and the action was dismissed with costs. The order on the summons was varied by limiting the registration in question to unwrought and partly wrought metal, consisting of galvanized iron sheeting.

COTTON, L.J., referred to the Act of 1875, sects. 3 and 4, and said :—No doubt the intention of the Act is to give a right to what is on the register, so as to enable a person who has been registered

30 Ch. D.
471.

for five years as the proprietor of a trade mark to maintain an action against any other person taking or infringing that trade mark ; but when the alleged infringement consists of using, not the exact thing upon the register, but something similar to it, the Court must, in considering whether there has been an infringement or not, proceed upon the old principle which prevailed both at law and equity before the Act, that a man is not to pass off his goods as the goods of another. At common law the man thus injured might obtain damages, and in equity the more effectual protection of an injunction. * * * Can it be said that by placing this label or mark, of which the Plaintiff complains, on their bundles of wire, the Defendants are passing off their goods as those of the Plaintiff, when the Plaintiff is not selling that class of goods at all ? If they had been using it as a trade mark upon the same description of goods as those manufactured by the Plaintiff, that might have led people to believe that those goods were the Plaintiff's manufacture ; but when we find that the goods are so distinct as they are in this case, I should say, as a judge of fact, that the Defendants are not doing anything to mislead people into thinking that their goods are the goods of the Plaintiff.

30 Ch. D.
472.

It appears to me that the 3rd section is intended to afford assistance to a person who is bringing an action against another person for passing off his goods as the goods of the person who brings the action. In such a case, if the Plaintiff shews that he has been on the register for five years, that dispenses with the necessity of his adducing evidence of exclusive user of his trade mark. But the 3rd section is no bar to an application under the 5th section for rectification of the register, and in the case of such an application the Court is bound to consider—as the Court of Appeal held in *Re Palmer's application* (*infra*, p. 261)—whether the trade mark is properly on the register ; for, although it may have been on for five years, if it ought not to have been on at all, then it can be taken off. So that on the question whether a trade mark is properly on the register, the 3rd section is no bar to an application to rectify the register.

30 Ch. D.
474.

Even if a trade mark can be registered which is not in actual use, it ought to be restricted to those goods in connection with which it is going to be used. In my opinion it is not the intention of the Act that a man registering a trade mark for the entire class, and yet only using it for one article in that class, can claim for himself the exclusive right to use it for every article in the class. In the present case it is an assignment of a registered

trade mark under which Mr. *Edwards* claims; and sect. 2 of the Act says, that a trade mark when registered shall be assigned only in connection with the goodwill of "the business concerned in" the particular goods or classes of goods to which the trade mark has been registered as belonging. Can a man claim registration for all the articles specified in the class, when the business he is engaged in comprises only one specific portion of the articles named in the class? I am of opinion he cannot. * * * In the course of the argument it was asked, what is to be done if a man extend his business? We have not to deal with that question now, but still we ought to notice it. In my opinion, if a man wishes to extend his business to a new description of goods, and to use his trade mark in connection with the goods, he ought to register it in respect of those goods.

LINDLEY, L.J.—The first question is:—What right did Mr. *Edwards* acquire by his assignment and subsequent registration? 30 Ch. D. 476. It is said that under the Act of 1875 he acquired the exclusive right to use the trade mark in connection with all the goods named in Class 5; and the argument is put as high as this, that the Act gives him either the right to damages, or the right to an injunction against any rival manufacturer who chooses to use this trade mark in connection with goods which Mr. *Edwards* himself does not manufacture. Pushed to an extreme, the argument means this:—That a man having no business at all, by simply registering a trade mark, acquires the exclusive right to use it. That construction of the Act seems so irrational that I cannot adopt it. A trade mark has no sense except in connection with trade. When therefore Mr. *Edwards* got himself registered as proprietor of this trade mark, it is perfectly preposterous to say that he thereby acquired any right to bring an action against a person, say a goldsmith, who may manufacture goods of a kind entirely distinct from that which he himself manufactures.

In my opinion it is perfectly ridiculous to suppose sect. 2 of the Act of 1875, means that a trade mark is to be registered as belonging to goods which the man does not manufacture at all. It must mean that the mark is to be registered, not in connection with nothing, but in connection with the particular trade in respect of which he desires to use it. 30 Ch. D. 477.

FRY, L.J.—I share the doubt expressed by COTTON, L.J., namely, whether a man can claim the exclusive use of a trade mark unless it is a trade mark actually used as such at the time of registration. I entertain that doubt because the 1st and 2nd 30 Ch. D. 479.

sections of the Act appear to me to imply the pre-existence, before registration, of the trade mark, and also of the business concerned in the goods in respect of which the trade mark is used. However, that is not the question now before us, and therefore I will not go beyond expressing a doubt upon the point; but I do express my opinion, that under the 2nd section no trade mark can be assigned except in connection with the goodwill of the business in which it has been used, which business must be co-extensive with the goods or classes of goods in respect of which the trade mark is registered. The result therefore is, that if a person registers a trade mark in respect of goods in which he carries on no business, he does so at his peril, and an assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered.

RE ERMEN AND ROBY'S TRADE MARK.

[December, 1886. 4 R. P. C. 70; 56 L. J. Ch. 177; 56 L. T. 230.]

Trade Mark—Alteration of register—Clerical error—Act of 1883, ss. 9, 92.

Motion on the suggestion of the Comptroller for leave to alter the register by amending a clerical error in an inessential particular of a registered trade mark. The mark had been advertised in an incorrect form, but the mistake having been immediately discovered it had been used for two years in the corrected form. CHITTY, J., made the order asked.

RE FARINA (1).

[January, 1878. 26 W. R. 261.]

Trade Mark—Refusal to register—Act of 1875.

Motion.

J. M. Farina (No. 1) was the registered proprietor of a trade mark for Eau de Cologne, consisting of a composite label, an important part of which was a certain medallion. *J. M. Farina* (No. 2) applied to register as a trade mark for Eau de Cologne a medallion (to which he was entitled) identical with the medallion appearing in the above-mentioned label. *J. M. Farina* (No. 1) now moved to restrain *J. M. Farina* (No. 2) from proceeding with his application.

Motion refused.

26 W. R.
262.

HALL, V.-C.—I think the proper and reasonable way of trying the question whether the Respondent ought to be allowed to register

what he proposes to register as his trade mark would be this : supposing, independently of the Act of Parliament and the registration, that the Applicant is the undoubted owner of the trade mark, which he has intended to use, and has used, and supposing bottles containing Eau de Cologne or spirits of some kind are being sold with nothing but that medallion upon them, in that state of things I do not myself consider that the medallion is that which catches the eye, and which procures the sale, and which is calculated to deceive the public. * * *

As at present advised, if the Respondent were using the medallion in combination with what the Applicant uses in combination with his medallion, or with anything not materially and substantially distinguishable, so as to make a mark of sufficient distinction between the two, he would be doing that which was illegal, and of which the Applicant would then have a right to complain.

RE FARINA (2).

[February, 1879. 27 W. R. 456.]

Trade Mark—Resemblance—Decision of foreign tribunal—Act of 1875.

Motion by *J. M. Farina*, carrying on business *gegenüber dem Jülichs Platz*, Cologne, as a manufacturer of Eau de Cologne, to restrain *J. Buchholz* (who was apparently entitled to and did in fact carry on a similar business as *J. M. Farina*, *gegenüber dem Elogius Platz*, Cologne) from proceeding with an application to register three trade marks.

The applicant was the registered proprietor in England of three trade marks for Eau de Cologne, consisting of (1) a label with the lithographed signature "*Johann Maria Farina, gegenüber dem Jülichs Platz*," and a seal in the corner, and used for pasting on the side of the bottle ; (2) a circular stamp on a strip of paper used for pasting on the cork and down the neck of the bottle ; (3) a label containing a picture of his business premises, "*Gegenüber dem Jülichs Platz*," Cologne, with medals and letter-press, and used for pasting on boxes in which bottles were packed.

Buchholz having applied to register for Eau de Cologne three marks similarly composed, and to be respectively used in the same manner as *Farina's* marks, this motion was launched.

Injunction granted.

HALL, V.-C., dealing with *Buchholz's* first mark, which consisted of a label containing the lithographed "*Johann Maria Farina, gegenüber dem Elogius Platz*," and got up like *Farina's* corre-

27 W. R.
457.

sponding trade mark, said :—It seems to me to be perfectly clear that the proposed registration cannot be allowed. It appears to me that that would be plainly taking one of the *Farina* marks which already has been registered. I cannot hesitate for a moment about that.

His Lordship held that *Buchholz's* second mark was clearly a colourable imitation of *Farina's* corresponding mark.

Buchholz's third mark (which was a label containing a representation of his business premises, and corresponded in shape and general appearance to, but differing in details from *Farina's* third trade mark), had already been the subject of litigation in Germany between *Farina* and *Buchholz* : but the Rhenish Court of Appeal were of opinion that there was such a difference in the architectural appearance of the houses delineated on the two labels, that persons looking at *Buchholz's* label would not be deceived, and they accordingly held that *Buchholz* was entitled to use the label in question. With reference to this his Lordship said :—

I observe in the judgment which is delivered by the Court of Appeal in Germany on that point what they have said has reference to, and only has reference to, the picture, without the letterpress at all. It is not a judgment taking the thing as a whole, and saying what impression would be made upon persons seeing this. As I understand, this label is put upon the box ; it forms the lid or cover of the box. The judgment which I have to give must be a judgment with reference to the whole appearance of the thing, and whether it would be calculated to deceive or not ; because, under the Act of Parliament, if it is calculated to deceive, it is not to be put on the register unless the Court thinks fit for some reason. What, in particular cases, might induce the Court to allow it to be done, would depend upon circumstances, and, true it is, there are said to be some such circumstances here, which I will mention presently. Looking at that box with the whole of this letterpress upon it, is that, or is it not, a trade mark which is calculated to deceive ? * * *

It is impossible for anyone to see this without seeing that the letterpress is, to a very great extent indeed, copied from, and exactly in imitation of, the *Farina* picture. For what purpose has that been done ? It might have been done, to my mind, for the purpose of passing off the goods of the one as the goods of the other ; and although, upon a minute examination, it may be that many persons would see the difference, even if I were to say that most persons would see it, and if I should say that there would

be only a small proportion of persons who would take the one for the other, yet I am satisfied myself, notwithstanding all the differences in the picture of the house, and so forth, that some persons, and not an inconsiderable number of persons, with reference to the property to be protected by this trade mark would be deceived, and would buy the one for the other. That being my view of the matter, and having made the observations which I have with reference to the non-observation by the learned Judges of the Court of Appeal at Cologne upon the letterpress, I cannot pay greater respect to their judgment in that respect than I can pay to the finding of one special jury against another special jury, there being two findings upon it. Under those circumstances I am bound, I consider, to treat this matter as if it were for the first time before me, and I must find for myself what is my view of it.

RE FARINA'S TRADE MARKS (3).

[February, 1881. 29 W. R. 391 ; 44 L. T. 99, n.]

Trade Mark—Erroneous registration—Practice—Act of 1875.

Motion to rectify.

In 1876, *Johann Maria Farina*, a member of the Cologne firm of *Johann Maria Farina, gegenüber dem Jülichs Platz*, registered in England certain trade marks belonging to the firm in his own name. This registration was intended to be on behalf of the firm. On *J. M. Farina's* death in 1880, the mistake was discovered, and a motion was launched by the then members of the firm to rectify the register by removing the name of *J. M. Farina* as proprietor, and inserting in place thereof "the firm trading under the name of *Johann Maria Farina, gegenüber dem Jülichs Platz*."

JESSEL, M.R.—This case is one of considerable difficulty, and while I am unwilling to deprive the Applicants of the benefit of their five years' registration, I cannot find that I have any power to dispense with the requirement that notice is to be given to the public. The case is not the same as that of *Rust & Co.* (*infra*, p. 303), for there the registered proprietor had applied in the firm's name as well as in his own ; here the registered proprietor made no mention of the firm in his application. * * * The Applicants may obtain what they desire by procuring the appointment of an administrator in this country to the estate of *J. M. Farina*, and then getting an assignment of the trade marks from the administrator to the firm.

29 W. R.
393.

RE FARROW'S TRADE MARK.

[May, 1890. 7 R. P. C. 260 ; 63 L. T. 233.]

Trade Mark—User—Registration—Act of 1883.

Motion to proceed.

In 1889 *Joseph Farrow* applied to register a charging buffalo as a new trade mark for mustard. The application was opposed by Messrs. *Colman*, who were the registered owners of a trade mark for mustard consisting of a bull's head. On appeal to the Board of Trade from the Comptroller's refusal to register, the matter was referred to the Court. The following facts were proved with reference to the sale of mustard. Mustard is commonly sold in tin boxes surrounded by paper wrappers commonly of a yellow colour, on which there are put red letters outlined in black ; and in front of the box there is frequently a circular spot in silver on which the trade mark is placed. These are matters common to the trade. On referring the appeal to the Court, the Board of Trade directed that all parties "be at liberty to adduce such evidence as they respectively may be advised."

7 R. P. C.
261, l. 27.

STIRLING, J.—That leaves the whole thing at large. It seems to me it stands on the same footing as an ordinary motion, and will take the ordinary course of evidence on a motion. If the parties desire to use the statutory declarations used before the Comptroller, they can do so very cheaply by verifying them by affidavit, but they cannot otherwise be admitted.

The motion was subsequently heard on its merits : and registration was refused.

STIRLING, J.—applied the test laid down in *Re Worthington's Trade Mark* (*infra*, p. 353), and *Re Christiansen's Trade Marks* (*supra*, p. 95), and held as a fact, to be decided partly by eyesight and partly by the evidence, that *Farrow's* mark would, if fairly used, be calculated to deceive.

7 R. P. C.
264, l. 18.

After describing the boxes and wrappers in which mustard is sold, his Lordship said :—It is obvious that it will be a fair use of this mark, if it is registered, to put it on a box of that description, enveloped in a wrapper of the kind which I have described.
* * * I come to the conclusion that the mark which is proposed to be registered, if used upon these boxes or on these wrappers, as it may be legitimately used if it is registered, would be calculated to deceive.

FENNESSY v. DAY & MARTIN.

[July, 1886. 55 L. T. 161.]

Trade Mark—Offer to compensate—Costs—Act of 1875.

On 12th *June*, 1886, a traveller in the employ of the Defendants, the well known firm of *Day & Martin*, received an order from *W. Nutting*, of Lavender Hill, for 60 dozen cardboard boxes with labels bearing the words “Browne’s Satin Polish for ladies’ and children’s boots and shoes, travelling bags, trunks, &c. manufactured by *Browne*, of Lavender Hill.”

The Defendants thereupon proceeded to have the labels printed.

On the 6th *July*, 1886, the Plaintiff, who traded as *B. T. Brown & Co.*, and was the owner of a trade mark registered in 1878, and consisting of a device combined with the words “Brown’s Satin Polish,” issued a writ against *Day & Martin*, to restrain infringement. On 7th *July*, 1886, the Defendants wrote a letter to the Plaintiff offering to compensate the Plaintiff without the necessity of legal proceedings, and to destroy the labels and comply with any reasonable request of the Plaintiff.

BACON, V.-C.—The question in this action which I have to decide is, who is to pay the costs. * * * In my opinion the offer is not enough. * * * Notwithstanding that offer the Plaintiff are compelled to come to this Court to prevent an injury, and are entitled to the costs of proceedings taken to protect their interest. There must be a perpetual injunction and an order to deliver up the labels to be destroyed, with costs. 55 L. T.
162.

FENNESSY v. RABBITS.

[March, 1887. 56 L. T. 138.]

*Trade Mark—Damages for infringement—Jury—R. S. C. 1883,
Ord. XXXVI. r. 6.*

Motion.

This was an action brought by the Plaintiff in *Fennessy v. Day & Martin* for infringement of the trade mark mentioned in that case.

The claim asked for an injunction and for damages for infringement, or alternatively for profits.

The Defendant submitted to a perpetual injunction as claimed, and the Plaintiff electing to take damages and not an account of profits, moved that for that purpose the action might be tried by jury, and accordingly transferred to the Q. B. D.

KAY, J. held that under R. S. C. 1883, Ord. XXXVI. r. 6, an order must be made as asked, but that even if he had a discretion, the case was one which ought to be tried by a jury.

56 L. T.
140.

KAY, J.—With the highest possible respect for the powers of this Court to determine what damages should be given, either by the judge in Court, or by the assistance of the staff in chambers, it seems to me that there are certain cases, especially trade cases, in which a jury is the better tribunal.

FENNESSY v. CLARK.

[C. A., December, 1887. 37 Ch. D. 184; 57 L. J. Ch. 398; 58 L. T. 289.]

Trade Mark—Practice—Discovery.

Summons.

This action was brought by the Plaintiff in *Fennessy v. Day & Martin* for infringement of the trade mark mentioned in that case, and the claim asked for damages or alternatively for an account of profits.

On the 7th of *June*, 1887, an order was made in Chambers that the questions of fact arising in the action be tried by a special jury at the Middlesex sittings.

On the 29th of *October*, a summons was taken out by the Plaintiff, for a further and better affidavit by the Defendant in answer to interrogatories, directed to the numbers of sales effected by him of the polishing preparation, and a further and better affidavit of documents (including the books in which the business transactions relating to the polishing preparation complained of in the action were entered).

The Plaintiff had not elected between damages and profits.

KAY, J. dismissed the summons.

Appeal to the C. A. (Cotton and Lopes, L.JJ.). Appeal dismissed with costs.

37 Ch. D.
187.

COTTON, L.J.—I do not say that the damage sustained by the Plaintiff is not a question of fact, but is it a question of fact within the meaning of the order of 7th *June*? At the time when the order was made, the Plaintiff had not elected to waive his account of profits. Would it then be right to allow the Plaintiff to get a jury to determine what damages he was entitled to before he has made his election between damages and profits? Should the jury award him a large sum for damages, he would probably accept it, but if they gave him a small sum only, then he might

say, "No, I would rather have an account of profits, as I see by the Defendant's books that he has made a much larger sum."

By "questions of fact," I think that the order means questions of fact on which the Plaintiff's title to relief depends. In my opinion the decision of KAY, J. is right, and the Plaintiff's application for discovery and inspection of the Defendant's books is premature. It is not necessary to refer to the authorities. The Court is always unwilling before the right to relief is established, to make an order for discovery, which may be injurious to the Defendant, and will only be useful to the Plaintiff if he succeeds in establishing his title to relief.

RE FUENTE'S TRADE MARKS.

[February, 1891. 8 R. P. C. 214; (1891) 2 Ch. 166; 60 L. J. Ch. 308; 64 L. T. 196; 39 W. R. 489.]

Trade Mark—Previous user in deceptive form—Act of 1883.

Summons to proceed.

In 1887, *Joseph Fuente*, a cigar manufacturer of Vera Cruz, Mexico, and successor to *Madrazo-y-Cia Sucesores*, of the same place, applied to register three trade marks for cigars: one as an old mark, and two as new marks. The application being opposed, came before the Court in the usual way. With regard to the first of the three proposed marks, it was proved that the mark used prior to 1875 differed from the mark proposed to be registered.

The two other proposed marks, (Nos. 67,418 and 67,419) were labels, and consisted of elaborate pictures or designs, (representations of which are given in 8 R. P. C. pp. 214 and 215,) and contained at the top the words "Plantacion de la Union," and at the bottom the words "De J. Fuente, Vera Cruz."

For some time before 1877, the labels had been used by *Fuente* and his predecessors in title (inside the cigar boxes) in the form in which it was now sought to register them, except that instead of "De J. Fuente, Vera Cruz" the words were "Madrazo y Cia Sucesores, Habana." "Habana" was also stamped on the boxes. *Fuente* had in fact applied to register one of the marks as used, but had abandoned the application. La Union is a place in San Salvador, where fine tobacco is grown. Registration refused of all three marks.

ROMER, J.—There are three applications before me. With regard to the application to register the old trade mark, that clearly fails. 8 R. P. C.
216, l. 23.

* * The mark which it is sought to register was never used as an old mark. That application therefore fails. But that leaves the

Court to consider the application so far as concerns two new marks, No. 67,419 and No. 67,418. Those two marks may be dealt with together, for substantially the points arising with regard to them are the same.

8 R. P. C.
217, l. 44.

The first question which arises is this :—Was the trade mark as used fraudulent? I have come to the conclusion that it was. Inside the box, and looking at the label as used, as appears from the exhibit before the Court, it is clear to me that the representation is there made, that *Madrazo & Company*, who were the predecessors of *Fuente*, had their place of business at Habana.

8 R. P. C.
218, l. 2.

It is clear, and indeed was admitted by one of the Applicant's Counsel, and rightly admitted, in the course of his argument, that the object of the Applicant in this case in registering this mark as a new mark, is in effect to enable him to get the benefit of the old user, that is to say, the old user which I have come to the conclusion was a fraudulent user. Further, I think that the effect of the registration in this case might well be to deceive. I think any person who had been accustomed to deal with the cigars under the old form of the label, and who had been led to believe that the cigars came from Habana, might still buy cigars under the new form of the label, believing that they also were Habana cigars, for he would, not unnaturally, remember the old label, which he would find substantially the same as the new one, and either might not notice or might not appreciate the difference between the two, arising from the substitution of the words "Fuente, of Vera Cruz" for the words "Madrazo y Cia Sucesores, Habana." And it has occurred to me the point might be put in another way. Suppose the case had come before the Court as follows :—Application by Mr. *Fuente* to register this mark as a new mark, saying nothing whatever about prior user. Answer put in on behalf of the Opponents: "This is not a new mark, it is substantially an old mark used for Habana cigars, and in proof the Respondents put in the old mark as used, which shows on the face of it that that is so." That would be an answer to the claim, but for the reply which the Applicant in this case asks the Court to allow him to establish, to this effect :—"I used the label and the trade mark referred to; and used it not for Habana cigars, but for Mexicans, and I ask the Court to allow me to show for my own benefit, on this application, and in support of this application, that my old user was fraudulent, and therefore ought to be removed from my path." In my judgment he ought not to be allowed to say that before the Court, in order to assist him in getting this mark registered,

RE GIANACLIS' TRADE MARK.

[June, 1889. 6 R. P. C. 467 ; 58 L. J. Ch. 782.]

Trade Mark—Person aggrieved—Act of 1883, ss. 64, sub-s. 1 (a), 90—Costs.

Motion to expunge.

In 1885 *Nestor Gianacelis*, a manufacturer of cigarettes, registered as a trade mark the words "Gianacelis Cigarettes," printed in ordinary capital type and not in any "particular or distinctive" manner (see Act of 1883, s. 64, sub-sect. 1 (a)). In 1889 he commenced an action against *George Elliott*. The Statement of Claim stated the facts with reference to the registration of the trade mark, and then went on to allege that the Defendant had manufactured and sold cigarettes bearing the name of "N. Gianulis" in boxes "got up" like the boxes in which the Plaintiff's cigarettes were sold. The Plaintiff claimed an injunction to restrain the Defendant from applying to any cigarettes manufactured or sold by him, or to any box, packet, or wrapper in which such cigarettes were sold by him, the name "N. Gianulis" or "Nestor Gianulis," or any other name so contrived as, by colourable imitation or otherwise, to represent the cigarettes manufactured &c. by the Defendant as being cigarettes manufactured &c. by the Plaintiff, together with the usual incidental relief. No claim was made to restrain infringement of the trade mark. On the Defendant moving to expunge the Plaintiff's trade mark, it was contended on behalf of the Plaintiff that, though the trade mark ought never to have been registered, yet the Defendant was not "a person aggrieved" within the meaning of the Act of 1883, s. 90.

NORTH, J., directed the Plaintiff's trade mark to be expunged.

NORTH, J., referred to *Rivière's Trade Mark* (*infra*, p. 290) and *Ralph's Trade Mark* (*infra*, p. 278), and said (after reading the Statement of Claim):—It is to be noticed that in the prayer in the Statement of Claim [the Plaintiff], does not use the word "trade mark"; and it would be a fair comment to say that the prayer of the Statement of Claim might stand in exactly the same language, if the facts necessary to prove it were proved, to shew a good Common Law right of action—if there were no such thing as a trade mark recognised by the law at all. That is quite true. But looking at the way in which [the Plaintiff puts forward in the Statement of Claim the fact of the registration of the words "Gianacelis Cigarettes" as a trade mark, and] gives the history of such registration, it is clear to me, that the Plaintiff is relying on his registra-

6 R. P. C.
470, l. 25.

tion to some extent as a ground for the relief that he asks against the Defendant. That being so, it appears to me that the Applicant is a person aggrieved within the definition of the Act itself.

6 R. P. C.
470, l. 46.

The only point that gives me any difficulty whatever is as to costs. I quite agree, generally speaking, if a man gets a wrong mark put on the register, and, when asked to remove it, opposes its removal, that he ought to pay the costs of getting it removed. But in the present case it appears to me an open question (I will say) whether this application is really made for the purpose of getting rid of an improper mark, or whether it is not intimately connected with the subject-matter of the action now pending between the Plaintiff and the Defendant, and I think, therefore, that I am not in any way departing from the rule that I should always follow in an ordinary case, in saying that the present case is so far mixed up with the matter to be tried in the action, that I reserve the costs of this motion to be disposed of when the action comes to be tried.

RE GOODALL'S TRADE MARK.

[July, 1889. 42 Ch. D. 566; 38 W. R. 189.]

Trade Mark—Disclaimer—Act of 1883, ss. 72, sub-s. 2, 74, sub-s. 2.

Summons to proceed with opposed registration.

In 1888 *Charles Goodall & Son* applied to register, for paper and envelopes, a trade mark consisting of a heart with (No. 176) inside the heart, "*Goodall's Cream-wove Parchment Bank*" above, and "*Notepaper, Charles Goodall & Son, London,*" below the heart, the whole being contained in an upright rectangle.

The registration was opposed by *Alexander Pirie & Sons, Limited* (the successors in title of *Alexander Pirie*), who were the registered owners of a trade mark for paper and envelopes consisting of the words "*Pirie's Parchment Bank*," the exclusive use of either "*Parchment*" or "*Bank*" having been disclaimed on application.

Registration refused.

The Applicants offered for the first time on the hearing of the summons to disclaim the exclusive use of the words "*Parchment Bank*."

42 Ch. D.
569.

NORTH, J.—It seems to me impossible to say that when what is *Pirie's* whole trade mark excepting his own name, is proposed to be incorporated into the Applicants' trade mark, it is not a case

which comes within the 72nd section of the Act. * * * Then the attempt in reply is to set up that this is common to the trade ; that it is used by many people. That may be the fact. I do not say it is not. That evidence is uncontradicted, and as far as I can judge from that, it seems, and it probably is the fact, that it has been used by other persons, as common in the trade. But it is quite clear to me that it is used in the Respondents' trade mark as a distinctive mark. And in my opinion that brings it exactly within the 74th section of the Act. * * Looking at the application here, I do not find this is an application of the sort referred to in that section.

If it is important for me to decide it now, I hold that, for the application to be made under [sect. 74, sub-sect. 2] it must comply with the requirements of the section, and if so, the offer to disclaim must be made in the application, which is not the case here. 42 Ch. D.
570.

GOODFELLOW v. PRINCE.

[C.A., February, 1887. 35 Ch. D. 9 ; 56 L. J. Ch. 545 ; 56 L. T. 617 ;
35 W. R. 488.]

Trade Mark—Act of 1883, ss. 77, 103.

Motion to restrain the Defendant from manufacturing or using in connection with the sale of champagnes not manufactured, sold, or shipped, by or for the Plaintiff, any labels or other devices bearing the name "Le Court et Cie." or any colourable imitation of the labels used by the Plaintiff in connection with the sales of his champagne, and from selling or advertising under such name any champagne not manufactured, sold, or shipped, by or for the Plaintiff.

In *July*, 1885, the Plaintiff, a wine merchant in the City, entered into an arrangement with *Moigneaux Père et Fils*, a firm of champagne shippers at *Dizy* near *Épernay*, for the supply to him of a particular growth of champagne, together with the exclusive right to adopt and use in this country the label "Le Court et Cie., Reims," which had been registered by *Moigneaux Père et Fils* on the 5th *July*, 1885, as their trade mark under the law of France, and to the use of which in France they were solely entitled. Under this arrangement large consignments of champagne were sent to the Plaintiff in this country, and sold by him chiefly to private customers under the name, and bearing the label, "Le Court et Cie., Reims," between *July*, 1885, and *July*, 1886, when this action was brought.

The Defendant also carried on business as a wine and spirit merchant in London, under the name *Short & Co.*, and his trade was chiefly in selling wine across the counter. Since 1880 he had been supplied with champagne by *Moigneaux Père et Fils* under a label bearing their own name. In 1883, he applied to *Moigneaux* to have champagne shipped to him under his own name and label, and he suggested "Le Court et Cie." as being the French translation of *Short & Co.* A label was prepared for him, but was never used.

In *February*, 1886, the Defendant began to deal with *Mercier et Cie.*, and sent them over a label bearing a design and the words "Le Court et Cie.," with instructions to get it registered as a trade mark in France, and to use the same on all champagne shipped to him. Between *February* and *July*, 1886, some 500 dozen of champagne bearing this label had been shipped to the Defendant and sold by him.

CHITTY, J., granted an injunction.

Appeal to the C. A. (Cotton, Lindley, and Lopes, LJJ.).
Appeal allowed.

The LJJ. held that the evidence failed to shew that, either by long user or reputation, the wine sold under the name and brand "Le Court et Cie." had become so associated with the wine of the Plaintiff as to enable him to assert his Common Law right of restraining another person from passing off his goods as those of the Plaintiff.

35 Ch. D.
18.

COTTON, L.J.—CHITTY, J. granted the injunction on the ground that what was done by the Defendant, amounted to a representation that the wine he was selling under the name of "Le Court et Cie." was the Plaintiff's wine. I cannot come to that conclusion.
* * * If it were in fact shewn that the representation made by the Defendant was a representation that the wine he was selling was the Plaintiff's, the case would have stood on a different footing. But that, in my opinion, is not the case. Both Plaintiff and Defendant represent that they are importing wine from manufacturers in France, and both of them say that these manufacturers, who are wine merchants, are *Le Court et Cie.*

It is very true that there is evidence that, previously to *Feb.*, 1886, there had been a sale of some fifty dozen of this champagne by the Plaintiff, but we know that some merchants sell wine made by certain firms in France, with the label of those firms upon it, without in any way representing that they are, or being considered to be, sole importers of that wine, or the wine with that label, *e.g.*

Perrier Jouet. Therefore the fact that this wine had been sold by the Plaintiff to various customers, although it shews that in the market there was a wine with this name, would not, in my opinion, shew that the use of this label by another person would amount to a representation, not that it was the manufacture of the same person in France, but that it was the same manufacture as the Plaintiff's, that is to say, the Plaintiff's wine. Therefore what the Plaintiff intended to do (though the injunction granted goes further), was to prevent the Defendant from selling wine not manufactured by, or coming from, *Moigneaux Père et Fils*, with their label, to which he has the exclusive rights. If he had intended to rely on that label in England, he should have registered the label as his trade mark, or got *Moigneaux Père et Fils* to register it, and unless he does so, his bringing an action to prevent that label being affixed to wine not coming from them, is an attempt to get for them the sole and exclusive right to the use of the label in England; but that is prohibited by sect. 77 of the *Patents, Designs, and Trade Marks Act*.

LINDLEY, L.J.—The simplest way of looking at the case is to suppose that *Moigneaux Père et Fils* were the Plaintiffs here. 35 Ch. D.
19.

I must say, I think their case, whether based on the label or the name, would fail on the evidence. On the label they would fail for want of registration. There is none here, nor do they say, apart from the name, that the Defendant is copying their label. On the name they would be driven to put their case on the old Common Law theory, that they were entitled to prevent the Defendant passing off his goods as theirs. But to do that they would have to shew that they had used the name "*Le Court et Cie*," to such an extent or for so long a time as to associate the name with their wine, and their case on the name upon the present evidence would fail. 35 Ch. D.
20.

GREAT TOWER STREET TEA COMPANY v. LANGFORD
AND COMPANY.

[July, 1887. 5 R. P. C. 66.]

Sale by Defendants of goods got up similarly to Plaintiffs' goods—Part of Plaintiffs' get-up capable of registration as a Trade Mark, but not registered—Action maintainable—Act of 1883, ss. 64, 77.

Motion.

The Plaintiffs moved in an action brought by them to restrain the Defendants from selling their tea in packets, which were colourable imitations of the Plaintiffs' packets of tea. The Plaintiffs' packets had printed on them, (a) the Plaintiffs' registered trade mark (a tower), (b) certain distinctive letterpress, the whole being arranged in a distinctive manner.

Part of the above-mentioned letterpress and of the "get-up" of the Plaintiffs' packets was capable of registration under the Act of 1883, s. 64, and it was contended on behalf of the Defendants that, by s. 77 of the Act, the action was not maintainable.

Injunction granted.

5 R. P. C.
67, l. 34.

STIRLING, J.—I think the decisions of the Court have gone to the extent of saying that the old law still remains, and that you are not entitled to sell your goods in such a way as to lead the person buying them to believe that they are the goods of another man. That is the real question, and as I understand it, the decisions of the Court of Appeal come to this, that the old law still remains, and it is upon that ground that the present case is put. Therefore, I have to decide in this case whether the Defendants are really selling their goods in such a way as to get the benefit of the reputation of the Plaintiffs. I think upon the evidence that I must take it that they are.

GREAT TOWER STREET TEA COMPANY v. SMITH.

[January, 1889. 6 R. P. C. 165.]

Trade Mark—Act of 1883, ss. 64, sub-s. 1 (c), 90—Fancy word—Trade name—Alleged fraudulent user—Costs.

Action to restrain infringement of a registered trade mark, and passing off of goods. Motion to expunge.

The *Great Tower Street Tea Company, Limited*, a company carrying on the business of tea dealers at No. 41, Great Tower Street, London, in 1885, registered the words "Tower Tea" as a

trade mark for tea. It appeared that the Company's tea became known in the market as "Tower Tea." In 1887 the Company commenced an action against *Hedley Smith*, who and whose predecessors in title had since 1879 carried on a similar business to the Company in the neighbourhood of Tower Hill, London, as *The Tower Tea Company*, claiming an injunction to restrain *Smith* from trading under the style of *The Tower Tea Company*, or any style calculated to mislead the public into the belief, &c., and from selling tea under the fancy name of "Tower Tea," and from infringing the above-mentioned trade mark. *Smith* moved to expunge the trade mark, and the action and the motion came on together.

NORTH, J., first dealt with the motion, and made an order expunging the trade mark.

NORTH, J., said that it had been suggested that the mark came under the head of a "label or ticket" (Act of 1883, s. 64, sub-s. 1 (c)), and continued :—In my opinion it is neither the one nor the other. 6 R. P. C.
170, l. 32. It is not registered as a label or ticket. What is registered is simply those two words "Tower Tea." In my opinion, if they come under that section at all, it is not as a label or a ticket, but it is as a "fancy word or words not in common use." Assuming for a moment that the mark is not entitled to registration upon the ground of being a "fancy word or words not in common use," I feel quite clear that it cannot properly be registered as a label or ticket, by putting those words upon a label or ticket, if it had been done, and merely pasting that label or ticket upon the goods themselves; in other words, the Plaintiffs would not be in a better position at all, if they had put the words "Tower Tea" upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they have done, impressed the words "Tower Tea" upon the packages themselves. In my opinion, it is not a label or ticket in any sense. There has been no label or ticket used in this case.

Then we come to the only remaining question, namely, whether it is a "fancy word or words not in common use."

His Lordship then referred at length to *Re Van Duzer's Trade Mark* (*infra*, p. 334), and also to *Waterman v. Ayres* (*infra*, p. 339), and said :—Now how does the matter stand as regards 6 R. P. C.
172, l. 11. the use of the name? The name, to begin with, is the name used by the *Great Tower Street Tea Company, Limited*. It is very difficult to believe that the words "Tower Tea" are used in any way except in connection with the name of the firm. But

there is this further, that they carry on their business in the immediate neighbourhood of the Tower. That, no doubt, is the reason why they took that name for the Company, and can anybody believe for a moment that they adopted that term, except because it was connected with their name, and was also connected with the place where they were carrying on their business?

His Lordship then pointed out that even if the words were "fancy words" they were not "not in common use," inasmuch as it had been proved that there were five associations all using the word "Tower" in connection with tea.

6 R. P. C.
173, l. 8.

With reference to a contention raised on behalf of the Plaintiffs, that the Defendant might have applied earlier to have the mark expunged, his Lordship said :—Very possibly he might, but I can see a very good reason for his applying now, when he has not applied before, which is this, that the Plaintiffs have registered this mark. The effect of that is that it is *primâ facie* evidence in their favour, and the Defendant now comes forward to move, because he finds that the Plaintiffs, who have registered this mark, are taking advantage of that registration, and using it against him in a suit to restrain him by injunction from continuing to do what he has done for a long time past; and, under these circumstances, it quite explains his coming forward at a late hour, if explanation were necessary, to say "Whatever might have been the case before, now that they are attacking me in a Court of Law, upon the ground of my doing what I do, I come forward and say that I am aggrieved by their being in the possession of a *primâ facie* piece of evidence, capable of being used against me, and which may be very strong against me, unless I make the motion which is now before the Court."

With regard to the action, his Lordship held that the Plaintiffs had failed to discharge the onus, which lay on them, of showing that the Defendant and his predecessor in title used the name "*The Tower Tea Company*" fraudulently, and that no grounds were shown for restraining the use of such name; that no evidence had been given to show that the two names were so similar as to be calculated to deceive, or that the Defendant had ever used or threatened to use the name "Tower Tea."

The action was dismissed with costs on the higher scale, it having been fought out at great length.

RE GREENLEES' TRADE MARK.

[January, 1892. 9 R. P. C. 93.]

Trade Mark—Firm—Act of 1875.

In 1879, *J. Greenlees*, a partner in the firm of *Greenlees Brothers*, applied for and registered in his own name a trade mark belonging to the firm. A motion was made by *J. Greenlees* and *Greenlees Brothers* for rectification of the register, by substituting the name of the firm for that of *J. Greenlees*.

STIRLING, J., held that the proper course was for *J. Greenlees* to assign the mark to the firm, and that the Comptroller-General ought to register the assignment.

RE GROSSMITH'S TRADE MARK.

[January, 1889. 6 R. P. C. 180 ; 60 L. T. 612.]

Trade Mark—Act of 1883, ss. 64, sub-s. 3, 73.

Summons to proceed.

In 1887, *J. L. Grossmith* applied to register the word "Emollio" as a trade mark for "an article of perfumery," alleging user by himself and his predecessors in title prior to 1875. The Applicant's father (who was his predecessor in business, and who died in 1867) sold a perfumed cream in bottles with labels on them, bearing the word "Emollio." The Applicant continued the sale of "Emollio" cream till 1870, when he discontinued the sale, and destroyed all the old labels. In 1881 he commenced to sell a solid substance, of the nature of cold cream, in boxes, on the lids of which were the words "Emollio Tablet." The application was opposed by *Cornell & Cornell*, who had since 1876 sold an article of perfumery called "Emolline," which word they had in 1887 actually registered as a trade mark.

Registration refused.

KAY, J., read the Act of 1883, s. 64, sub-sect. 3, and after pointing out that the use of the word "Emollio" on the cream labels had been abandoned in 1870, said:—

Therefore it seems to me that the only use on which the Applicant can rely, to bring his case within the section I have just read, is the use of it on the lid of this box—"Emollio Tablet." He is not seeking to register "Emollio Tablet." He wants to register "Emollio" alone, and he is not seeking to register it for the tablet, but, he says, "for an article of perfumery" without describ-

6 R. P. C.
182, i. 20.

ing it, the object being to get a monopoly of this word "Emollio" for any article of perfumery, which he is doing in this, perhaps, ingenious manner; but it seems to me not at all within the meaning or spirit of the Act. When this section says that a special or distinctive word or words may be registered if they have been used as a trade mark, it means you must register them as you use them. You cannot pick out of a sentence or a combination of words one particular word and register that. * * Here what the Applicant seeks to do, is to take out of the words "Emollio Tablet" one word "Emollio," and then register that in such a way that he may use it either for the "Emollio Tablet" or for any article of perfumery to which he chooses to affix it. But that is not the use of it. He has not used it practically, and was not using it at the time of this application, for any article except the "Emollio Tablet," and then in conjunction with the word "Tablet." I therefore think that in that respect the application is wrong.

His Lordship then pointed out that the word "Emollio" was in reality merely a descriptive word, being the Latin for "I soften," and continued:—

6 R. P. C.
182, l. 48. Is the use of a descriptive word like "softening tablet" the use of a distinctive word as a trade mark? * * * Consider what a trade mark means. A trade mark means a mark under which a particular manufacturer or merchant sells his goods to distinguish them as his from anybody else's. Is putting upon a particular article a descriptive word, the use of that word as a trade mark to distinguish the goods of that manufacturer?

6 R. P. C.
182, l. 20. It is deserving of very careful consideration, whether in a case of this kind where you have a descriptive word, a word which describes the effect of the use of the particular article to which it is applied, that word can properly, within the meaning of this clause, be considered as a trade mark; or whether it can be considered as having been used as a trade mark, which is essential to enable the Comptroller to register it, because of its having been used before the date given in that section 64. * * I shall not give any decided opinion upon that, because it does not seem to me to be necessary in this case; but I confess that it seems extremely doubtful whether that is the sort of use that is mentioned in this proviso to the 64th section, namely, use as a trade mark.

Referring to the Act of 1883, s. 73, and *Cornell & Cornell's* opposition, his Lordship said:—

6 R. P. C.
183, l. 51. Now, if I were to permit the word "Emollio," which is only

another form of the English word "emollient," to go upon the register, this use of the word "Emollio" would be very likely indeed to deceive. "Emolline" and "Emollio" are so nearly like one another, that I cannot doubt that the use of the two words would be calculated to deceive people. People might buy "Emolline" for "Emollio," and "Emollio" for "Emolline," and, observe, the Comptroller, when he is asked to register a trade mark, is bound to consider, whether, looking to all the circumstances of the case, he can exercise his discretion by permitting the trade mark to be registered; and one of those circumstances would be this use of the word "Emolline," which had been going on for some years before the "Emollio Tablet" was issued to the public at all. It may be that neither of the words is proper to be registered. I think that is very likely. * * * If neither word is properly registered, that would not affect it. Even if both words were open to the same objection, that certainly would not enable the Applicant to have his word registered. If "Emolline" has been registered, there is a still stronger reason against allowing "Emollio" to be registered.

RE GUINNESS & COMPANY'S TRADE MARK.

[May, 1888. 5 R. P. C. 316.]

Trade Mark—Addition—Act of 1883, s. 92.

Arthur Guinness Son & Co. Limited, were the owners of a registered trade mark, which comprised amongst other particulars the signature "*Arth. Guinness Son & Co.*" The Company applied, under the Act of 1883, s. 92 (*supra*, p. 17), for leave to add the word "Limited" in ordinary type under the signature. Leave granted by CHITTY, J.

RE HAINES, BATCHELOR & COMPANY'S TRADE MARK.

[March, 1888. 5 R. P. C. 669.]

Trade Mark—Resemblance—User—Hardware goods—Act of 1883.

Summons to proceed.

In 1886 *Haines, Batchelor & Co.* applied to register as a trade mark for goods in Class 13 the representation in outline of a pig with the letters *H. B. & Co.* underneath it. The application was opposed by *T. & Riley Carr*, who were the owners of a registered trade mark for articles in Classes 12 and 13, consisting of the shaded device of

a pointer dog in the act of pointing with the word "Stanch" underneath it.

Upon the matter coming before the Court in the usual way registration was directed.

5 R. P. C.
672, l. 27.

CHITTY, J.—The question is whether the mark which the Applicants propose to register is so similar to the Respondents' mark as to be calculated to deceive. It is established now, that when two marks are being compared together, for the purpose of seeing to what extent one resembles the other with reference to the question of registering or not, the Court must presume a fair user of the mark, and at the same time it is established that the Court must look, in deciding such a question as this, to the mode in which the mark would be stamped or affixed, the character of the goods on which it is affixed, and generally to all the circumstances of the case with respect to the placing on of the mark and the user of it. But, though the circumstances are to be looked at, it is a cardinal proposition to my mind that the Court must presume a fair user.

5 R. P. C.
673, l. 5.

With regard to user his Lordship said :—It is said that when the Applicants' mark comes to be impressed upon the goods in Class 13, even though reasonable and ordinary skill is used in the impression, the mark will not be found with the same distinctness as it appears in the Trade Marks' Journal, and on that I think there is no question, that it will not come out so clearly or distinctly, but, as a part of the Respondents' case, they have produced a number of exhibits of articles which are not in Class 13 but in Class 12, as to most of them, and in some of those the mark is practically obliterated, that is to say, the Counsel in Court and the Judge have examined them and required some artificial aid in order to find the mark. I do not say, it was done unfairly at all, but the manufacturer has, after the mark has been stamped upon the goods, submitted the goods to the grinding-stone or to some other similar process, with the result that he has—I am not putting it too strongly—in one or two cases obliterated his mark altogether. Now that would not be a fair user, and it is absurd to draw, as to some extent has been done by the Respondents' witnesses, a comparison of the mark, which was well, and fairly well, marked, with an impression of the mark which has become obliterated, and obliterated before the goods are put upon the market. Between those things no comparison can be instituted. I have however before me two specimens which I consider fair. One is the dog and "Stanch" on a large file exhibit A. P. W. which I merely

select as an illustration. There I see the dog with reasonable plainness and the word "Stanch." It is a fair impression. I have also an exhibit of goods which the Applicants manufacture or sell, and there is on those goods the impression of their proposed trade mark; and comparing those two things together I find as a matter of fact and as a matter of eyesight, that they do not resemble each other to such an extent as to be calculated to deceive. It is quite true, as urged by Counsel, that the opinions of the experts are in favour of the Respondents; and it is an important part of this case; but I think that they have unintentionally overstated the case, and that their mode of comparison between the two marks is not legitimate. They speak, and very rightly, in giving their opinions, of the necessity of stamping upon metal goods in such a way that there can be no opportunity of shewing the niceties of shape in drawing; and then they say this:—that having regard to the difficulty there is in stamping the trade mark with perfect accuracy on metal goods, the probability is that such trade mark would become more or less blurred. Stopping there, I make no observation of any unfavourable character to the affidavits; but they go on then to say, "and obliterated." Now, when they have once sought to compare a mark which can be discerned, and a mark which cannot be discerned, it seems to me that they are erecting a standard of comparison which common sense must reject. It may be putting, perhaps, too strict a construction on the phrase, because experts do not always use the most appropriate terms; but in coming to any conclusion I have had regard to the various matters which these witnesses mention. I agree with them about the blurring, and I agree with them in this, that when you come to impress a mark upon metal goods, a greater degree of distinction is required than in the cases where you have other goods. I remember *Mr. Whiteley's Case* (*infra*, p. 343). There he proposed to put his well-known globe on metal goods—spades and agricultural implements and the like—and he was allowed to register his globe notwithstanding the opposition, but on the terms of his using a label and not stamping. In that case his globe, if stamped, would not have been sufficiently distinguishable from the Opponent's globe. All those matters I bear in mind, but at the same time I think that this pig with the letters underneath is sufficiently distinguishable, if honestly used, from the pointer dog with the word "Stanch."

HAMMOND v. BRUNKER.

[February, 1892. 9 R. P. C. 301.]

Trade Mark—Assignment by trustee in bankruptcy—Act of 1883, s. 70.

Motion in an action to restrain infringement and passing off.

In 1884 the Defendant *Collyns* (then trading as *Collyns & Co.* and the *London Pickle Company*), registered as a trade mark, No. 40275, Class 42, “pickles,” an elaborate label containing (inter alia) the words, “The London Pickle Company.”

In April, 1891, *Collyns* became bankrupt, and went as a clerk into the employ of the other Defendants. In July, 1891, the Plaintiffs offered to purchase for £25 from *Collyns*’ trustee in bankruptcy, what the Plaintiffs described as “the registered brand ‘The London Pickle Company,’ and all rights thereto,” and the trustee accepted the offer and gave the Plaintiffs a receipt in which it was stated that the trustee thereby transferred to the Plaintiffs, the registered trade mark No. 40275, Class 42, “The London Pickle Company.”

In December, 1891, the trustee executed a deed assigning to the Plaintiffs the trade mark, and also the goodwill of the department of the business lately carried on by *Collyns & Co.*, in the particular class of goods for which the trade mark was registered.

The label as used by *Collyns* prior to his bankruptcy, and by the Plaintiffs after July, 1891, was slightly different from the registered trade mark. In the latter a shield which formed part of the device on the label was empty: in the former, a hand and fore-arm were inserted in the shield, across the lower part of which were the words “trade mark.”

Injunction granted.

CHITTY, J., read the Act of 1883, s. 70 (*supra*, p. 11), and said:—In other words, the Act of Parliament prevents the assignment of a trade mark in gross, and for very obvious reasons. A trader who continues his business, would enable his assignees, if he assigned the trade mark in gross, to impose upon the public, who would be led to believe when they saw the trade mark that the trade mark indicated the goods of the assignor and not of the assignee. Probably, as I say, attention was called to that, and hence the deed.

His Lordship discussed the provisions of the deed, and continued:—Consequently, on the face of that deed there is an assignment which answers the provisions of the 70th section, an assignment not of the whole goodwill of the bankrupt’s

business, but an assignment of the goodwill in the particular class for which the trade mark had been registered. For the Defendants it is argued that the transaction shown by the letter and receipt in *July* is void, as being contrary to the 70th section. The Plaintiffs' Counsel in reply accepted that argument by way of assumption, and I do the same. I assume that the transaction of the 10th of *July* was not operative to pass the trade mark to the Plaintiffs, and that if the business ended then and there the Plaintiffs would have purchased for the £25 merely a label which probably they could have had made for them for 20s. or so. But assuming that the transaction in *July* was inoperative and indeed void, it still left open to the trustee in bankruptcy to make a valid assignment of the trade mark in connection with the particular part of the business of the bankrupt, and therefore it follows that the assignment of the 30th of *December* is valid. But again, the Defendants' Counsel raised a point, which was that as a matter of fact the goodwill of the business carried on by the bankrupt had ceased and determined before the 10th of *July* and certainly before the 30th of *December*. Now, it is not open to question that on a bankruptcy the goodwill of the business passes to the trustee, and he may sell it, and certain rights pass to the purchaser. The right passes to the purchaser to call himself the successor in business to the old firm which has become bankrupt. Of course, it does not preclude the bankrupt from resuming a similar business, and as close as he chooses to the old place of business. But then it was said that the goodwill had ceased, and there was nothing to assign, because the trustee in bankruptcy did not himself carry on the business, the effect of which argument, if adopted, would be that if the bankrupt's shop was shut up even for a few days, there would be a discontinuance of the business, and the trustee in bankruptcy, though it was a valuable estate, would not be able to turn it into money. It is necessary, to maintain the argument, to put it to the extreme length that I have just stated. The value of the estate is not the question, and there is no doubt that the goodwill of a business not actually carried on by the trustee in bankruptcy rapidly deteriorates, and I dare say that by the 10th of *July* it had ceased to be valuable, that is to say, it had ceased to be of any great value, but I am satisfied that the true intent of the trustee on the 10th of *July*, was not to sell, as contended, a mere picture to the Plaintiffs, his intention was to sell the trade mark, and I think, seeing what he afterwards did, and what he reasonably did, he meant to give the full benefit of that

trade mark and so much of the goodwill as he could lawfully convey to the Plaintiffs. The case of *Hudson v. Osborne* (21 L.T., N.S. 386), if any authority is wanted, is quite sufficient authority to show that in point of law a trustee in bankruptcy can sell the goodwill. So that the argument for the Defendants really results in this, that the goodwill here taken by itself is of very little value. The result, in my opinion, is that this is a valid assignment of the trade mark in connection with a particular portion of the goodwill of the business which it was competent for the trustee to assign.

The next objection came strangely from the Defendant *Collyns*. It is that the Plaintiffs are not using the trade mark as registered.

9 R. P. C.
307, l. 17.

Now, I adhere to what I said in *Melachrinio's Case* (*infra*, p. 223), that the mere addition of something, as in that case a coat of arms, to the trade mark, is not sufficient to disentitle a person who otherwise uses the whole of his trade mark to sue for an injunction. That proposition is sufficient to dispose of that argument which is founded on the shield. Then with regard to the words "trade mark" under the shield, there is the observation of the Lord Justice FRY in the *Apollinaris Case* (*supra*, p. 51). It is a question of fact in every case where a man puts the term "trade mark" on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only. In the *Apollinaris Case* (*supra*, p. 51) the Lord Justice's observations were addressed to a label which had been registered and had the term "Friedrichshall" above a disc with a quantity of printed matter; the disc was coloured red, and underneath the disc, following the lines of the circumference, but outside the disc, were the words "trade mark." Without expressing a final opinion upon the matter, the Lord Justice thought that there were grounds for saying on that label that the trade mark referred to the disc, and if I may say so myself with great respect it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words "trade mark" in the middle of this label do not indicate to the public that the shield only is the trade mark. In the *Apollinaris Case* there was no other device except the disc which was coloured red in use.

9 R. P. C.
308, l. 23.

Then, as to the passing off, I shall not go through the facts. My opinion is that the Plaintiffs, quite apart from the right to the trade mark in this case, had put the goods upon the market in such a manner that they had acquired a reputation in connection with this trade mark, treated as a label, and that the goods had

come to be known, sufficiently for the purposes of an injunction, in the market with this label upon them as the Plaintiff's goods. As is well known, where there is a label and get-up, the name of the maker, or the name of the person who selects the goods, is very often not disclosed, nor is it necessary that it should be. I am not saying that the goods are known in the market as *Hammond's* goods, but that the goods which *Hammond* puts on the market with this label on them (treating it not as a trade mark) had acquired a sufficient reputation to justify my holding, as a fact, for the foundation of an injunction on the second ground, that the goods were known in the market as his goods.

RE HANNAY'S TRADE MARK.

[December, 1889. 7 R. P. C. 46.]

Trade Mark—Fancy word—Act of 1883, s. 64, sub-s. 1 (c).

Motion.

In 1887, *J. B. Hannay* registered the following trade mark: "Hannay's Electroid Antifouling Composition." An action was subsequently commenced against him by Messrs. *Dick & Co.* for infringement of a patent. In the course of the action *Hannay* made an affidavit in which he stated that he used the word "Electroid" to indicate the presence of electrical action combined with his new process. The Plaintiffs thereupon launched a motion to expunge.

Mark expunged.

CHITTY, J.—[Counsel for the Respondent] stands on "Electroid," and says that is a meaningless word with regard to this subject matter. But his client swears, and there is not the least ground for doubting the truthfulness of his client, that he used the word "Electroid" to indicate the presence of electrical action combined with his new process. It is clear therefore it has a meaning, and that it is intended, by the person who uses it, to describe the article. Nothing more is to be said.

7 R. P. C.
47, l. 21.

RE HANSON'S TRADE MARK.

[November, 1887. 5 R. P. C. 130 ; 37 Ch. D. 112 ; 57 L. J. Ch. 173 ;
57 L. T. 859 ; 36 W. R. 134.]

Trade Mark—Distinctive device—Colour—Act of 1883, ss. 64, sub-s. 1 (c), 67.

Motion to proceed.

In 1881, Messrs. *Hanson & Co.* registered as an old mark in class 42 for coffee, three parallel stripes, the two outer ones shaded, and the middle one white, with the words "Red, White, and Blue" printed across them. In practice they used the mark in the colours red, white, and blue. After the Act of 1883 came into operation, Messrs. *Hanson & Co.* applied to register as a new mark for all the articles in class 42, other than coffee, a device consisting of three parallel stripes of the same width, one of these stripes being red, one blue, and one white. There was no line drawn between the stripes, nor was there anything to divide them from one another except the colours. The Comptroller refused registration. The Applicants appealed to the Board of Trade, and on the matter being referred to the Court, the Comptroller's refusal was upheld.

5 R. P. C.
132, l. 53.

KAY, J.—To see whether the argument addressed to me on behalf of the Comptroller is right, I must look at the 67th section. Up to the time [when the Act of 1883 came into operation] colours could not be registered. What says this Act? "A trade mark may be registered in any colour," but then the mark must be a distinctive device, must be something independent of the colour, "and such registration shall, subject to the provisions of this Act, confer on the registered owner" what? "The exclusive right to use the same in that or any other colour." It is obvious that colour is, as I have said, treated as an accident, and that the distinctive device must be something which is distinctive independently of the colour. * * * In this case there would be no distinctive device independently of the colour, and if the Applicants registered it in one colour, or two or three colours, or half a dozen colours, they might use it in any colour or colours they pleased.

5 R. P. C.
133, l. 27.

An application to register the words "Red, White, and Blue" was abandoned, his Lordship saying:—I pointed out at once, that if the first mark could be registered, that would include the use of the words "Red, White, and Blue," and if anybody used "Red, White, and Blue" after that mark was registered, he clearly would be infringing that trade mark by a colourable

imitation ; and really the whole thing comes to this—the object is to get registration of the words “Red, White, and Blue,” which in my opinion are not fancy words.

HANSON v. GAME HARRISON & LARNER, LIMITED.

[February, 1892. 9 R. P. C. 186.]

Trade Mark—Act of 1833, s. 87.

Motion in action to restrain infringement.

In 1885, a partnership between Sir *R. Hanson* and Messrs. *E. Evison* and *H. Barter* was dissolved by the Court upon terms embodied in a consent order, the fourth clause of which was as follows :—

“That the said Sir *Reginald Hanson*, *Edward Evison*, and *Henry Barter*, and any partners they may take respectively, are to have the common use of all trade marks, and the right to publish the price lists heretofore published by the present firm.”

Evison subsequently became interested in the Defendant Company, and the latter commenced using two of the trade marks of the old partnership.

Injunction granted.

STIRLING, J., decided upon the facts that *Evison* was not a partner with the Defendant Company, and that the user complained of was not *Evison's*, but the Company's user.

STIRLING, J.—It is said that Mr. *Evison* is one of the registered owners of the trade mark, and in that capacity can grant a licence to the Company to use it. No doubt section 87 of the Trade Marks Act of 1883 says this :—His Lordship read the section (*supra*, p. 16) and the fourth clause of the consent order, and continued :—That means that these gentlemen are each of them to have the right personally to use those marks along with other parties. If it had been contemplated that each of them should have been at liberty to grant licences, it would have been wholly unnecessary to put any proviso with reference to the user by their partners, because if they could grant licences to the whole world, they could grant licences to their partners.

9 R. P. C.
188, l. 10.

9 R. P. C.
188, l. 31.

RE THE HARDEN STAR HAND GRENADE FIRE EX-
TINGUISHER COMPANY'S TRADE MARK.

[April, 1886. 3 R. P. C. 132; 55 L. J. Ch. 596; 54 L. T. 834.]

Trade Mark—*Fancy words not in common use*—*Act of 1883, ss. 64, sub-s. 1 (c), 90.*

Motion to strike out the registration of a trade mark registered as a new mark on 8th April, 1885, and consisting of the words "Hand Grenade Fire Extinguisher." The article in respect of which the mark was registered, consists of a bottle containing a liquid. The bottle on being thrown breaks, the liquid escapes, and the effect alleged to be produced is, that it extinguishes fire.

CHITTY, J., ordered the trade mark to be expunged from the register.

3 R. P. C.
134, l. 35.

CHITTY, J.—Every one of the four words are words in common use—"hand," "grenade," "fire," "extinguisher"—and they are all ordinary words to be found in any dictionary, and well understood by any person moderately acquainted with the English language.

* * * The four words appear to me to indicate, with very considerable precision, and with much greater precision than I am accustomed to find in matters of this kind, the nature of the article itself; and I should hold, as a mere general proposition, without regard to the evidence, which I shall discuss in a moment, that these words, which the Respondents call fancy words, are merely descriptive of the article—"hand," "grenade," "fire," "extinguisher." The bottle is something like the pomegranate, from which the military instrument or weapon called the grenade is taken; and everybody who understands the English language, knows that the grenade is a thing intended to be thrown, and it is known that it contains something inside it, and that, when thrown, there being a fuse, the fuse will ignite, and the thing will explode. Breaking is part of the notion, therefore, to be found in the use of the term "grenade," and the bottle, of which there are several specimens here in Court, is not unlike a grenade with a fuse in it. "Hand"—this grenade is to be used by throwing it with the hand; it is not shot from a gun, or anything of that kind, and it does serve to extinguish the fire by breaking the glass bottle and allowing the contents to escape. These are questions of trade terms, and it is a great mistake to suppose that in trade, terms are found of great accuracy. On the contrary, there is a very considerable looseness allowed. This is not a question—and I say this emphatically—for a grammarian or philologist. It is a question

of the ordinary fair meaning of the term to any ordinary Englishman; and there are many illustrations I could give—some of which I gave in the course of the argument—where words have got into the language, and pass current, and are very good words, which do not please the philologist, who never would be satisfied. Of course, after a time, the learned philologist accepts them, and takes them as part of our ordinary stock of English language. Professor *Henry Morley*, of whom I desire to speak with the greatest respect, has stated in substance in his affidavit that he considers this a fancy term, and that the term—as a whole, he must mean—is not in common use. There is another learned Professor, who takes a view which is wholly opposed to this. He considers the term not fancy, and considers the words in common use; and they certainly were in use about two years before he made his affidavit. It is the first time I remember any affidavits being filed to explain the English language, but I accept them, and I have no doubt both these gentlemen do state their view with perfect accuracy. But it is really a question, as I have said, which does not depend upon expert evidence. I remember no case in which, in order to explain the English language, expert evidence has been allowed to be adduced. Of course there are many cases in which experts in the market are allowed to come forward and explain the market terms or the like, such as the terms of a charter-party and any other mercantile document. But, however this may be, without pressing this too far, it is for the Court to decide; and I do consider these words to be mere description. I hold that as a general proposition.

Now I will go to the evidence, which I will deal with very shortly. (His Lordship discussed the evidence and said:—)

3 R. P. C.
135, l. 52.

I am satisfied that in this country the term was well known, and in common use at the time the Respondents on this motion applied for the registration.

3 R. P. C.
136, l. 24.

RE HARGREAVES' TRADE MARK.

[February, 1879. 11 Ch. D. 669; 27 W. R. 450.]

Trade Mark—“*Leave of the Court*”—*Act of 1875*, s. 6—*T. M. R.* 1876, r. 19 (*infra*, p. 390).

Motion for leave to register.

In *Jan.*, 1879, *J. Hargreaves*, of Liverpool, provision merchant, applied to register a trade mark, consisting of the words “Anchor Brand,” surmounting a representation of an anchor, as a new mark

in respect of "Substances used as food (Class 42), *i.e.* Bacon and Hams." The Registrar refused to register without leave of the Court, as there were already four marks consisting in part of an anchor on the register in respect of goods in Class 42 (namely):

1. Biscuits for feeding dogs and other animals, and biscuits generally; 2. cattle food, &c.; 3. butter; and 4. imported articles of food, *viz.* preserved fish, vegetables, and meat, also fresh meat and shell-fish.

Not one of the four marks registered was identical with *Hargreaves'* mark, but each of them consisted of an anchor with words or initials. There was evidence to this effect, that the words "Preserved Meat" (one of the nineteen articles mentioned in Class 42) had a well-known meaning in the provision trade, and was applied solely to meats, both fresh and cooked, imported in tins, and not to bacon or hams, or produce of a similar character, and that the public would not be deceived by the use of the mark for bacon and hams, to the prejudice of any of the proprietors of the other four marks registered.

Motion refused.

11 Ch. D.
674.

HALL, V.-C.—The Court has a discretion given to it by force of the words in the 6th section of the Act, and the 19th rule, "without leave of the Court." The Court, in exercise of its discretion, must have regard to the circumstances of the particular case. The general law being that you must only have one mark of one kind on the register, without the leave of the Court, the onus is upon those who ask for leave, and they must make out a case, and a substantial and good case. The person selecting a new mark has nothing to do but to ascertain all the marks (which it must be supposed he is capable of doing), which have been registered as to goods in the class, and he can then select another mark which would lead to no inconvenience whatever. In regard to this case, no less than four marks of the "anchor" have actually got on to the register, as new marks apparently; at all events they are on the register, either as old marks or as new marks; there may be some of one and some of the other, and the distinction which has been attempted to be made between the different characters of the goods for which this mark is now sought to be registered, and the other descriptions of goods for which it has been already registered, is not, I think, so clear, that I ought, in the exercise of my discretion, to give the leave asked for.

HARGREAVES v. FREEMAN.

[May, 1891. 8 R. P. C. 237; (1891) 3 Ch. 39; 61 L. J. Ch. 23; 65 L. T. 487.]

Trade Mark—Infringement—Merchandise Marks Act, 1887—Registration for entire class—User for part of class—Costs.

Motion in action to restrain infringement.

In 1879 the Plaintiffs registered under the Act of 1875 for Class 45 (that is, manufactured and unmanufactured tobacco), a trade mark consisting of (1) three crowns within a shield, (2) the words "The Three Crowns" printed above, and "Mixture" printed below the shield, (3) "R. Hargreaves" on one side, and "Hull" on the other side of the shield. This trade mark the Plaintiffs used only on packages containing cut tobacco. "Mixture" means in the tobacco trade a mixture of cut tobacco, and is never used in reference to cigars.

The Plaintiffs also sold cigars in boxes, to which they affixed labels containing (1) three crowns within a shield, (2) the words "The Three Crowns" over the shield, (3) "Habana" below the shield, (4) ornamental leaves and flowers. On the top of each box was printed the words "British Manufacture." The Defendants sold cigars in boxes to which they attached labels containing the device of the three crowns, and the words "The Three Crowns" over the device. The Plaintiffs brought an action against the Defendants to restrain infringement of their registered trade mark.

Motion refused without costs.

CHITTY, J.—One point raised by the Defendants' Counsel may be disposed of in a few words. At one end of the boxes containing the Plaintiffs' cigars, there is affixed a label with the word "Habana" printed on the label itself, and on the top of the boxes there are printed the words "British Manufacture." On these facts alone it is argued for the Defendants that the Plaintiffs were not entitled to any relief, on the ground that by the use of the word "Habana" the Plaintiffs were guilty of a false representation. In support of the argument, reference was made to the Merchandise Marks Act, 1887, and I was asked to hold in substance that the Plaintiffs were guilty of a criminal offence under that Act. The argument was pushed to that extreme length in the absence not merely of any evidence, but of any suggestion in the Defendants' affidavits, that the point would be raised. It is scarcely possible to deal seriously with such an argument. The word "Habana" by

R. P. C.
239, l. 51.

itself might mean that the tobacco was grown in Havana, and the cigars themselves manufactured there; or merely that the tobacco was grown in Havana, while the cigars were made elsewhere; or, possibly, that the cigars were in the fashion of cigars made in Havana. See *Newman v. Pinto* (*infra*, p. 242). Having regard to the words "British Manufacture" at the top of the boxes, it would be difficult, and in the absence of evidence impossible, to assume that the Plaintiffs represented that their cigars were made in Havana, and in the absence of evidence it could not be assumed that the tobacco, of which the Plaintiffs' cigars were made, was not grown in Havana.

8 R. P. C.
239, l. 33.

His Lordship stated the facts, and said :—

The Plaintiffs have thus used, in reference to tobacco, a mark which is both less and more than their registered trade mark. The parts of their registered trade mark which they have uniformly omitted from the cigar label are the name "*R. Hargreaves*," the place "Hull," and the word "Mixture." The alleged infringement of the registered trade mark relates solely to cigars manufactured and sold by the Defendants. * * * The Defendants claim no trade mark, and have given no explanation why or how they came to use such a label. They have plainly taken the essential parts of the Plaintiffs' registered trade mark, but only with reference to cigars, and the Plaintiffs have never used their registered trade mark with reference to cigars. * * * Upon these facts it is argued for the Defendants that although the Plaintiffs have registered their trade mark for the whole of Class 45, yet by force of the terms of the trade mark itself it is confined to part only of the goods within the class, and therefore the registration should be restricted to such goods only.

Now the term "mixture," according to the evidence as it now stands, is not appropriate to cigars. It appears to me as a Judge of fact, that the term "mixture" as applied to cigars, would not operate as a recommendation, but rather as a deterrent, to an intending purchaser. It would repel rather than invite. The Plaintiffs have never ventured to apply it to their cigars. It is an important, and indeed an essential, part of their registered trade mark. The fact that although the Plaintiffs' registered trademark has been on the register for upwards of eleven years, they have not used it in connection with cigars, is strong evidence to show that it is not applicable to cigars.

8 R. P. C.
241, l. 17.

In *Edwards v. Dennis* (*supra*, p. 117), COTTON, L.J., stated his opinion that it was not the intention of the Act that a man registering a trade mark for the entire class, and yet only using it

for one article in that class, can claim for himself the exclusive right to use it for every article in the class. The other LJJ. appear to have been of the same opinion. There is no doubt a further distinction between the two cases, namely, that the Plaintiff there never made steel wire, whereas the Plaintiffs in the case before me have manufactured and sold cigars; but on the question of user there is no substantial difference. In fact, the Plaintiffs' case appears to resolve itself into this. They are, or claim to be, the proprietors of two trade marks, one for cut tobacco or mixture, which they have registered, the other for cigars which has not been registered, and registration of which has not been refused. They are really attempting to sue on the latter, which they cannot do by reason of the Act of Parliament.

I can give the Plaintiffs no costs, because they obtain no order on the motion which has been opened. I decline to give the Defendants any costs, because they have, through their Counsel, made a charge of fraud which has failed, and in other respects they are destitute of merits.

8 R. P. C.
241, l. 40.

RE HARRIS'S TRADE MARKS.

[July, 1892. 9 R. P. C. 492.]

Trade Mark—*Fancy word not in common use*—*Act of 1883, ss. 64, sub-s. 1 (c), 90.*

Motion to expunge two trade marks, consisting of the words "The Beatrice" and "The Beatrice Shoe, Imperial Quality," which were registered as new marks for shoes in 1884 and 1885.

Motion granted.

STIRLING, J., referred to the judgments of the LJJ. in *Re Van Duzer's Trade Mark* (*infra*, p. 334), and said:—Is the word "Beatrice" as applied to a shoe "obviously one which cannot have any reference to the description or designation of where the article is made, or of what its character is"? or is it "obviously non-descriptive"? or is it "a fancy word of its own inherent strength"? And I am to remember in dealing with it that the Act of Parliament is addressed to ordinary English people. Now, when an ordinary English person reads the designation "The Beatrice," I think the first thing that would occur to his mind would be that it had some reference to the lady, a member of the Royal Family, who bears that name. Then that being so, is it obviously non-descriptive? It seems to me that it suggests that the article is of the character which might very fitly be worn by a lady in that position. That seems to me a suggestion which lies on the face of it—a

suggestion as obvious as the application of "Electric" to velveteen. of the word "Britannia" which occurred in the case of *Hodgson v. Sinclair* (*infra*, p. 162); of "Strathmore"; and of the words "John Bull," which occurred in the case of *Paine's Trade Mark* (*infra*, p. 259), as applied to beer. The suggestion there, which the learned Judge found in it, was, that it was applied to designate a beer which had the characteristics of John Bull, apparently with reference to the burly form and bluff nature ascribed to the typical Englishman. If these decisions be correct, and I see no reason to quarrel with them, it seems to me that equally in the use of the word "Beatrice," as applied to shoes, there is a suggestion made, and it cannot be said to be obviously non-descriptive.

RE HARRISON'S TRADE MARK.

[November, 1889. 7 R. P. C. 25; 42 Ch. D. 691; 59 L. J. Ch. 22; 61 L. T. 484.]

Old Trade Mark—User to designate design—Rectification.

Motion to expunge.

In 1884, *Harrison McGregor & Co.*, agricultural instrument manufacturers, registered the word "Albion" as a trade mark for goods in Classes 6 and 7, stating user for 18 months prior to 13th Aug., 1875. The mark was unchallenged for 5 years, but in 1889 a motion to expunge was launched on behalf of the Defendants in an action brought by *Harrison & Co.* to restrain infringement.

KEKEWICH, J., held, upon the evidence, that the word "Albion" had been used by *Harrison & Co.* prior to 1875, to designate agricultural implements of a particular design or pattern, and not as a trade mark, and he accordingly directed the trade mark to be expunged. By agreement, however, an order was made only for the limitation of the registration to certain specified goods, subject to the Comptroller not objecting to an order in that form.

HART v. COLLEY.

[February, 1890. 7 R. P. C. 93; 44 Ch. D. 193; 59 L. J. Ch. 355.]

Trade Mark—Infringement—Different classes—Act of 1883, ss. 62, 65, 70, 77.

The Plaintiff in this case was the owner of a trade mark, registered in Class 6 (machinery), for "a toilet requisite, being a machine to hold a reel of perforated paper." The trade mark itself represented this machine with a reel of perforated paper within it. In an action brought by the Plaintiff against the

Defendant to restrain infringement and passing off, the Plaintiff alleged: "The Defendant is a dealer in toilet requisites, perforated paper, and similar goods, and has sold large quantities of perforated paper contained in wrappers, and has issued large numbers of circulars and advertisements, whereon there were printed the registered trade mark of the Plaintiff."

Perforated paper comes within Class 39. The Defendant raised the point, that he was not selling goods within Class 6, in respect of which the Plaintiff was registered, and that the Plaintiff could not sue for infringement.

NORTH, J., at the trial sustained the point made by the Defendant.

NORTH, J., referring to sect. 77, said:—It is quite true that but for that section the Plaintiff could not sue at all, and to some extent he has done what is necessary in getting registration; but for registration he could not sue at all. However, there is nothing in the section to say, that if he once has registered, he is entitled to sue in respect of anything. It is simply a negative, imposing a condition precedent, registration under the Act, as a necessary preliminary. 7 R. P. C.
96, l. 51.

His Lordship, after referring to sects. 62, 65, and 70, continued:—I do not see what the requirement for registration as to particular goods or classes of goods, and these requirements under which the applications are to be made for particular classes and so on, are for, if the Plaintiff can, by registering in respect of one class, have a right to sue in respect of all, which I understand the argument to be. I think the express object of requiring the application for registration to be in respect of particular goods and classes of goods, is to confine the registration, and the right to sue in respect of registration, to the goods so indicated. 7 R. P. C.
97, l. 27.

His Lordship then cited *Edwards v. Dennis* (*supra*, p. 117), and said:—Now it would be absurd to say, that if a man registers under Class 1, in respect of particular goods in that class, he cannot sue in respect of other goods in that class, but can without any other registration, sue in respect of all goods found in all the other classes. It is impossible to come to the conclusion that that could be so, and as it is decided that a man can register with respect to such only of the goods in any given class as he has used his marks upon, it follows *à fortiori* that a man who is registered in respect of one particular class cannot by virtue of such registration sue in respect of goods which are not within that class at all. 7 R. P. C.
93, l. 5.

HATCHARD v. MÈGE.

[April, 1887. 18 Q. B. D. 771; 56 L. J. Q. B. 397; 56 L. T. 662; 35 W. R. 576.]

Trade Mark—Slander of Title—Actio personalis moritur cum personā—R. S. C. 1883, Ord. XVII. rr. 1, 2.

Action brought by a wine merchant for (1) injunction to restrain infringement of a registered trade mark, (2) damages for and injunction to restrain publication of a certain alleged libel.

The statement of claim set out the alleged libel and the innuendo charged that the Defendants intended to convey the meaning that the Plaintiff had no right to use the trade mark, and that the wine he sold was not genuine. The Statement of Claim also alleged that in consequence of the publication of the libel, the Plaintiff had been injured in his credit and reputation, and in his trade of a wine merchant. After the close of the pleadings the original Plaintiff died, and an order was made by the Master under Order XVII. r. 2, that the action should be carried on in the name of his executrix.

The case as to infringement was abandoned at the trial.

At the trial Lord COLERIDGE, C.J., after hearing the opening statement of Counsel for the Plaintiff, directed a nonsuit to be entered, on the ground that the action came to an end on the death of the original Plaintiff.

The Divisional Court (Day and Wills, JJ.) directed a new trial in respect of so much of the libel as impugned the Plaintiff's right to use the trade mark.

18 Q. B. D. DAY, J.—This publication may be construed to mean that the
774. Plaintiff had no right to use his trade mark. This is not properly a libel, but is rather in the nature of slander of title, which is well defined in *Odgers on Libel and Slander*, c. V. p. 137, in the following passage: (His Lordship read the passage). It appears, therefore, that the * * innuendo in the present case suggests slander of title. As appears from the passage I have read, an action for slander of title is not an action for libel, but is rather in the nature of an action on the case for maliciously injuring a person in respect of his estate by asserting that he has no title to it. The action differs from an action for libel in this, that malice is not implied from the fact of publication, but must be proved, and that the falsehood of the statement complained of, and the existence of special damage, must also be proved in order to entitle the Plaintiff to recover. The question whether the publication is false and malicious is for the jury. Here, I think, special damage is

18 Q. B. D. 775.

alleged by the Statement of Claim, and if the Plaintiff could have shewn injury to the sale of the wine which he sold under his trade mark, he would have been entitled to recover, and that is a cause of action which survives.

RE HAYWARD'S TRADE MARKS.

[July, 1885. 53 L. T. 487 ; 54 L. J. Ch. 1003.]

Trade Mark—Disclaimer—Person aggrieved—Non-completion of Registration Act, 1875—Act of 1883, ss. 63, 73, 74, sub-s. 2, 76, 90, 113.

Two motions to rectify.

The first motion was by *R. Hayward & Co.*, canvas manufacturers, to expunge trade marks 28,402, 35,188, and 39,710, which had been registered by *R. Hayward & Sons*, canvas manufacturers.

The second motion was by *R. Hayward & Sons* to expunge trade mark 21,551, which had been registered by *R. Hayward & Co.*

Trade mark 28,402 (registered in 1882 as a new mark) consisted of a device and the words "Extra G," which words were common to the trade.

KAY, J., directed a disclaimer of the words "Extra G," and said:—"Sect. 74, sub-sect. 2 of the Act of 1883 (*supra*, p. 11) is a new provision, but it is a provision which had been sanctioned by the decisions of the Courts beforehand, and I refer to the case of *Re Kuhn & Co.* (*infra*, p. 200), which was an application under the former Act of 1875. That Act did not contain a provision as to altering and rectifying the register in which a representation common to the trade appeared ; but the Court nevertheless under that Act exercised the jurisdiction which it is now called upon to exercise in this case. Accordingly, although the provision in sect. 74 of the Act of 1883 is a new one, I am sanctioned by that authority to rectify the register." 53 L. T. 489.

Trade mark 35,188 (registered in 1884 as a new mark) consisted of a device and the words "*R. Hayward & Sons*," "Sole Makers, Extra Coker." It was admitted that *R. Hayward & Sons* were not sole makers of the canvas known as "Extra Coker."

Trade mark expunged.

KAY, J.—This mark is objected to under the Act of 1883, s. 73 (*supra*, p. 11), on the ground that it is calculated to deceive. His Lordship read the section and said:—"I cannot understand the mark as meaning anything but a statement that the proprietors 53 L. T. 490.

thereof were the sole makers of "Extra Coker," because the words "sole makers" precede those two words "Extra Coker," they being printed immediately above. Therefore I think that mark must be struck off the register.

Trade mark No. 39,710 (registered in 1884 as an old mark) consisted of a device and the words "*Hayward's Coker Canvas*." The Judge stated the effect of the evidence as follows :—

53 L. T.
490.

KAY, J.—The words were never stamped on goods, or advertised as a trade mark, but people coming to the place of business and inquiring for Coker Canvas would ask, perhaps, for "your Coker Canvas," or "Hayward's Coker Canvas." But that is not using the words "Hayward's Coker Canvas" as a trade mark, and I calculate on this evidence that these words "Hayward's Coker Canvas," for the first time registered on the 19th *Sept.* 1884, had not been used as a mark.

Trade mark expunged.

His Lordship then dealt with trade mark 21,551, which had been registered as a new mark in 1885, though the application for registration had been made in 1879. This mark consisted of a certain device and the words "Extra Coker." The mark was objected to *first*, on the ground that the Registrar ought to have treated the application as abandoned and to have refused to register the mark ; *secondly*, on the ground that the words "Extra Coker" could not be used as a trade mark.

53 L. T.
491.

KAY, J.—Sect. 63 of the Act of 1883 (*supra*, p. 9) applies in terms to the case of a pending application where the registration, at the time of the passing of the Act, has not been completed within twelve months, which is this case exactly. It seems to me, therefore, that the two sections, 63 and 113 (*supra*, pp. 9 and 23), may well be reconciled in this way. If it were not for the provision in sect. 113, a pending application would have been put an end to altogether by the repeal of the Act of 1875. But the meaning of sect. 113, read in conjunction with sect. 63, seems to me to be this : The pending application shall not be put an end to by the mere force of words of sect. 63, but any pending application, if not completed by registration within twelve months of the time of the passing of this Act, shall come under sect. 63. That gives operation to both sect. 113 and to sect. 63, and makes them one. Therefore it seems to me clear that sect. 63 applies in this particular case, and the Registrar has no option left to him by sect. 63 at all, but he was bound to treat the application as abandoned. When, however, the Court has to deal with the matter it has two or three

things to consider. First of all, I think it is quite clear that under sect. 90 of the Act of 1883 the Court may either expunge or vary the entry as the Court thinks fit. The only reason suggested to me for doing either of those things is, that the five years after which, under sect. 76 of the Act of 1883, a registered owner gets an absolute title, as one may say, begins to run from the time of the application. If that period of five years were to run from the time of the application in this case, the Applicant would have his five years come to an end sooner than he had any legitimate right to. Therefore the Court may vary the order in that respect. Strictly I suppose the person who registered this trade mark ought to be put to the trouble and expense of making a new application, and it should be struck off the register; but no sufficient reason has been shewn to me for putting him to that expense and trouble. Therefore I think that the proper mode of dealing with the case or that part of the objection would be to vary the entry in the register by an addition to the effect that the five years mentioned in sect. 76 of the Act is not to run in this case from the date of the application, but from the date of the entry in the register. It is suggested that the Applicant in this cross motion is not the "person aggrieved;" but I think it is impossible to say that, because the decisions before this Act was passed were to the effect that any person interested in the same trade might, without showing any special damage to himself, be treated as a person aggrieved by any improper or inaccurate registration; and considering this is an improper registration, it seems to me that the person who applies to have it rectified, is the person aggrieved within these decisions and within the terms of the Act. As to this there is another objection. I must take the evidence to be that the words "Extra Coker" in combination had never before been common to the trade; but the word "Extra" was common enough to the trade, and the word "Coker" by itself was common enough to the trade. Accordingly, it seems to me, that the necessary application of this section is to enter a disclaimer on the register as to the use of the word "Extra," or the use of the word "Coker." Either word may be added to the trade mark.

RE HEATON'S TRADE MARK.

[July, 1884. 27 Ch. D. 570 ; 53 L. J. Ch. 959 ; 51 L. T. 220 ; 32 W. R. 951.]

Trade Mark—Fraudulent commencement of long adverse user—Continuing misrepresentation—Act of 1875.

Summons to proceed.

In 1882 *G. C. Adkins* and *G. Heaton*, trading as the *Brades Company*, iron and steel manufacturers, applied to register as an old mark for steel and iron, wrought and unwrought, a trade mark consisting of the letter L within a circle (known as "the Hoop L") in combination with the words "Brades Co., Warranted." The application was opposed by *Baron de Geer*, who was the owner of ironworks at Leufsta, in Sweden.

The Baron's predecessors in title had, in 1718, registered in Sweden as a trade mark the Hoop L, and their iron, so marked, had acquired a high reputation, particularly for manufacture into blister steel. By Swedish law all bar iron must be stamped with a duly registered mark before it is exported, and from the year 1835 (when the export trade with England commenced), the Leufsta iron was exported to England, marked with the "Hoop L" in combination either with the name of the English consignee, or with the word "Leufsta," or with both. In 1878 the Hoop L was registered in England by the Leufsta owners as a trade mark, both alone and in combination with the word "Leufsta." The Applicants and other English manufacturers had for many years bought the Leufsta and other Swedish iron, and manufactured the same into blistered steel, the Leufsta iron making the best steel. In the case of the Leufsta iron the stamp of the owners was not touched, and not being effaced by the process of conversion, appeared upon the steel when manufactured. In the case of other qualities of Swedish iron, the Swedish mark was cut off before the process of conversion was commenced, and the English manufacturers' mark (containing in each case the "Hoop L") was put upon the bar iron instead, and of course duly appeared on the manufactured steel. The Leufsta owners did not discover this adverse user till 1881.

KAY, J., dismissed the application with costs.

27 Ch. D. 576. KAY, J.—Where persons come and object, in whatever form, to the use of a trade mark, which has been used for a great number of years, it does not follow, as a matter of course, that the use for a great number of years is an absolute bar to obtaining an injunction ;

but, most certainly, it throws on those who object to the use the onus of proving that it was originally a fraudulent use, and that it is calculated to deceive; and very much stronger evidence is required in such a case where there has been a long user than would be required in another case.

But is the question the same as if I had now before me an application to grant an injunction? If I had before me an application to restrain this use by these present Applicants of the Hoop L mark, I must require * * very clear evidence that persons are now deceived by that use; but the Applicants say (and I hope they will not take exception to the language in which I put their argument), this has been done so often that it has lost its power to defraud, it has become so common a fraud among all manufacturers that it is impossible anyone should be deceived by it now, and therefore they say, not that the Court cannot grant an injunction, but that the Court must put its own seal upon this transaction, and add to it the approval of the Court by allowing the mark to be registered! I absolutely decline to do this. It seems to me there never was a clearer case brought before a Court of Justice.

This was evidently in its origin a gross fraud. I am not satisfied now, nor would any amount of evidence satisfy me, that this transaction, which I assume to be done in all innocence, is not calculated to deceive. To ask a Court of Justice to sanction by its fiat, and by allowing to be put upon the register a mark adopted in absolute fraud of the rights of another man; to ask to allow to be done, under the sanction of a registration permitted by the Court, this act which is properly characterised as a continuing misrepresentation, an attempt to make out that this iron of an inferior quality is the iron which is well known now in the market as the best iron produced, seems to me an utter absurdity, and absolutely out of the question. The question is not the same as whether the Court can grant an injunction or not, as to which I say nothing because that matter is not before me; but I most distinctly say, in my opinion, it is the duty of the Court to mark, in the strongest possible manner, its disapprobation of this kind of proceeding, however long it may have been sanctioned by custom. I say that I am not satisfied that this would not, if continued, be eminently calculated to deceive. I think it would be. It seems to me there may be many purchasers of this blistered steel and of iron, who, knowing the reputation which the Hoop L mark has obtained, and has had for so long a time, even for centuries, might well be deceived by seeing upon blistered steel, made

admittedly from Swedish iron, this Hoop L mark coupled with a name. The name which the Baron has from time to time added to the mark itself upon his own iron has from time to time been changed. What is to prevent a purchaser of the blistered steel supposing that the changed name was the name of the consignee of the Baron's iron? Nothing at all that I can make out; and besides that, I have staring me in the face on this trade mark of which it is sought to obtain the registration, the word "Warranted."

Now what does the word "Warranted" mean? Warranted what? Warranted, that it is manufactured into steel by the *Brades Company*? Clearly nothing of the kind. It means, if the word has any meaning at all, "we warrant this to be made from the Hoop L iron," a falsehood which certainly gains nothing in respectability from being continually repeated. That again is a reason why, if any other trade mark with the Hoop L as part of it could be registered, this is not that should be. I have no hesitation, therefore, in saying, that this is an application which ought not to be granted, and I dismiss it with costs.

HODGSON v. SINCLAIR;

RE HODGSON & SIMPSON'S TRADE MARK.

[C.A., November, 1891. 9 R. P. C. 22.]

Trade Mark—Fancy word not in common use—Act of 1883, ss. 64, sub-s. 1 (c), 90.

Motion to expunge a trade mark consisting of the word "Britannia," which was registered in 1886 as a new mark for soap.

Motion granted.

9 R. P. C.
24, l. 2.

CHITTY, J.—From the decision of the C. A. in *Re Van Duzer's Trade Mark* (*infra*, p. 334), and the subsequent decision of the same Court in *Re Waterman's Trade Mark*, the "Reversi" case (*infra*, p. 339), it appears that no word is a fancy word unless the word considered by itself is a fancy word—that the fanciful application of a word is not sufficient to make it a fancy word, and that no word is a fancy word unless it is obviously non-descriptive of the article to which it is applied. If you coined a word fancifully, you could not register it as a new trade mark, under the Act of 1883, if it had about it any element of descriptiveness in reference to the goods to which you applied it.

Confining myself within the limits of these authorities I proceed to consider the word "Britannia." It is a well-known geographical term in a well-known Latin form. It was used originally by Latin authors such as Tacitus, Cæsar, Cicero, and others, to designate Great Britain, or some part of it, and sometimes as including Ireland. In a similar way the terms Germania, Italia, Hispania, Sicilia, Hibernia, and others were used to designate these countries. These terms Britannia, Germania, and the others, although Latin in form, have been constantly used since the Latin language ceased to be a spoken tongue. The term "Britannia," or some inflection or abbreviation of it (spelt sometimes with two t's, as by some ancient authors—"Brittannia"), was used on the coinage of the Roman Emperors in this country, and still appears on the current coin of the realm. I have before me a penny issued in 1861, and another in 1879, with the letters "Britt. Reg." on them.

The word in its Latin form is not obsolete ; it is constantly used, and is intelligible to an ordinary Englishman. It occurs in the well-known patriotic song, it is applied to a compound metal, and to a well-known training ship, it is employed as the name for streets in London ; many other instances of its familiar use might doubtless be given. In fact, notwithstanding its Latin form, it may be said that it has been adopted, and naturalised as an ordinary English word. In its primary sense it denotes Britain. It is also used in a secondary and slightly different sense. In accordance with a habit of the human mind which delights in personification, it denotes a symbolical personage—so do Germania, Italia, and the like. Each of these words as there used, serves to denote the country, or its people, personified. * * * Even if taken in its secondary sense, it would not be a fancy word within the meaning of the term as explained by the C. A. A word is not a fancy word, merely because it denotes a thing which does not exist and never has existed. The terms Griffin, Centaur, Chimera and Winged Bull are not fancy terms, because there never was, nor is, anything in the actual world to correspond with them. They are the common appellations used to designate such fancy creatures. In the words themselves there is nothing fanciful. Again, the Plaintiffs urge that the Latin termination is sufficient to make the word a fancy word. If this were so, any other trader could at once have appropriated, under the Act of 1883, the terms Germania, Italia, and the like, and this reasoning, if followed out, would lead to the palpably absurd conclusion that a trader could appropriate as a trade mark the word "Germania" in reference to

sausages, "Italia" to olives, "Hispania" to wines, and "Londinium" to porter. As is shown by the "Reversi" case, a slight alteration in the termination of a common word so as to give it a foreign aspect or sound, will not suffice to make it a fancy word within the Act. It is not a mere question of grammar, but of substance. There is nothing fanciful in the word "Britannia" considered by itself; and it is not obvious to a person of ordinary intelligence, that it could not be intended to designate the place where the goods were produced or are used.

RE HOPKINSON'S TRADE MARKS.

[March, 1892. 9 R. P. C. 102 ; (1892) 2 Ch. 116 ; 61 L. J. Ch. 387 ;
66 L. T. 487.]

*Trade Mark—Special and distinctive words—Act of 1875, s. 10—Act of 1883,
ss. 64, sub-s. 3, 90.*

Motion to expunge several trade marks registered (some under the Act of 1875, and some under the Act of 1883), by Messrs. *J. & J. Hopkinson*, as old marks for pianofortes. These marks consisted of the words "J. & J. Hopkinson" (in ordinary capitals), "J. & J. Hopkinson, London" (in early English characters, surrounded in one case by scrolls and flourishes, and in another by an ellipse), "Hopkinson," and, "Hopkinson London."

Motion refused.

9 R. P. C.
107, L. 13. KEKEWICH, J., referred to the Act of 1875, s. 10, and said:—What do the words "special and distinctive word or words" mean? Are they really anything more than declaratory of the law as it existed before the passing of the Act? That is to say, do they do more than incorporate into the statutory provisions, what had existed before the Act was passed? In order to protect a trade mark before the Act, you were obliged to find, not only that the words were used as a trade mark, but that they were of such a character as may, I think, be fairly termed special and distinctive; that is to say, you were obliged to prove by evidence, and satisfy the Court, that the words used as a trade mark were known in the market, and—I think it is Lord WESTBURY'S phrase—gave a vendible character to the articles to which they were attached, made those articles recognised as coming from the particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore it seems to me that the Legislature here did no more than adopt the language of the cases, reduce it into a

compressed form, and really say that, what the Court would have held to be a trade mark independently of the Act, shall now be capable of registration as a trade mark under the Act, provided only that it has been used as a trade mark before the passing of the Act. What is the meaning of "special"? I think that "special" must be intended to mean that which separates the article to which it is applied from all others of the same class or character; something which points it out as standing alone; which makes the man who sees it or reads it, understand that it has a special standing—a special existence—that it is not one of the general class, say, of pianos, but that it belongs to a class of a particular character. "Distinctive" is a little different. There I would not hazard my own definition, because I have one to hand in the judgment which has been cited in *Richards v. Butcher* (*infra*, p. 287), where KAY, J., says: "The essence of a trade mark is that it is some distinctive thing which points out that the goods are the goods of A.B." Here we have "Hopkinson." It is quite true that there may be, and are, many *Hopkinsons*, and no one would contend that under the present legislation you could register "Hopkinson" as a trade mark. Nay, more than that, it must have been extremely difficult—at least it would be now—for Messrs. *Hopkinson* to build up the reputation of their pianos, so that they might be known simply by the name of "Hopkinson." According to what I have been told in this case, it would be now impossible, because there are other *Hopkinsons* in the trade, and they would not be allowed to do it. There would be competitors which would make it impossible. But that is just where the strength of their case comes in. They established their right to the name "Hopkinson" before others of the clan emulated them, and perhaps they emulated them, because of their great success. But having established it, why are they not entitled to keep it? Why are they not entitled to the reputation, and the advantage of the reputation, because somebody else now desires to trade in his own name? By all means let him trade in his own name. I am not now saying what he may or may not do, but what I do now say is, that Messrs. *Hopkinson* having registered this trade mark, and having proved to my satisfaction—because, although the evidence has not been read, it has not been disputed—that they used this word for many years before 1875, and that their pianos were known by this name in that way, I think they are entitled to retain on the register the trade mark which they have placed there.

With regard to the scrolls, &c. his Lordship said:—

9 R. P. C.
108, l. 37. I look upon that as a mere adventitious circumstance, the same as the little line which I put generally under my own signature—which I sometimes put in, and sometimes do not.

RE HORSBURGH'S APPLICATION.

[February, 1878. 32 W. R. 530 n. ; 53 L. J. Ch. 237 n. ; 50 L. T. 23 n.]

Trade Mark—Descriptive word—Act of 1875, ss. 6, 10.

Motion by Messrs. *Leonard & Ellis* (who were the registered proprietors of a trade mark for lubricating oils, consisting of a dotted shield with the word "Valvoline" written across), for an order that the Registrar should not register a trade mark, applied for by Messrs. *Horsburgh & Co.* in respect of the same goods, consisting of a portion of a steam engine with the word "Valvoleum."

Motion refused.

32 W. R.
530 n.

JESSEL, M.R.—I think this application ought not to be granted. The Complainants have a mark which is not a very old mark. They have used it for four years in this country or thereabouts for valve oil, and they choose to put on their mark, which was a kind of crescent with dots on it, the word "Valvoline," of which it is agreed by their Counsel, and in fact could not be disputed, that the essence is the word "Valve," meaning that the article is valve oil. Instead of calling it "Valve oil," they call it "Valvoline," but they might as well have put "Valve oil" on it at once. However, they have called it "Valvoline," and they have made "Valvoline" their trade mark. This is a new word, but the only novelty is in the "oline." The "valve" is old, and this is the essential part; therefore the novel part is not essential. The Respondents are also oil sellers, and they propose to register a new mark which has not the most remote resemblance to the device of the Applicants.

His Lordship described Messrs. *Horsburgh's* device, and continued:—

They may add a word, and their word is "Valvoleum." Now, "Valvoleum" is valve oil again, nothing else. I do not think they can claim much for their invention—but instead of writing "valve oil," they write "Valvoleum." Both parties represent, on their trade mark, that they sell valve oil of their own manufacture, and why should they not? The Applicants say, "We sell this valve oil, and it is distinguished by this peculiar thing, a crescent—

shaped device with holes in it like a colander." The Respondents say, "We sell valve oil, and distinguish it by this other device, and you may know our valve oil from the Applicants' valve oil." Can the Applicants put forth any exclusive right to sell valve oil, or to make "valve oil" a part of their trade mark? That is not a trade mark; that is an attempt to exclude all the rest of the trade from representing that they sell valve oil, for that is the meaning of it. It was admitted by their Counsel that that is the meaning of it, for they said that "valve" was the main part of it. They could not restrain other people from using "valve," but the new part "oline." The Respondents do not use "oline," but "oleum," therefore the Applicants' invention is not taken. The old thing, which everybody had a right to use, is taken, and I think there is no ground of complaint whatever.

A man, who sells valve oil, cannot have a right to prevent other people from using the word "valve," because that is common property to all the world, and it would give him the advantage of representing that he was the only seller of valve oil, if he could exclude other people from using it. It appears to me that this application is wholly groundless, and it has no support whatever in the Act of Parliament as regards deception. A mark, such as is used here, is not deceptive at all, if the owners sell valve oil. The deception in the Act of Parliament refers to the words themselves being calculated to deceive, not to deception being occasioned because they are like another trade mark. The words are, "by reason of their being calculated to deceive, or otherwise, be deemed entitled to protection in a Court of Equity," but the words are entitled to protection if they belong to anybody's trade mark. It is not competition between two trade marks to which reference is made; what is meant is a thing deceptive in itself, something representing the goods to be that which they are not for the purpose of deception. That is not to be registered at all. But the case with which I have to deal, is one in which the very Applicants themselves have registered the thing. It is, therefore, not within the 6th section. The mark may be registered, and the Applicants' only right to take it off the register would be, that it was an infringement of their trade mark, which I think it is not. So that Messrs. *Horsburgh* may register, and have their costs of this application. * * *

32 W. R.
531 n.

ASTON, Q.C.—Does your Lordship hold that the words "calculated to deceive" used in the Act, refer to some inherent deception in the words themselves, as where a man says that something

is a Chinese mixture which is not so, or that something is the subject of a patent which is not so?

JESSEL, M.R.—That is what is intended, because otherwise the words would have no meaning. The section refers to things which ought not to be registered at all, and the first person to register is equally within the prohibition. There is nothing in this provision which affects a man's rights to have a mark taken off the register, if it is an infringement of his trade mark.

RE HUDSON'S TRADE MARK.

[C. A., March, 1886. 3 R. P. C. 155; 32 Ch. D. 311; 55 L. J. Ch. 531; 55 L. T. 228; 34 W. R. 616.]

Trade Mark—User—Descriptive words—Disclaimer—Act of 1875, ss. 2, 5, 6, 10—Act of 1883, s. 74, sub-s. 2.

Summons to proceed.

In December, 1883, *R. S. Hudson* applied to register a certain label as a new trade mark for soap powder, soap extract, and dry soap. Round the edge of the label was a pattern; in the centre of the label was a black parallelogram on which were printed the words "Hudson's Carbolic Acid Soap Powder" in white characters. In the corner of the label was a device of a hand holding a washerwoman's dolly with the words "trade mark" printed in juxtaposition. This device had been previously registered by *R. S. Hudson* for the same goods. The application was opposed by *F. C. Calvert & Co.* on the ground that the words "Carbolic Acid Soap Powder" were not distinctive, but merely descriptive, and ought not to be registered, at all events, without a disclaimer. *BACON, V.-C.*, made an order allowing the application to proceed.

Appeal to the C. A. (Cotton, Bowen, and Fry, L.JJ.).

Appeal dismissed, but without costs; the Court being of opinion on the evidence, that the litigation was really due to a desire on the part of the Applicant to get some exclusive right to the words in question.

The Court held that the case was governed by the Act of 1875.

3 R. P. C.
159, L. 24.

COTTON, L.J.—The main point that was argued, and that we have to consider here (subject to what I shall have to say as to the particular thing proposed to be registered), as that which is proposed to be registered had never been used before the application, is this:—whether the Act of 1875 enabled anything to be registered as a trade mark which had not already been used; and

there is very considerable difficulty on that point, because the very essence of a trade mark independently of the Act was use.

His Lordship, after reading the Act of 1875, s. 10, said :— 3 R. P. C.
160, l. 1.
Sect. 2 is this : “ A trade mark must be registered as belonging to particular goods or classes of goods ” (that is not material), “ and when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in such particular goods or classes of goods.” Now that points to user, but of course we must recollect this, that it not only points to user, but it points to the mode in which title to a trade mark can be transmitted—that it can be transmitted only in connexion with the goodwill of the business engaged in making the goods for which the trade mark was registered. Then we come to this, “ but subject as aforesaid, the registration of a trade mark shall be deemed to be equivalent to public use of such mark.” Of course when we are dealing with a trade mark which had been used before the passing of the Act, the question I am now considering, cannot arise ; but this applies to both, and as far as one can see, the intention of the Act was this, that, independently of those things the title to which entirely arises from user antecedent to the Act, these particular things which sect. 10 says are to be trade marks, for the purposes of the Act may be registered, even although there has been no user of them so as to give a right independently of the Act, because it says the registration of a trade mark is to be deemed to be equivalent to public use of such mark. But, undoubtedly, that is a difficulty, because, when you come to register a trade mark, it is to be something which is to be considered as a trade mark before you apply and before you register, and in my opinion the meaning of the Act, though very obscure, is that those distinctive things which are comprised in the first part of sect. 10 shall be considered as trade marks even before they are registered, though giving no right to anyone to complain of the use of them until they have been registered, the registration being equivalent to public use of such marks.

Here the only objection to this label is this : that by using the words “ Carbolie Acid Soap Powder ” on the label which it is proposed to register, the Applicants are seeking to secure to themselves the exclusive right to use those words “ Carbolie Acid Soap Powder ” * * * It is a label, and I think a distinctive label, with words added * * * and the Act specially says, that to a distinctive label there may be added any words. In my opinion all that the registerer of this can claim is the label as his 3 R. P. C.
161, l. 41.

trade mark. He cannot say that a portion of this, such as "Carbolic Acid Soap Powder," can be claimed by him as a registered trade mark. It is not.

3 R. P. C.
162, l. 25.

His Lordship read the Act of 1883, s. 74, sub-s. 2 (*supra*, p. 11), and said :—The Act of 1875 contains nothing like that which I have read from the Act of 1883. There was a section referred to, but which I think does not apply to this case—the latter part of section 6 of that Act—(His Lordship read the section and continued):—In my opinion that does not give to the Court the same power as is given to the Court by section 74 of the Act of 1883. It points to there being something in the words which are upon the label that they are deceitful in themselves or scandalous, or something of that kind, so that under the old law no exclusive right to them could be gained. That I think does not apply. * * I regret that we have not got the power in this case, as the application was before the Act of 1883, of enforcing any disclaimer as a term of registering ; but, in my opinion, registering this label as a trade mark cannot give the Applicants any right by any length of user to the exclusive use of those words "Carbolic Acid Soap Powder." These are words merely of description, and not words which can be considered as distinguishing the make of the particular person.

3 R. P. C.
163, l. 25.

FRY, L.J.—When one looks at the first section, one finds that the register is to be of trade marks and of the proprietors of them in language which seems to assume that the pre-existing right of a proprietor to a trade mark is the thing to be registered ; and you find that the operative part of that clause only puts a fetter upon the right of suing of such proprietor of the trade mark. Then there are other clauses which seem in the same direction, and not least the second sub-section of section 5, which provides for the determination of the rights by the Court, of claimants of these trade marks—a matter which again seems to assume that there is an existing right to the trade mark. But on the other hand it is almost impossible to construe the Act, as it appears to me, without coming to the conclusion that the Legislature were minded in a somewhat obscure manner to effect a great and fundamental change in the law of this country. Before the passing of the Act the property in any trade mark could be acquired only by user, or, in case of cutlery goods, by an assignment by the Cutlers' Company ; but it appears to me that under the Act a new mode of acquiring a right to a trade mark is given, namely, by registration. The traces of that are to be found, especially, as it appears to me, in the two sections of the Act to which I will shortly refer,

the 5th and the 10th. The 5th section provides that "if the name of any person who is not for the time being entitled to the exclusive use of a trade mark in accordance with this Act, or otherwise in accordance with law, is entered on the register of trade marks," then the register may be rectified. That appears to assert that there are, or may be, two titles to the exclusive use of a trade mark, one in accordance with the Act, and the other otherwise in accordance with law. I think, therefore, that is an indication of the intention of the Act to give a new title to the exclusive use of a trade mark, and I am confirmed in that conclusion by the 10th section, which refers to user in cases of trade marks used before the passing of that Act; but it is silent with regard to the user of any other classes of trade marks. Therefore, although not without hesitation, and not without difficulty, I come to the conclusion that the true meaning of the Act was to enable a person who had invented a trade mark, which had not previously been used by some other person, to obtain registration of that trade mark, and to treat its being on the register as evidence of public user or equivalent to public user. With regard to the second question, the special circumstances of this case, I entirely concur in the view that by the label in question the Respondents cannot acquire any exclusive right to the use of the words "Carbolic Acid Soap Powder."

HUDSON v. OSGERBY.

[March, 1884. 32 W. R. 566; 50 L. T. 323.]

Trade Mark—Submission—Practice—Costs—R. S. C. 1883, Ord. LXV., r. 9.

Action to restrain infringement.

The Defendant submitting to a perpetual injunction with costs, the question was raised whether the costs should be taxed on the higher scale under O. LXV., r. 9.

PEARSON, J., read the rule and said:—Here there is no special ground. If I were to direct taxation of costs on the higher scale in the present case, I should be inflicting punishment on the Defendant for submitting to an injunction at once, instead of simply enjoining him not to infringe the Plaintiff's trade mark.

32 W. R.
566.

HUMPHRIES v. TAYLOR DRUG COMPANY (1).

[August, 1888. 5 R. P. C. 687 ; 39 Ch. D. 693 ; 59 L. T. 177 ; 37 W. R. 192.]

Trade Mark—Infringement—Misrepresentation—Particulars.

Summons.

This was an action to restrain the infringement of a trade mark, consisting of the representation of a ship with the word "Herbalin" below it, registered by the Plaintiff (a chemist of Low Morr near Bradford), in *January*, 1887, in respect of a preparation for the manufacture of "herb beer," which the Plaintiff alleged he had invented in *February*, 1885, and had since sold under the name of "Herbalin." The alleged infringement consisted of the sale by the Defendant, *W. B. Mason* (who carried on business at Bradford and elsewhere as a chemist, under the style of the *Taylor Drug Company*), of a similar preparation under the name of "Herbaline."

The Statement of Claim contained the allegation that the user by the Defendant of the word "Herbaline," "is an infringement of the Plaintiff's said trade mark, and the same is calculated to induce, and has in fact induced, divers persons to purchase the Defendant's preparation as and for the goods of the Plaintiff." On a summons for particulars by the Defendant, *KEKEWICH, J.*, ordered the Plaintiff to give the names and addresses of the "divers persons."

5 R. P. C.
689, l. 16.

KEKEWICH, J.—The real question on the second part of this case, which is different from the first, is: Has the Defendant induced divers persons to buy his goods as and for those of the Plaintiff? If it is once known to the Defendant that that has been done; that there have been such sales; that his goods have that effect, he will of course no further resist the action. If, on the other hand, he thinks that those are imaginary instances or insufficient, he will be prepared to meet them at the trial, and there will be no surprise. [It is truly said by Counsel] that there is a remedy at the trial, that is to say, that the Court may allow the case to stand over for that purpose; but that is an inconvenient result, and the object of particulars is to get rid of that whenever it can be reasonably done.

HUMPHRIES v. TAYLOR DRUG COMPANY (2) ;
 RE HUMPHRIES' TRADE MARK.

[November, 1888. 59 L. T. 820.]

Trade Mark—Fancy word—Descriptive word—Common to the trade—Entry on register—Act of 1883, ss. 64, sub-s. 1 (c), 74, sub-ss. 1 (b), 2, 90—Costs.

Trial of the action *Humphries v. Taylor Drug Company* (1) (*supra*, p. 172). Motion by the Defendant to expunge so much of the Plaintiff's trade mark as consisted of the word "Herbalin."

The Defendant in his Defence alleged that he had been the first to invent and sell a preparation which he called "Herbaline," and that the Plaintiff had copied the title "Herbalin" from him.

KEKEWICH, J., dismissed the action, and directed that a disclaimer by the Plaintiff of the word "Herbalin" should be entered on the register. His Lordship refused to give the Defendant any costs either of the action or the motion.

KEKEWICH, J.—The question is, whether the Plaintiff is entitled to his trade term "Herbalin;" and if my view of the law is correct, that is a mere question of fact. What is the law upon the subject? I will take it from the latest case decided by the Privy Council.—(His Lordship referred to *Somerville v. Schembri* (*infra*, p. 316), and to *Edelsten v. Edelsten* (1 De G. J. & S. 185), and continued):—[Lord WESTBURY in a] case, the name of which I cannot recall, uses the term "vendible" as applied to a commodity which it is the duty of the Court to protect against infringers. I understand [that expression] as well as that of "employed in the market," to mean, not merely that the article was made and sold, but that the actual quantity sold, and the area of sale, were extensive enough to give it an established position among goods of that class, and to make it known to persons vending or purchasing, that the article is the product of a particular firm. The question of fact, therefore, is, does the Plaintiff fulfil that position? My conclusion from the evidence is, that he commenced to sell this article some time in March, 1885, three months before the Defendant, whose sale cannot be put before June, 1885.—(His Lordship then reviewed the evidence as to the sales by the Plaintiff, and came to the conclusion that they were comparatively small, and that the Plaintiff had not copied the word "Herbalin" from "Herbaline." His Lordship continued):—Apart from any question about the trade mark, the Plaintiff, in my judgment, is not entitled to the protection which he seeks. But as the

59 L. T.
821.

Defendant has claimed to be first in the field, and has distinctly charged the Plaintiff with copying his word, both of which allegations are disproved by the evidence, I do not give him any costs. * * The Plaintiff's trade mark is a fancy mark, and nobody suggests that it is not a mark properly registered; but the question arises on the word "Herbalin," which is a striking feature of the registered mark. I have no doubt whatever that, standing alone, the word "Herbalin" could not have properly been registered, and it would have to be expunged. (His Lordship referred to *Waterman v. Ayres* (*infra*, p. 339), and *Re Van Duzer's Trade Mark* (*infra*, p. 334), and continued):—It comes down to this, that in order to be capable of registration, the word must be non-descriptive. Now "Herbalin," to my mind, is clearly something else than non-descriptive; it may not be found in any dictionary, but its present meaning is well understood, and when attached to herb extract, there is no difficulty in seeing that a meaning has become attached to it. But the word "Herbalin" does not stand alone; it is only part of the trade mark, and the authorities do not go so far as to say that what could not have been registered alone, cannot be registered as part of a trade mark. * * I therefore turn to the Act of 1883. Sect. 90 of that Act gives me power to direct any entry to be made on the register that may be necessary in order to effect complete compliance with the Act, and there is no question that the Defendant is a person aggrieved within the meaning of the Act, and may fairly bring this point before the Court. (His Lordship read sect. 74, sub-sect. 1 (b), and said):—I have to consider what is the meaning of the words "common to the trade." It is to be observed that the words are "common to the trade" and not "common in the trade." Any word which the trade might have used at the date of registration is, as I construe the Act, common to the trade. I think it means that a word, which might have been used for these particular goods by any other person at the time, is a word common to the trade. The date of the registration was *January*, 1887. At that time the Defendant had sold extensively, and had used the word "Herbaline." He might have used the very same word. "Herbalin" and "Herbaline" are therefore common to the trade. I do not think that the word "Herbalin" ought to have been entered upon the register. * * * Though I am bound to hold that the Defendant is an aggrieved person, still I think it is a small matter which, as far as I can see, is of no possible advantage to the Defendant. He cannot think it would interfere in the slightest degree with

the sale of his preparation. Taking these things into consideration, I think the Defendant must take the relief which he has claimed, but without costs.

RE HYDE & COMPANY'S TRADE MARK.

[January, 1878. 7 Ch. D. 724; 54 L. J. Ch. 395 n.; 38 L. T. 777;
26 W. R. 625.]

Trade Mark—Advertisement—Laches—Act of 1875, s. 5—Costs.

Motion to expunge.

In 1876, *Hyde & Co.* registered as an old mark for sealing-wax, the words "Bank of England" without opposition. This mark, though originally introduced by *Hyde & Co.*, was, prior to 1875, common to the trade to the knowledge of *Hyde & Co.*

After effecting registration, *Hyde & Co.* issued a circular to the trade stating the result of what had been done. Steps were immediately taken on behalf of the trade leading to this motion.

Motion acceded to with costs against *Hyde & Co.*

JESSEL, M.R.—Those who register a mark to which they are not entitled, do so at their own risk and peril. They must satisfy themselves before they register that it is a mark to which they are entitled, and I do not see any reason whatever for drawing any distinction between one title and another. If a man has a good title he has a right to register, and if he has no title, he ought not to attempt it. Of course there may be special circumstances in peculiar cases which induce a man to register, upon the representation of another that he had not a title, which prevent that other asking for costs against him, or asking to have the trade mark removed from the register. But, as a general rule, it must be understood that every man registers at his own peril.

7 Ch. D.
725.

The gentlemen who registered it, thought that as they were the first persons who used this mark, which had become common, they could now assert a right to the mark as a trade mark. That is not the law. I cannot, because they make a mistake as to the law, knowing the facts, exonerate them from the consequences of that mistake. Every man, knowing the facts, who chooses to act upon his own opinion of the law—who does not even take the trouble to consult a professional adviser—must take the consequences of so acting. Then it is said that the trade should have taken notice of the advertisement, which is inserted pursuant to the provisions of the Act of Parliament, to give notice to all the world of the intended registration. But the answer to that is,

7 Ch. D.
726.

that there is no obligation to see the advertisement. It is as a precaution that the Act gives people an additional opportunity, besides looking at the register, of knowing what is going to be done. But if a person interested does not see the advertisement, he is in no worse position than he would have been before. He must use due diligence, when the fact comes to his knowledge, to remove the trade mark. These gentlemen having registered the thing—I have no reason to doubt, in the *bond fide* belief that they were entitled to register—gave notice to the trade. The trade at once came forward.

7 Ch. D.
727.

When the notice of motion is given, what do the Respondents do? Do they yield? Not at all. They let the case come on, and it is not until after their Counsel have read the evidence on the other side, and found that they could not fairly occupy the time of the Court, having regard to the interests of other suitors, by discussing that which is really upon the evidence an unarguable case, that they very properly admit that they cannot argue the case upon its merits. * * *

It appears to me, so far from there being any reason to take this case out of the general rule, there is every reason for keeping it in the general rule, that the person who is wrong in litigation should pay the costs.

IHLEE v. HENSHAW.

[January, 1886. 3 R. P. C. 15; 31 Ch. D. 323; 55 L. J. Ch. 273; 53 L. T. 949; 34 W. R. 269.]

Trade Mark—Right of assignee of registered trade mark to sue before his name is on register—Act of 1883, ss. 62, 77, 87.

Action for infringement brought by *Ihlee & Sankey*, partners, who were assignees of the goodwill of the business of *Ihlee & Horne*, and of a trade mark passing therewith.

At the commencement of the action, the assignment of the trade mark to *Ihlee & Sankey* had not been registered, and the trade mark still stood in the names of *Ihlee & Horne*.

NORTH, J., held that the Plaintiffs could maintain the action.

3 R. P. C.
15, l. 37.

NORTH, J.—I think what was contemplated by the Act, was that there should be a registration from time to time, when an assignment takes place. I do not think there is anything in the terms of the Act making any such registration of an assignment a condition precedent on the part of the assignee to suing. If I were to read the 77th section, as [Counsel for the Defendant] contends, I

should have to read it in this way. "A person shall not be entitled to institute any proceedings to prevent infringement of a trade mark, unless it has been registered in pursuance of the Act, and if assigned or otherwise transmitted, unless such assignment or transmission shall also have been registered."

I cannot add those words to that section, and although I think that other sections of the Act contemplate that the subsequent dealings with the trade mark shall be registered, and it is very desirable that they should be, I do not think I can import those other sections into the 77th section in such a way as to say that no assignee shall be entitled to sue, in respect of the infringement of a trade mark duly assigned to him, unless, not only the trade mark but the assignment of it also, has been registered before action brought.

RE JACKSON COMPANY'S TRADE MARK.

[December, 1888. 6 R. P. C. 80.]

Trade Mark—Fancy word—Kokoko—Indian language—Similarity to word used on similar goods though not as a trade mark—Distinctiveness—Act of 1883, s. 64, sub-s. 1 (c).

Motion to proceed.

In 1885 the *Jackson Company*, an American firm, applied to register as a new mark for cotton goods in Class 24, the word "Kokoko," an onomatopoeic word used by the Chippeway Indians, and meaning "Owl." The figure of an owl was so commonly applied by trading firms to cotton goods that the Comptroller, acting upon the recommendation of the Manchester Chamber of Commerce, had made it a rule not to register any figure of an owl for cotton goods.

It appeared also that the word "Coco" was used, though not as a trade mark, in connection with cotton goods exported from Manchester to Spain and other foreign countries, the word "Coco" being a Spanish word, and meaning the berry from which "cocoa" is made.

The Comptroller refused registration. Appeal to the Board of Trade, who referred the matter to the Court. The Comptroller's decision was upheld.

KAY, J., said that it was admitted that the English word "owl" could not be registered as a trade mark for cotton goods and continued:—

The question is, can [the Applicants] register the name of an
C.T.M. N 6 R. P. C.
83, l. 40.

owl, that name being the name in a foreign, and, as it is said, an unwritten language, because that name would not be known in England or in most foreign countries to which cotton goods go. Now, there is some evidence that there is no trade with these Chippeway Indians, and that the tribe is dying out. It is very remarkable to me if cotton goods have not reached any part of America, I must say; and I do not know how long it may be before there is a trade in them. Supposing the trade to commence and flourish there, it is obvious there might be a question between the Owl goods which are called "Owl" in the language of the Chippeway Indians, and the Owl cotton goods which have the mark of an owl upon them, which would appeal to the eye of an Indian and be recognised in a moment. It is obvious that if such a trade existed, the word would not, in that trade, be a distinctive word or sufficiently distinctive, and the objection would be quite one which, in my opinion, the Comptroller ought to regard when he had to consider the question whether he should register the mark or not.

6 R. P. C.
84, l. 4.

Therefore, I think that on that part of the case, if it rested on that alone, there is enough to show me that the Comptroller was perfectly justified in saying "I do not think this mark sufficiently distinctive regarding the fact that cotton goods cannot be registered with the figure of an owl upon them, nor can they be registered with any word in any commonly known language which means 'owl.'"

6 R. P. C.
84, l. 26.

His Lordship referred to the use of the word "Coco" as above stated and said:—Now there it seems to me again a reason why, if there be a word like "Coco" in very common use as a mark on cotton goods, the Comptroller would be justified in saying this word "Kokoko" is not sufficiently distinctive. It is almost of the same sound, and might be very easily confused and mistaken when people are talking to one another, at any rate, for the old word "Coco." Therefore although the Applicants may be perfectly at liberty to use the word "Kokoko" as much as ever they like, and prevent all the world from using it, if the use of it would deceive people into believing the goods so marked were goods made or sold by them, still there is sufficient reason for not putting them on the register in England, by reason, first of the signification of the word, and then by reason of its likeness in sound to the other word "Coco."

JACKSON v. NAPPER;
RE SCHMIDT'S TRADE MARK.

[December, 1886. 4 R. P. C. 45; 35 Ch. D. 162; 56 L. J. Ch. 406; 55 L. T. 836; 35 W. R. 228.]

Trade Mark—Old mark—Application abandoned—Fresh application—Infringement—User—Act of 1875, ss. 3, 5, 9—Act of 1883, ss. 63, 76, 90, 113.

Summons for rectification and action to restrain infringement.

On 24th *March*, 1876, Messrs. *Schmidt*, a German firm of manufacturers of iron and steel goods, applied through the Trade Marks Protection Society (whom they had constituted their agents for that purpose), to register an old mark consisting of a joiner's square and compasses, in Classes 6, 7, 12, 13, and 49. The application was advertised in *February*, 1877, in the Trade Marks Journal, and a copy of the journal was sent to Messrs. *Schmidt*, who being under the impression that this was an announcement of registration, took no further steps in the matter, and continued using their mark as before. Shortly after this the Cutlers Company (at the instigation of the Plaintiffs, who carried on business at Sheffield, and had on the 17th of *March*, 1876, registered in Classes 5, 12, and 13, a Sheffield corporate mark consisting of a Maltese cross placed above a square and compasses), gave the Registrar notice of objection to the registration of Messrs. *Schmidt's* trade mark. The Registrar thereupon sent a letter addressed to Messrs. *Schmidt*, care of the Trade Marks Protection Society, informing them of the Cutlers Company's objection, and stating that the registration could not be proceeded with except by leave of the Court (Act of 1875, s. 9, sub-s. 4, *supra*, p. 4). This letter was never forwarded to Messrs. *Schmidt*, and the matter dropped. In *June*, 1885, the Plaintiffs commenced an action for infringement against Mr. *Napper*, Messrs. *Schmidt's* English agent. Messrs. *Schmidt*, on discovering that their application in 1876 had not been acted upon, made in *August*, 1885, a fresh application for registration of their trade mark in respect of the same five classes, and they obtained registration in Classes 6 and 49, but were refused in Classes 7, 12, and 13, in consequence of a notice of opposition which had been filed by the Plaintiffs.

The action and a summons by Messrs. *Schmidt* for rectification of the register, by placing their mark thereon in respect of Classes 7, 12, and 13, came on for hearing together, the Plaintiffs withdrawing their opposition except in respect of certain articles in Classes 12 and 13, viz. axes, hatchets, saws,

coopers' drawing knives, files, augurs, scissors, sheep shears, garden shears, anvils, hammers, vices, and trowels.

STIRLING, J., held that user in England prior to 13th August, 1875, of Messrs. *Schmidt's* mark had been proved in respect of all the above articles except sheep shears. Registration was therefore granted in respect of all the articles except sheep shears.

As regards the action an injunction was granted as to the sheep shears, the rest of the action being dismissed, but without costs.

4 R. P. C.
51, l. 39.

STIRLING, J., dealing with the 1876 application, said:—The main objection to that being proceeded with is founded on sect. 63 of the Trade Marks Act of 1883, which is to this effect:—(His Lordship read the section, *supra*, p. 9).—It appears to me plain that the section is retrospective. It applies where registration of a trade mark has not been completed, evidently referring to a mark as to which an application for registration was pending at the time of the passing of the Act. It was also suggested that sect. 113 prevented the application of that section, but when that clause is looked to, it appears to me that it does not so provide. (His Lordship read the section, *supra*, p. 23, and continued):—

4 R. P. C.
51, l. 58.

It is contended that that saved the former application. But all that that section does is to say that the repeal of the enactments is not to affect the application pending or the rights acquired, and it does not say that the provisions in the other parts of the Act are not to affect them, and there being a section—namely, sect. 63, which to my mind has a clear retrospective effect—it appears to me that that must be held to affect the application pending, if it was pending, and to govern it. That view I find has been taken by KAY, J., in the case of *Re Hayward's Trade Marks* (*supra*, p. 157), which was not referred to till a somewhat late stage in the argument. That being so, it appears to me I have to deal with sect. 63. Then upon that it was argued that it was no default on the part of the Applicant, and that that section only applies to a case of non-completion of registration by reason of default on the part of the Applicant. I think that is so, and it is necessary therefore to consider whether the Applicant Mr. *Schmidt* was in default.

His Lordship then dealt with the evidence, and held that Messrs. *Schmidt* must be taken to have authorized the address (care of the Trade Marks Protection Society) to be given and so far to be in default.

4 R. P. C.
54, l. 37.

Then comes the question,—what is the effect of this? The application is to be deemed to have been abandoned, but, in my

judgment, that does not prevent a fresh application being made. The matter has not been carried out at full length; the application has never been dealt with on its merits, though if the application had been dealt with on its merits and had been refused, I apprehend the matter would then be *res judicata*, and it would not have been competent for the Applicant to make a fresh application to go through the same process.

Still, here the application is merely "deemed to be abandoned," which being a technical term seems to me to mean only this, that he must begin afresh if he is going to take any further steps at all. Of course there might be, and I can imagine, cases in which it would not be right to allow him to begin afresh, or, at all events, he would be stopped at a very early period, because things might have taken place which would preclude him from bringing forward a fresh application. The position of the parties might be changed possibly in such a way as to preclude him from coming forward. But upon the evidence before me I cannot come to the conclusion that any such change has taken place. * * *

There is no such laches as to prevent Mr. *Schmidt* from making a fresh application, and I hold that it is perfectly competent for him under the circumstances of this case to make a fresh application for registration.

Then it is said, "but the Act precludes you from entertaining that." The Act is the Act of 1875. Section 3 says—(His Lordship read the section (*supra*, p. 1), and also s. 76 of the Act of 1883 (*supra*, p. 12), and continued):—

The Act of 1883 is better framed, no doubt, than the Act of 1875. The words in section 3 were very difficult to deal with, but they have been the subject of decision, and I take the substance of them to be given in the case of *Edwards v. Dennis* by COTTON, L.J. I will read his judgment, the others being practically the same thing. Dealing with this section he says:—(His Lordship read the passage *supra*, p. 118, line 21 to line 35). There the question was whether the registered trade mark was properly on the register, and they held that section 3 was no bar to that question being raised. Here the question is not whether the trade mark of Messrs. *Jackson* was properly on the register, but whether Messrs. *Schmidt* have not a right to be put on that register. I think that the same principle applies, and that as section 3 was no bar to an application to rectify the register by removing a trade mark which had got improperly on, so neither is it a bar to the right of a person who makes out a title to be put on

4 R. P. C.
55, l. 16.

the register, to have that enforced by registration. That is how it would have stood under the Act of 1875; and it seems to me that in effect the decisions have brought section 3 of that Act to be interpreted in exactly the same way as section 76 of the Act of 1883, which is more cautiously framed, and says that "the registration is, after the expiration of five years, to be conclusive evidence of his right to the exclusive use of the trade mark subject to the provisions of this Act."

Now among the provisions of the Act of 1883 are two which appear to me to be in point. One is section 62, which enables persons who have a right to a trade mark to make an application to the Comptroller; and the other is section 90, which is similar to section 5 of the Act of 1875, but in wider terms, and which enables the Court, on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under the Act, to make an order for making, among other things, such entry as the Court thinks fit. Mr. *Schmidt* being, as I hold, under no disability to bring forward this application by reason of any conduct on his part, appears to me not to be barred either by section 3 of the Act of 1875, or by section 76 of the Act of 1883, from so proceeding.

4 R. P. C.
56, l. 5.

The opposition [to registration] is founded on this, that it is alleged that there was no user of the mark in England in respect of the goods in question prior to 13th *August*, 1875. * * It is said, and I think rightly, that in order to entitle you to register, there being a similar mark already on the register, you must make out that there was a user of the mark in England prior to that date.

His Lordship then dealt with an objection that had been raised to Messrs. *Schmidt's* registering their mark for axes, on the ground that they had in fact sold hatchets under their mark. His Lordship pointed out that according to the definition in Johnson's Dictionary, hatchets were small axes, and continued:—

4 R. P. C.
56, l. 34.

The objection of course is founded on *Edwards v. Dennis* (*supra*, p. 117), in which it was held that a man having registered for iron goods and having manufactured, I think, sheet iron and applied a mark to that, was not to be entitled to stop another man from using the same mark in respect of iron wire, on which the former had never used it at all. That, to my mind, is a totally different thing from saying that a man who has used a mark on hatchets of a particular size and shape is not to be entitled to use that trade mark as applied to an axe, which is a thing of the same kind but a little different in size and a little different in shape.

No doubt at first the classes of goods under the Trade Marks Act were drawn too wide, and that has led to difficulty; but if I were to accede to this notion, and say that, because a man had merely manufactured small axes he was not to be allowed to register a mark in respect of axes, the logical consequence would be that he would have to register the shapes and sizes of everything to which he attached it. That was an inconvenience that was never intended to be imposed on an Applicant, and I hold on that broad ground that a man who has manufactured and applied his mark to small axes is entitled to register it in respect of axes. That is what it comes to.

His Lordship then dealt with the evidence, and held that there had been user in England by Messrs. *Schmidt* prior to *August, 1875*, of all the articles except sheep shears.

It appeared that sheep shears bearing Messrs. *Schmidt's* mark had been sent to England prior to *August, 1875*, but only for exportation. With regard to this his Lordship said:—Now, upon that, it seems to me that I cannot hold that there has been any real user in England of the mark on sheep shears, or, in other words, that these goods were on the market in England as vendible articles before 1875. If the goods had been purchased by a foreign firm, say, a firm in New York, direct from *Schmidt*, and the goods had been shipped by *Schmidt* to London or Liverpool, or some port in England, and taken out in England and inspected at the Custom House—simply opened for inspection—and then re-shipped for America, I cannot think that that amounted to a user in England of the trade mark. Then does it make any difference that the goods are ordered through an English intermediary, the goods themselves not coming into England any more than I have already described? I cannot see that it does.

⁴ R. P. C.
59, l. 8.

RE JAMES' TRADE MARK;

JAMES v. PARRY.

[C. A., August, 1886. 3 R. P. C. 340; 33 Ch. D. 392; 55 L. J. Ch. 915; 55 L. T. 415; 35 W. R. 67.]

Trade Mark—Pictorial representation of articles—Distinctive device—Act of 1875, s. 10.

Motion to restrain infringement, and motion to expunge.

In 1877, *Edward James & Sons*, the principal makers of dome shaped black lead (which was always sold by them as "dome black

lead"), registered as an old trade mark for black lead in Class 50, a drawing representing a piece of black lead of a dome shape. Messrs. *James* sold black lead, however, in other shapes besides the dome shape under their trade mark.—On Messrs. *James* bringing an action against Messrs. *Parry* for infringement, the latter moved to expunge Messrs. *James*' trade mark.

PEARSON, J., ordered the trade mark to be expunged.

Appeal to C. A. (Cotton, Lindley, and Lopes, LJJ.) by Messrs. *James*.

Appeal allowed.

3 R. P. C.
334, l. 24.

COTTON, L.J.—The Appellants here cannot possibly claim any monopoly in the shape in which they sell their black lead * * * but what they claim is the right to use this dome as a trade mark on their black lead in whatever shape they sell it. Now no doubt they have in some respects rather led to the supposition that they are using this trade mark as protecting their shape. That they cannot do. But supposing this is a trade mark which they annex to black lead in whatever shape they sell it, in my opinion there is nothing to prevent it being registered under the Act as a trade mark.

3 R. P. C.
344, l. 11.

LINDLEY, L.J.—Anybody may make black lead of this shape provided they do not mark it as the Plaintiffs mark theirs, and provided they do not wrap it up and represent it as the Plaintiffs' black lead. There is no monopoly in the shape, and I cannot help thinking that that has not been quite kept in mind. Now what the Plaintiffs have registered is a brand—a mark—a mark like a dome, intended to represent a dome. That that is a distinctive mark, as a matter of fact, is proved by the evidence, and that it can be a distinctive mark is obvious, I think, when you look at it.

JAY v. LADLER.

[November, 1888. 6 R. P. C. 136 ; 40 Ch. D. 649 ; 60 L. T. 27 ; 37 W. R. 505.]

Trade Mark—Registration for specific goods—Injunction—Fraudulent representation—Act of 1875—Act of 1883, s. 65.

Action.

In 1883, the Plaintiff (a fur dealer) registered a picture of a lady and a bear, as a trade mark in Class 38, for "sealskin mantles and sealskin coats," but he in fact always used the mark in connexion with all fur goods. The mark was not impressed on the goods themselves, but was affixed to the paper wrappers and the boxes in

which the goods were sent out to purchasers. The Defendant (a wholesale and retail furrier), some time after the registration of the Plaintiff's trade mark, commenced to issue a circular to his customers on which there was a picture of a lady and a bear, only slightly different from the Plaintiff's trade mark. The action was commenced in 1887, in respect of infringement, but at the trial an amendment was allowed, claiming protection under the general law in respect of all goods sold by the Plaintiff.

An injunction was granted restraining the Defendant from infringing the trade mark in connexion with sealskin mantles and sealskin coats, and also from using the device of the lady and the bear in such a way as to deceive the public into the belief that the Defendant's goods were the Plaintiff's.

KEKEWICH, J.—The first question which I have to consider is, whether the registration of the Plaintiff's trade mark, admittedly good in law, is applicable to all the goods in Class 38 of the rules issued under the Trade Marks Act, 1875, all of which it is conceded—or may for the purposes of the argument be conceded—he has manufactured and sold, or manufactures and sells; or must be restricted to the particular goods mentioned in the certificate at the time of registration—"sealskin mantles and sealskin coats." 6 R. P. C.
137, . 39

The Act says, in section 65, that "a trade mark must be registered as belonging to particular goods or classes of goods"; the rules say that "for the purpose of these rules, goods are classified in the manner appearing in the first schedule hereto, and if any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller." That points distinctly to the registration of goods as constituting a class, and to goods as belonging to one class or another being determined by the Comptroller; and if the schedule to the rules is looked at, it is found that in some classes there is no distinction, that is to say, there are no particulars given at all, and in others there are a variety of illustrations given. * * * It was competent to Mr. Jay to select to be registered under Class 38, for articles of clothing, with or without illustration, as he pleased and the Comptroller allowed. He might have registered for all these articles. What he thought fit to do, for reasons which I suppose were good to him, was this: he thought fit to register for "sealskin mantles and sealskin coats," and I think he must be kept within the limits of his registration. There is very little doubt that that was the intention of the Act, and that that is the proper construction of it and of the rules. 6 R. P. C.
137, l. 50.

His Lordship then decided that the Plaintiff had sufficiently used his trade mark in connexion with the articles for which it was registered, and that the issue of the Defendant's circular was an infringement. With regard to the relief asked by amendment, his Lordship said :—

6 R. P. C.
139, l. 19.

The general law, as expressed in [*Mitchell v. Henry* (*infra*, p. 227)], is to be found in a large number of cases, and is really based on law which existed long before the Trade Marks Registration Acts, and I know was once referred to by JAMES, L.J., as having been laid down three thousand years ago. It is to be found in a very homely proverb of two lines, which I shall not quote, and which is known to all of us in what—I do not know whether it is the English language, but what passes as the English language. A man is not entitled—whether in trade or out of trade—to take that which is another man's, and when a man in trade advertises his goods as being the goods of another person, he is doing that which is wrong in itself and liable to injunction in this Court.

His Lordship then decided that the Defendant had by the issue of the circular represented that his goods were the goods of the Plaintiff. Dealing with the difficulty caused by the limited registration, his Lordship said :—

6 R. P. C.
139, l. 57.

The Plaintiff may have been ill-advised; he may have gone beyond his rights; if so, he has done it at his own risk; but he has been guilty of no fraud. There is no impropriety in Mr. Jay endeavouring to appropriate “the lady and bear” as the description of his goods. If within a reasonable time after the registration, which was in the year 1883, Mr. *Ladler* or any other person had used the “lady and bear” for goods to which the registration could not apply, it would have been done with impunity. Mr. *Jay* would not have been able to say, “The ‘lady and bear’ designates my goods; my goods are known in the market as the ‘lady and bear’ goods; a man who sells ‘lady and bear’ goods, sells my goods, or says he sells my goods.” Therefore he ran for a considerable time great risk of having his mark taken by some other persons with impunity; but years have gone on, and now, without the slightest fraud, without the slightest impropriety, Mr. *Jay* has appropriated the “lady and bear” to his goods; and that being so, I see no reason why the general principle should not apply in his favour notwithstanding the defect, if defect it be, in his registration.

RE JELLEY, SON & JONES' APPLICATION.

[May, 1878. 51 L. J. Ch. 639, n. ; 46 L. T. 381, n.]

Trade Mark—Similarity—Old marks—User—Limited registration—Act of 1875, s. 6.

Summons to proceed.

In 1877, Messrs. *Jelley, Son & Jones*, wholesale ironmongers, No. 196, Blackfriars Road, applied to register the device of a pointer dog eating out of a porridge-pot, as an old trade mark for certain goods in Class 13, and as a new mark for "fencing-wire" in Class 5, and for files, stocks, dies, carpenters' and other edge tools, scythes, and rag-knives in Class 12. The mark had in fact been used for many years by *Jelley & Co.* in respect of the various small metal goods included in Class 13, being either impressed on the metal or printed on paper labels, but it had not been used by them on goods included in other Classes.

Jelley & Co.'s application was opposed by *J. & Riley Carr*, Sheffield, on account of the similarity of the mark to a mark consisting of the device of a pointer dog standing at a pail with the word "Stanch" in capital letters beneath it, and granted to their firm as a Sheffield corporate mark in 1849, and subsequently registered by them without opposition as an old mark with 28 years' user, in Class 5 for unwrought and partly wrought metals used in manufacture, in Class 12 for cutlery and edge tools, and in Class 13 for metal goods not included in other classes. They had used the mark on goods in all three classes, and in Class 5 principally on steel wire. Their files and saws had acquired the name of "Dog" files and "Dog" saws.

Jelley & Co. then took out this summons.

JESSEL, M.R., directed registration for Class 13.

JESSEL, M.R.—To deal with Class 13, the mark is an old mark, and there is no question but that both parties are entitled to register it. In the case of old marks the Registrar must register two or three, even if they are Sheffield marks, or even if they are identical. I direct registration of both. The 6th section of the Act only says that registration shall not be obtained without the leave of the Court, but you may make your application, and the rule of the Court is, if they are old marks, to register up to three, but not more than three, even if they are identical. Then if there are more than three applications to register, we do not register at all, because they then come under the classification of

51 L. J.
Ch. 639, n.

common property. So that if two or three people have used the same mark for 20 or 30 years, the only thing is that they must come to the Court to prove it. If two people have a right to the lawful use of an old trade mark, they are both entitled to register it. * * I have often had the case of a man in one town not knowing that another man in another town has used the same mark, and he has got his trade mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in section 6 is not a capricious leave. The rule of the Court which I have just stated, is always followed, and it merely means that the second man must shew his title. You cannot deprive him of his trade mark. Look at the monstrous injustice that would be done, if a man who had a trade mark for perhaps 40 years, should lose it, because another man who had it for 4 years, had happened to register it first.

JESSEL, M.R., refused registration for Class 12 and said :—

51 L. J.
Ch. 640, n.

If a man wants a new mark for his own goods, he must invent something for himself, and not adopt a mark which comes so near other people's marks that it may deceive. Do you mean to say that a man might adopt this mark, if he put the pot an inch more on the dog's nose? that it would make a difference? could he then take the mark? At the risk of repeating myself, I must say, what I always say in these cases, that if you want a new mark to distinguish your goods, the best thing for you to do is to invent a very distinct mark. Although the Applicants contend that they have used this mark for 25 years in the market, these particular goods have not been known by it. * * * As to what has been said with respect to the marks possessing distinguishing features, there is no obligation on a man who takes a new mark, to take any part of an old one; and if he does so, and does not give an explanation to satisfy me why he has taken it, I shall consider it to be a fraudulent mark; but that is, of course, not the case here, because there is a reason for it. The Applicants say that if they are allowed to use this mark in respect of certain goods, it is hard upon them that they should not be allowed to use it for the whole of their trade; but if they are going to sell goods which they never sold before, the answer is, that they can adopt a new mark upon them. Then it is said that the Applicants have been in the habit of using this mark upon their bill-heads and invoices, which they use not for such goods only as come within Class 13, but for the purposes of their business generally, and that it is therefore open to them to say that it is

their mark, to be used for the whole of their stock ; but that is not the application before me. Their application is to be registered for a new mark practically for something else, and not for their old business. * * *

When one comes to look at these two trade marks on the file themselves—for that is in my opinion the right way of looking at them—they appear to be a great deal too much alike for me to allow the new mark to be registered, because, after all, these cases do not depend merely on evidence. You can always get as much evidence on one side, as you can on the other : one set of experts say that the marks are alike, and the other set say they are not ; one side say that they are practically indistinguishable in the stamping, and the other side say that if the stamping is carefully and well done, they may be distinct ; whereas in practice they are particularly well struck, and one must, therefore, have regard not merely to the theory on the subject. I have always had regard in these cases of registration of new marks to the question of distinctiveness ; that is a very different question from the question of distinction as regards old marks, because a man who wants to sell new goods which he has not sold before, ought to want to distinguish his goods from those of other manufacturers, and therefore if a man is an honest man, the more distinctive the mark is, the better it must be for himself.

JESSEL, M.R., directed limited registration for Class 5 and continued :—

As to Class 5, however, the goods do not appear to clash, and *Jelley, Son & Jones'* mark may be registered for fencing-wire only. I will order it to be so registered, as I can order the mark to be confined to part of the Class. It is not to be registered for the Class generally, but for fencing-wire only.

51 L. J.
Ch. 641.

RE JONES' TRADE MARK.

[C. A., January, 1885. 53 L. T. 1.]

Trade Mark—Joint adventure—Deceptive mark—Act of 1875, ss. 6, 10.

Summons to proceed with opposed application to register.

Robert Jones, a merchant in Manchester, for some time prior to the passing of the Act of 1875, was in the habit of shipping cotton drills to *Andrews & Co.*, a firm at Manilla, for sale on commission, the goods (in common with other goods sold by *Andrews & Co.* for other people) bearing a trade mark representing the figure of Britannia, which mark was the property of *Andrews & Co.* After

the passing of the Act, doubts having arisen as to the propriety of using the Britannia mark, *Jones* wrote to *Andrews & Co.* suggesting the use of a new design; and they sent back a proposed trade mark, containing a representation of the house of business at Manilla of *Andrews & Co.* with their name on the signboard of the house. Beneath this were three perpendicular columns in Chinese characters, the first being interpreted as "Robert Jones, Manchester," the second being the crest of *Rotschke* (a partner in *Andrews & Co.* residing at Manilla), with words indicating that it was his "chop" or mark, and the third being interpreted as "Andrews & Co. Manilla."

In 1882, the business transactions between *Jones* and *Andrews & Co.* terminated, and thereupon *Jones* applied to register the above trade mark as his own. *Andrews & Co.* opposed.

CHITTY, J., held, (1) that upon the facts there was no contract between the parties that the mark should ever be the property of *Jones*; (2) that if there had been such a contract, the registration of the mark as *Jones'* property would have been calculated to deceive. Registration refused.

- 53 L. T. 3. CHITTY, J.—I have heard nothing in the argument, and I do not think I ever should hear anything in an argument, which would convince me that a man might, consistently with the 10th section, take the business house of another man, and register that as a distinctive trade mark. [*Jones*] was seeking at first to register the whole, but when it was explained to him that parts of the mark meant "this is the trade mark of *Andrews & Co.*," he was willing to make concessions, and to strike out "*Andrews & Co., Manilla*," in the Chinese characters, and also from the signboard. But of course a man cannot gain a right by making a concession.

Appeal to the C. A. (Baggallay, Bowen, and Fry, L.JJ.). Appeal dismissed

- 53 L. T. 3. BAGGALLAY, L.J.—*Prima facie*, we have a design which is composed of two elements—one representing the sending firm in Manchester, and the other element representing the receiving firm in Manilla. The design is made up of the representations of the interest of each of the two, exactly as in *Robinson v. Finlay* (*infra*, p. 295). There were there three parties—the manufacturer, an agent through whom the goods were shipped, and the consignee. In that case the design was made up of three parts representing the interest of each of the three persons. Now, *prima facie*, one would come to the conclusion that a trade mark invented and used in this way could only be used so long as the two or three parties, as

the case might be, were concerned in the adventure, but that when the adventure came to an end, then the design, which was a common design for the purpose of the common adventure, would come to an end also. * * *

This was a design for the joint adventure, and when the joint adventure ended, neither of the parties had any right to continue to use that design.

RE KEEP'S TRADE MARK.

[January, 1884. 26 Ch. D. 187; 54 L. J. Ch. 637; 50 L. T. 453; 32 W. R. 427.]

Trade Mark—Entry on register of note, limiting user—T. M. R. 1883, r. 32
(*infra*, p. 393).

Objections having been raised, by the owner of a registered trade mark, to the proposed registration of another trade mark, for use in connexion with goods included in classes for which the first mark was used, but no formal opposition having been lodged to the application for registration, an agreement was entered into between the registered owner and the Applicant, that no formal opposition should be lodged, that the Applicant should use his mark in connexion only with goods actually exported to certain specified countries, and that he would, in connexion with the registration, cause a note of this restriction on the use of his trade mark, to be entered on the register.

Upon an *ex parte* application by the Applicant in pursuance of this agreement, the Court directed the Comptroller to enter such a note on the register.

RE KENRICK & JEFFERSON'S TRADE MARK.

[March, 1890. 7 R. P. C. 321.]

Trade Mark—Practice.

Motion.

In 1889, Messrs. *Kenrick & Jefferson* applied to register the word "Palmilla" as a new trade mark in Class 39 for paper (except paperhangings) and stationery. The Comptroller refused registration because there were two trade marks in the same Class already on the register, one of which had been registered by Messrs. *Spicer* for paper (except paperhangings) and contained the words "The Palm Trade Mark" in two places, and several representations of palm trees; while the other had been registered by Messrs. *Slater & Palmer* for "a preparation for reducing and refining printing

and lithographic inks for use by printers," and consisted (among other printed matter) of the word "Palmink." On appeal to the Board of Trade the matter was referred to the Court, and the Applicants served notice of motion, on the Comptroller for an order to proceed, and also by the direction of the Court, on Messrs. *Spicer* and Messrs. *Slater & Palmer*. Messrs. *Spicer* did not appear, but Messrs. *Slater & Palmer* appeared and consented to the registration, so long as it was confined to paper and stationery consisting of paper, and so long as ink of every kind was excluded.

CHITTY, J., accordingly ordered the application to be proceeded with on the above terms, and ordered the Applicants to pay the Comptroller's and Messrs. *Slater & Palmer's* costs.

KINAHAN & COMPANY v. LYLE & KINAHAN LIMITED.

[May, 1890. 8 R. P. C. 18.]

Trade Mark—Issue of writ out of jurisdiction.

The Plaintiffs (wine and spirit merchants of London) being the registered owners of a certain trade mark, gave notice of motion to expunge a registered trade mark belonging to the Defendant Company, who carried on business in Ireland, but occasionally executed orders for English customers. The Plaintiffs obtained leave to issue and serve on the Defendant Company in Ireland, a writ in an action for infringement.

The Defendant Company moved to discharge the order for service. Order discharged.

KEKEWICH, J., pointed out that an injunction could not be enforced against the Defendant Company in England, and said:—
[It is suggested] that execution might be obtained against the Defendants' goods in this country. As I understand the practice of the trade, as appearing on the affidavits, no goods of the Defendants ever come to this country at all. They execute orders for customers here, and remit goods, which come here as the goods of the customers, and it seems to me that there is nothing liable to execution by the Plaintiffs against the Defendants.

8 R. P. C.
21, l. 14.

8 R. P. C.
21, l. 26.

As regards the Irish business, it seems to me beyond doubt that it ought to be, and is, an Irish action, and not an English action, and that the proceedings ought to be in Ireland and not here.

In the first place, consider the matter of witnesses. It may be that the Plaintiffs would have to take some witnesses over to Ireland; on the other hand, if the action proceeds in England,

the Defendants would have to bring all their witnesses over here. Again, as regards the extremely important question in an action of this kind—discovery. If discovery is to be had against the Defendants, it must be had somehow or other in Ireland. The only place in which the books can be seen is in Ireland, and the examination of the books, both for the purpose of the action and the trial, and still more for the purpose of account, if account is ordered, really goes to the root of the action.

What the Court is to regard is the comparative cost and convenience of proceedings as regards both parties, in reference to the general cost of the action—the cost to both sides. The convenience, I think, ought certainly to include dispatch as distinguished from delay. Now, regarding it with reference to what I have already said about witnesses, and about discovery, it seems to me that cost and convenience both point to Ireland, and not to England.

With regard to the pendency of the motion his Lordship said : —It is a question of jurisdiction arising on the Trade Marks Act, which I had far better leave for decision when it really arises and calls for decision. It is sufficient for me to say that I do not think the pendency of the motion, whether ultimately tried here or in Ireland, ought to interfere with the general convenience, the convenience resting on other grounds, of remitting the case to Ireland, or rather declining to have it tried here.

8 R. P. C.
21, l. 46.

8 R. P. C.
22, l. 7.

RE FREDERICK KING & COMPANY, LIMITED.

[C. A., May, 1892. 9 R. P. C. 350 ; (1892) 2 Ch. 462 ; 67 L. T. 33 ;
40 W. R. 580.]

Trade Mark—Registered owner domiciled in Ireland—Jurisdiction—Notice of Motion—Practice—Act of 1883, ss. 90, 107, 111, 117—Act of 1888, s. 9.

In 1889 *Frederick King & Company, Limited*, a Company carrying on business as provision merchants, and domiciled in Ireland, registered as an old trade mark the words "Desiccated Soup." The register contained both the Irish and the English address of the Company. In 1892, the *Pure Beef Company*, a firm of provision merchants in London, launched a motion to expunge *F. King & Company's* trade mark. The latter Company was originally named as a Respondent, together with the Comptroller, to the notice of motion, which was for the 8th of March, 1892 ; but as the Company was an Irish Company, and therefore could not be served with the notice of motion, the Applicants amended the notice by striking out the Company's name, and then adopted the

course suggested by STIRLING, J., in *In re La Compagnie Générale d'Eaux Minérales et de Bains de Mer* (*supra*, p. 101), serving the Comptroller with a notice of motion for the 18th of *March*, and sending a copy of it to the Company's office in Belfast, with a letter intimating that the copy was sent to inform them that proceedings had been commenced which might affect their interests.

On the day of the motion Counsel wished to appear for *F. King & Co.* under protest, to argue the question of jurisdiction, but KEKEWICH, J., refused to hear him, unless the Company consented to be added as a party, and to appear in the usual way. This the Company refused to do, and KEKEWICH, J., after reading the evidence, ordered the trade mark to be expunged. The order as drawn up contained the words, "Counsel for *F. King & Co.* being present in Court and declining to be added as Respondents." On the 1st of *April*, 1892, *F. King & Company* moved to set aside the order expunging their trade mark, on the ground that the Court had no jurisdiction to entertain the motion, or if the Court had jurisdiction, it ought not in its discretion to have entertained it behind the backs of *F. King & Co.*

KEKEWICH, J., refused the motion. Appeal to C. A. (Lindley, Bowen, and Kay, L.JJ.). Appeal dismissed.

9 R. P. C.
359, l. 39.

LINDLEY, L.J.—It is necessary to observe in dealing with the Patent Act of 1883, that it is one Act of Parliament applicable to three things—Patents, Designs, and Trade Marks. It is applicable to the whole of the United Kingdom; England, Ireland and Scotland and the Isle of Man; and its general provisions are framed in language to meet the three subject matters with which it deals, and the three countries with which it deals. I attach some importance to that general view, with reference to the argument of [Counsel for *F. King & Co.*] as to the concurrent jurisdiction given to the Courts of Ireland and England. I am not going to decide to-day whether they have any concurrent jurisdiction or not; because, whether they have or have not in matters of this kind, that they have some jurisdiction is obvious. But whether they have such concurrent jurisdiction as is contended for, is to my mind by no means clear. It is quite sufficient for this purpose to show that the High Court in this country has jurisdiction over this particular subject matter, and that the mode in which that jurisdiction has been exercised is not wrong.

His Lordship referred to the form of application for registration (*supra*, p. 25), and said:—

9 R. P. C.
360, l. 13.

There is nothing that I can discover, either in the form or in the

directions accompanying the form, or in the rules, or in the Act of Parliament, to the effect that the Applicant is to give or leave any address for service, unless he is a foreigner resident out of the jurisdiction, when there is a legislative enactment to the effect that he is to do that. That will be found in the Act of 1888, the 51st and 52nd Victoria, cap. 50, section 8:—(His Lordship read the section (*supra*, p. 27), and said):—

That is the only regulation that I can find anywhere about what are called addresses for service. It may be that, as regards foreigners within the United Kingdom, neither Ireland, nor Scotland, nor the Isle of Man are to be considered as out of the jurisdiction. It may be that for the purposes of this Act you do not want an address for service, because you can serve a notice anywhere within the United Kingdom. That may be so; at all events it looks something like it.

9 R. P. C.
360, l. 23.

Now, we have to consider the propriety of this, and the impropriety, if any, of what was done. The Act of Parliament says nothing whatever about the method of procedure to rectify the register, except what I will read presently. The rules do not prescribe how the applications are to be made, or anything of the sort. We are left entirely to the light of nature. What is the light of nature? I mean English nature, and English notions of justice, and what is right. So far as I know, there is no magic in a notice of motion. What you want is to give your opponent notice of what you are going to do and what you want, and to give him an opportunity of shewing cause why your application should not be entertained. That is all that is required in substance; and, in substance, these gentlemen have had notice enough, and more than enough.

9 R. P. C.
360, l. 47.

His Lordship read the Act of 1883, s. 90 (*supra*, p. 17), and continued:—

Now the mere enactment that the Court may do this, necessarily implies to the minds of Englishmen, that the person who is to be affected must be brought before the Court somehow or other. The Court is not to do it because somebody asks the Court, without giving notice to the person who is to be affected; but as to what the particular method of giving notice to him is we are left absolutely in the dark. The Court referred to there is defined in section 117. (His Lordship read the section (*supra*, p. 24):—

9 R. P. C.
361, l. 11.

Therefore “the Court” is the High Court; and then I think, either by the Judicature Act, or by some Act which is not at the moment present to my mind, this particular class of applications

9 R. P. C.
361, l. 19.

which were to be made under the statute to the High Court, is either assigned to, or usually entertained by, Judges in the Chancery Division. That is so in practice. I forget for the moment whether it is assigned or not, but in practice we know that the applications are usually made to them. Now, in order to get any application entertained by a Judge in the Chancery Division, you must get it assigned to a Judge or marked with the name of a Judge, and you can only do that by going to the proper officer who has charge of the rota, and who will put on the notice of motion, or whatever it is—the writ or whatever it may be—the name of the Judge who is to attend to the matter. Therefore, for that purpose it is necessary to mark this notice of motion, or application, or whatever you choose to call it, with the name of a particular Judge. This was so marked; but does it follow, because that is necessary in order to get before the Court, that you are to apply to the application all those technical rules that apply to writs or notices of motion or anything of the kind, the whole procedure being left in the dark? It appears to me it is unnecessary to say anything of the sort, or to go anywhere near that length. All that you have to do is to take care that your opponent is there, and tell him that you are going to apply for an order—an order, not on him, but on the Comptroller—an order to rectify the register. That is what is to be done; and you are to give anybody who is affected by it, notice that you are going to ask that his trade mark is to be expunged or rectified, or whatever the nature of the application is; and that is all that it appears to me is absolutely essential.

It is in vain, I think, to say that the Court has not jurisdiction to do that. The thing to be rectified is, I do not say an English register, it is a register for the whole of the United Kingdom; and the Court which has jurisdiction over that register is, *inter alia* at all events, the High Court of Justice. (His Lordship read the Act of 1883, s. 111 (*supra*, p. 22), and continued):—

9 R. P. C.
362, l. 16.

Now we have been pressed to say, as I have already mentioned, that that section which preserves to the Irish and Scotch Courts such jurisdiction as they had before, gives the Irish and Scotch Courts exclusive jurisdiction at least in this case, that is to say, in a case where a Scotchman or an Irishman has a registered trade mark—I confess I cannot so read it—I cannot understand that there is anything in this section, which is a preserving section and not an enabling section as I understand it, which goes anything like that length, and yet that is behind all this form and this technicality, the real struggle. The trade mark here belonging to

an Irish Company, the Irish Company say, "If you want to touch our trade mark you must come to Dublin or Belfast to do it, and you cannot do it in London." That is the struggle. It appears to me that that contention is, in the face of the sections to which I have alluded, quite untenable.

Now, to go back, the jurisdiction of the Court is to my mind incontestable. The procedure is all loose. Any procedure which comes up to the mark of justice in the eyes of an Englishman is enough to satisfy this Act. What is required by our notions of justice—I do not know about other peoples'—is, that no man shall have his case disposed of or be aggrieved or interfered with, without ample notice to him and an ample opportunity of shewing cause against it. Here the Respondents, the present Appellants, have had that notice not once but twice or three times, and they have not availed themselves of it. They were in Court though they would not appear. They would not consent to be made Respondents because they were afraid that, if they had been, they would prejudice their case, that this application was all wrong and ought to be heard in Dublin; but still there they were, and so far as all the technicalities are concerned, it appears to me that, if you go down to the root of it, there is nothing in it except a false analogy based on the supposition that because the notice of motion is marked by an English Judge they must be technically named at the foot of it as Respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had.

9 R. P. C.
362, l. 36.

His Lordship referred to the directions given by STIRLING, J., in *Re La Compagnie Générale, &c.* (*supra*, p. 101), and said:—That is a strong intimation that that which has been done in this case, if it was really necessary, is amply sufficient. I am clearly of opinion it is amply sufficient.

9 R. P. C.
362, l. 59.

BOWEN, L.J.—COTTON, L.J., points out in the argument [in *Re Busfield*, 32 Ch. D., p. 123,] the distinction between a case where the object of the service abroad is merely to give notice of the proceedings, with regard to which the Court has jurisdiction in this country, and a case where the object of the service abroad is to create jurisdiction at home. He distinguishes those, according as they fall on one side or other of the line.

9 R. P. C.
363, l. 58.

Now, in this case, on which side of the line does the matter fall? This is, I will not say an English, but it is a register formed for public purposes in the United Kingdom. It is to be available

9 R. P. C.
364, l. 9.

to all the subjects of Her Majesty. It is perfectly true that others besides the subjects of Her Majesty can take advantage of the register; but the object of the register is to be a benefit to trade in England. The Courts in Ireland may or may not have concurrent jurisdiction in the matter. It is a point which it is not necessary for us to decide. I assume that they have. The register is a register for the United Kingdom. It is remarkable that in the provisions as to getting upon this register and expunging the entries, there are only very vague indications as to any necessity for service of anything. * * There is no provision as to the procedure for expunging names from the register.

9 R. P. C.
364, l. 29.

Now is it conceivable, with regard to a procedure of that kind, that, after an application has been made by a firm, or by a person, and the person or the firm repairs, as my brother KAY picturesquely said during the course of the argument, to an Irish glen or a Scotch mountain, and leaves nothing behind except the memory of himself in this country, the whole of the English trade is to be obliged to hunt him down in Scotland or in Ireland before it can get the register cured which is paralyzing their business?

9 R. P. C.
364, l. 41.

Now, with regard to such a register, can it be said that notice to the person who is interested in the entry, who is either himself the Applicant or inherits the Applicant's right, is essential to found the jurisdiction of the Court, so that if the person disappears into space the hands of the Court are for ever tied? It is impossible to suggest it with regard to a public English register. I arrive, therefore, without the faintest hesitation, at the view that this is an instance of the branch of cases where the Court has jurisdiction over the person, over the thing, over the subject-matter; but though I agree that notice to the person interested is of the essence of the proceeding, it does not give the jurisdiction.

9 R. P. C.
364, l. 53.

The notice is to be dealt with by the municipal law, and if the municipal law has made no such regulation, the Courts will deal with it, in the absence of any provisions in the statute, by the light of natural justice. Applying that light, nobody can doubt but that it is of the essence of the proceedings that the person who is interested in the entry in the register should have the fullest opportunity of being heard, and, if he wishes to be heard, should be heard before the Court. He must therefore have full notice. There is no regulation as to what t's are to be crossed or what i's are to be dotted in the notice to be given. It must be full and sufficient to protect his rights in every respect, and

nobody need fear, that, if the sufficiency of the notice was brought before an English Court, they would not insist on the notice being as ample and as wide as the protection of individual rights and individual property could demand. But here it has been done in the fullest sense. It is said, indeed, that the notice which was given did not say that the Company were to be Respondents. What the exact effect of calling them Respondents or not may be I do not know, but if a notice is given to a person who is interested in property, and who may be said in a sense, though only *sub modo*, to be owner of the property, and if the Court is to be asked to deal with property in which another person is interested, and notice to that person is given that an application is to be made to the Court to deal with his property, and if that person appears before the Court and gets the application dismissed, I cannot myself doubt that the Court has inherent jurisdiction to give him costs. In this case all has been done which was in the least necessary for the protection of the rights of the parties.

KAY, L.J.—Assuming that there is jurisdiction in the Courts in Ireland [to entertain an application for rectification of the register], I am quite clearly of opinion that it is not an exclusive jurisdiction. The 117th section gives jurisdiction in plain and unmistakeable words to the High Court of Justice in England. * * So that I agree with the rest of the Court that this objection now raised is not an objection which goes to the jurisdiction at all. It is an objection which is an objection really on procedure. The Act has left, and I think designedly left, as free a hand as possible to the Courts which have to entertain these applications under the Act, in respect of procedure; and certainly natural justice is completely satisfied when you see that the procedure has been such, as it has in this case, as to give to the Appellant the amplest possible opportunity of meeting everything that could be said and urged in the case, and of resisting this application in the fullest and completest manner; and, therefore, no kind of injustice can be alleged by these present Appellants, in the nature of the procedure which has been adopted in this case.

9 R. P. C.
366, l. 58.

RE KINGSFORD & SON'S APPLICATION.

[April, 1889. 6 R. P. C. 413.]

Trade Mark—Registration by mistake in wrong name—Rectification—Act of 1883, s. 90.

Trade marks belonging to *Kingsford & Son* were, by an admitted mistake, registered in the name of the *Oswego Starch Co.* *Kingsford & Son* moved under the Act of 1883, sect. 90, for an order that the name and address appearing on the register of the proprietors of the trade marks might be expunged, and that the trade marks might be registered in the name of the Applicants. The Comptroller (who was served with the notice of motion by the direction of the Court) stated that he did not object to the motion so far as it asked to expunge the name and address of the Company, but contended that *Kingsford & Son* could not come on the register except after application and advertisement in the usual way.

Comptroller's contention upheld. Applicants to pay Comptroller's costs.

RE KUHN & COMPANY'S TRADE MARK.

[November, 1878. 53 L. J. Ch. 238 n.]

Trade Mark—Disclaimer—Act of 1875—C. sts.

Motion to rectify by adding a note disclaiming the common parts of trade marks.

In 1877, *C. H. E. Brandauer*, carrying on business at Vienna and Birmingham as a steel pen manufacturer under the style of *Kuhn & Co.*, registered certain trade marks for steel pens consisting in part of distinctive elements common to the trade (namely a device of a steel pen, together with different combinations of words and numerals). The motion was made on behalf of an association of steel pen manufacturers.

Order for rectification made as asked; *Kuhn & Co.*'s Counsel did not resist, though he did not formally consent to the order.

53 L. J.
Ch. 239 n.

JESSEL, M.R.—[Registration of an entire mark with the addition of a note disclaiming the common parts] is a convenient mode of registration, because it points out exactly what is intended, which is for the benefit of the person who claims the trade mark. The C. A. decided in *Barrows'* case (*supra*, p. 75), that where a man was entitled to use any device, and had used it in combina-

tion with common words and common marks, he might register the device alone, and say he used it in combination with the common words and marks; but the manufacturers said they did not like that, because registering in that way did not shew what they actually used, and they wanted to put on the register the thing they actually used. They said "If you register the 'B. B. H.,' " as it was in *Barrows'* case, "with no additions, it does not shew on the register what the mark really is. If, for instance, we use 'B. B. H.' and a crown, we want to shew that we use 'B. B. H.' and a crown, though we admit the crown is a common mark." So, in order to gratify the manufacturers by shewing on the register what they actually used, and still applying the principle of *Barrows'* case, it was decided to allow the manufacturer to put on the register the distinctive device, together with the common words that he really used, and then to enter in the register a note disclaiming the common part of the mark. That was not a new rule; it was only a new way of doing what was aimed at in *Barrows'* case.

Kuhn & Co.'s Counsel asked to be relieved from costs on the following grounds (namely), (1) that *Kuhn & Co.* had at once given notice of registration to the trade, and that this motion had not been launched till after a year and a half; (2) that *Kuhn & Co.* had not been requested to disclaim before legal proceedings were commenced; (3) that the common elements in *Kuhn & Co.'s* marks had originally been pirated from those marks by other steel pen makers. Of this latter allegation no proof was adduced.

JESSEL, M.R.—As a matter of courtesy, and to save expense, it would of course be better in all cases that a man should be asked to disclaim when he can disclaim; and I do not approve, as a rule, of people either giving notices of motion or bringing actions, without an offer to the other side to put the matter right. But there is no such legal right: you can always bring an action against a man for a wrong committed without giving him any notice; but you should give him notice to rectify that which is wrong. * * * When one comes to look at the marks on the pens, there is a good deal to be said in favour of the suspicion that what has become common to the trade was really common piracy originally; and that the pirates, having used the parts so taken long enough to prevent the Respondent from registering his original trade marks, applied to have them struck out. Well, that is a very strong case, if proved; and that, combined with the want of notice before making the motion, and combined also with what was told to me,

53 L. J.
Ch. 240 n.

and what appears to be substantiated, that at the time when the foreign pen maker (though he had an establishment in Birmingham as well) registered his marks, he gave notice all round to the trade, and they let him alone for a year and a half, would if proved, have made some difference with regard to the costs. However, not a word of the substantial part of that case is proved: there is no evidence of the piracy, the substantial part of the case—in fact the main part is not proved at all: and nothing of that sort being proved, I am bound to hold that the mere want of notice will not do, though the combination might have influenced, and, I will say, would have influenced, my mind as to the costs, for I should have thought it a very gross case indeed. But I must take the case upon the evidence, and as the greatest part of the case is not proved, I must grant the rectification asked for and order the Respondents to pay the costs.

RE LAMBERT'S TRADE MARK.

[C. A., March, 1889. 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138; 37 W. R. 154.]

Trade Mark—Sheffield register—Old corporate mark—Opposition to registration—Act of 1883, ss. 81, 90.

In 1887, *Arthur Lambert*, trading at Sheffield as a razor manufacturer, under the style of *George Johnson & Co.*, applied to the Cutlers' Company to have the old corporate mark of a tobacco pipe with a dart in line with the pipe at the bowl end registered in his name. This mark had originally been granted in 1698: in 1839, it was surrendered, and was in the same year reassigned to *Thomas Linley*, a razor manufacturer, the entry of this assignment being the last record in the books of the Cutlers' Company relating to this mark. *Lambert* claimed the mark through *Linley* and his successors in title. The mark had been continuously used by *Lambert* and his predecessors in title up to 1887. Shortly after the application was made, the Cutlers' Company advertised for claimants to the mark, and *George Wostenholme & Son, Limited*, thereupon notified to the Cutlers' Company that they opposed any regrant of the mark on the ground that there was no legal owner of it, and that it was so similar to a mark of their own (an old Sheffield mark which had been reassigned) as to be calculated to deceive. A considerable correspondence ensued between the Opponents and the Cutlers' Company, but in the result the Company refused to hear the opposition, and registered *Lambert* as the

owner of the mark in question in respect of Classes 5, 12, and 13. In due course *Lambert* was registered in the same way on the London register.

The Opponents appealed to the Comptroller under the Act of 1883, s. 81, sub-sect. 12 (*supra*, p. 15), but he held that that sub-section did not apply and dismissed the appeal. They then launched a motion (notice of which was addressed to the Cutlers' Company and *Lambert*) asking that the decision of the Comptroller and the Cutlers' Company might be set aside, or in the alternative, that the registration might be expunged (under the Act of 1883, sect. 90).

Motion refused.

NORTH, J.—I come to the conclusion that the application is really the performance of a ministerial act, under [the Act of 1883, s. 81,] sub-sect. 2, and that being so, it is not a case in which [the Cutlers' Company] were bound to take or could properly have taken, the proceedings indicated by the Act to be taken with reference to an application for a new mark with respect to which opposition is, or may be, offered, and certain proceedings are contemplated by the Act, and the rules framed in pursuance thereof, as those to be taken under these circumstances. Now, looking at the Act of 1883, sect. 81, sub-sect. 2, it seems to me beyond all question that the first part of that sub-section points to a mere ministerial duty and nothing else. The Company are required to enter in the Sheffield register in respect to certain goods, the trade marks which were entered in respect of goods under the Act of 1875. That is a thing as to which there could be no possible question. They might of course overlook it by accident, but the Act says they are to do it, and there is nothing in respect of which opposition could be offered. Then it goes on to say: "Shall also enter in such register in respect of the same goods" (meaning the same articles as were referred to before) "all the trade marks which shall have been assigned by the Cutlers' Company, and actually used before the commencement of this Act, but which have not been entered on the register under the Act of 1875." Therefore the difference between the two classes is this: In the one case the *sine quâ non* was registration under the Act of 1875: in the other case what was required was, that they should have been assigned by the Cutlers' Company and actually used. Now the question of assignment is a matter which equally could not be in dispute, because that would appear in the books of the Company. Then as to the actual user, no doubt that is a point with respect to which some evidence—I do not say necessarily would be, but might be, wanted. It may

5 R. P. C.
553, l. 3.

be that it was notorious that the marks had been used, and I apprehend if the Cutlers' Company had knowledge of that fact, it would be their duty to enter the trade mark upon the register, without calling for evidence of actual user. If on the other hand there was any doubt about it they might call for evidence. If there was nothing to bring the matter before their attention, they might possibly abstain from taking any step until their attention was called to it. But the section provides in both parts of it, as I hold, that they are to perform a ministerial duty. I do not think that it is less their duty to perform it, or that it is less an act under that sub-section, if they are put in motion by a person who calls their attention to his right to be registered, and asks them to register as they are bound to do. That does not seem to me to be an application like the application contemplated by sub-sect. 3, which in my opinion relates to an application for a new mark with respect to which there is nothing existing either on the register or in the records of the Company. Sub-sect. 3 refers to an application for registration of a mark used on certain sorts of goods described in the section, if made after the commencement of the Act by a person carrying on business within the district.

Appeal to the C. A. (Cotton, Lindley, and Bowen, LJJ.).
Appeal dismissed.

6 R. P. C.
350, l. 22.

COTTON, L.J.—There was no objection at all raised by any person claiming to be entitled to this corporate trade mark as against the application of *Lambert*; and then in my opinion the Cutlers' Company and the Comptroller would simply have a ministerial duty to perform to see that that corporate mark which was on the old books of the Cutlers' Company was transferred on to the new; and then the corporate mark to be granted is for all the goods of *Linley*, and he has transferred that for all the goods of *Lambert*.

As regards the second part of the motion, both Courts held that the Opponents had not made out their case.

EX PARTE LAWRENCE BROTHERS; RE MARLER'S TRADE MARK.

[November, 1878. 29 W. R. 392 n.; 44 L. T. 98 n.]

Trade Mark—Wrongful registration—Practice—Act of 1875.

Motion to rectify by inserting the names of the partners in the firm of *Lawrence Brothers* (who carried on business both in London and in America), as proprietors of a trade mark registered by *E. T. Marler*, under the following circumstances:—

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In 1876 *Marler*, who was the manager of the business in England of the said firm, acting without the knowledge or consent of any of the members of the firm, and during the absence of them all in America, applied in his own name for the registration of a trade mark belonging to the said firm, and the same was in due course registered as his property, the name of the proprietor being *Marler*, described as of 21, Charles Street, Hatton Garden, and the period of user of the mark being alleged to be three years before the 1st Jan., 1876. *Marler* had in fact never carried on business on his own account, and the address given was that of his employers, *Lawrence Brothers*.

JESSEL, M.R.—If *Marler* had registered the trade mark acting under instructions from the firm, but had registered it in his own name and not in the firm's name, it may be that I could have acceded to the application, treating *Marler* as a trustee for the firm. But as it is, the registration was a mere wrongful act on the part of *Marler*, acting without authority, and I cannot regard him as a trustee. Nor can I direct him to assign the trade mark, for he is unable to assign with it the goodwill of any business. All I can do, therefore, is to direct the entry to be expunged from the register, and to leave the present Applicants to make a new application in the usual way to register their trade mark. 29 W. R.
392 n.

RE LEONARD & ELLIS'S TRADE MARK ;
LEONARD & ELLIS v. WELLS.

[C. A., March, 1884. 26 Ch. D. 288 ; 53 L. J. Ch. 603 ; 51 L. T. 35.]

Trade Mark—New name for new article—Improper registration—Act of 1875,
ss. 3, 5, 10.

In 1873 *Leonard & Ellis* introduced a new kind of lubricating oil, to which they gave the name of "Valvoline." In the same year they registered as a trade mark in America a device, part of which consisted of the word "Valvoline," and in 1877 they registered this trade mark in England, claiming four years' user prior to 1877. In 1878 they registered in England the word "Valvoline" alone as their trade mark, claiming five years' user before 1878.

The Defendants *Wells & Co.*, oil refiners and importers, sold this oil as "Valvoline," and put that name on their circulars, &c. In 1883 (after the mark "Valvoline" had been 5 years on the register), *Leonard & Ellis* commenced an action and launched a

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motion against *Wells & Co.* to restrain them from infringing the last-mentioned trade mark, and from selling, &c. as Valvoline, any lubricating oil not made by the Plaintiffs. The Defendants thereupon moved to expunge the trade mark "Valvoline."

The two motions came on together.

PEARSON, J., directed the trade mark "Valvoline" to be expunged, and refused the Plaintiffs' motion.

Appeal to the C. A. (Lord Selborne, L.C., Cotton and Fry, L.JJ.). Appeal dismissed with costs. Fresh evidence was allowed to be adduced before the C. A. The result of the evidence was (1) that the word "Valvoline" had from 1873 to 1878 been treated by the Plaintiffs as a word descriptive of a particular substance which any one was entitled to make, and had not been used by them as a trade mark, and (2) that the Defendants did not use the word in a way calculated to represent their goods as made by the Plaintiffs.

26 Ch. D.
293.

EARL OF SELBORNE, L.C.—It was determined [in *Re Palmer's Trade Mark* (*infra*, p. 261)], upon the construction of the 3rd and 5th sections of the Act, 1875, that the 3rd section, making the registry of a trade mark *primâ facie* evidence, and the continuance of the registration for five years conclusive evidence, of the right of the registered proprietor to the exclusive use of the trade mark, subject to the provisions of the Act, does not control, and has no bearing upon, the right of anyone who holds himself aggrieved by any improper registration, to apply under the 5th section for the removal from the register of the alleged trade mark, which he says has been improperly registered. That being so, as it seems to me, the 3rd section is entirely out of the case. If five years' registration is not conclusive evidence, then the being on the register is for this purpose *per se* no evidence at all; because that which in less than five years is *primâ facie* evidence, is after the five years conclusive evidence. But it has been held that in a case of this nature registration for five years is not conclusive. Consequently we have nothing to do here with the 3rd section; but, of course, anyone who makes an application to take a registered mark off the register under the 5th section, has upon him the burden of proving that it ought to be taken off. If he takes the ground which in this case is taken, that the mark registered as a trade mark is one of a description not authorized to be so registered, still some burden of proof, in my opinion, lies upon him. When a mark is registered it is not to be assumed against the registered person, that it was not within the terms of the 10th

section of the Act, which defines what marks are authorized to be "registered;" and, notwithstanding the general rule that no man is bound to prove a negative, I am disposed to think that the person applying to have it removed must shew some ground for putting on the party who has registered the duty of making out his right to retain it on the register.

Referring to sect. 10 of the Act of 1875 (*supra*, p. 5), his Lordship said:—I am satisfied that the opinion which was given by one of my learned Brothers, if not by the whole Court, in *Re Palmer's Trade Mark* (*infra*, p. 261), is perfectly correct, that the definition "any special and distinctive word or words used as a trade mark before the passing of this Act" refers to words when used alone, not in combination with any other device. Now to say that a word used alone, not in combination with any other device, if it was used as a heading, is discharged by the prior portion of the section from the condition that it must have been so used before the passing of this Act, is to strike out of the Act those words of condition, and indeed, the whole of the clause which contains them; because whatever is said of a heading is said of any distinctive device, any distinctive mark, any distinctive label, or other distinctive ticket.

26 Ch. D.
295.

What is the meaning of "used as a trade mark," as distinguished from the use of the words to describe an article. I do not at all mean to say that it is impossible that a word which is used to describe an article may also, if the proper means are taken at the proper time, be used as a trade mark; but when any such double use takes place, it is most important to remember the difference between the use of a name as a trade mark and the use of it as a descriptive term. If the article itself is *publici juris*, and anybody may make it, then people who make it are at liberty, provided they do so honestly, to describe it by the descriptive term by which it is properly known in the trade, and no right of monopoly to that descriptive term can be acquired otherwise than by using it as a trade mark. If it is used as a trade mark then it is that use and not the other use which may be restrained.

23 Ch. D.
296.

The embarrassment which I have during a portion of this case felt has arisen from the following considerations. The word "Valvoline" is used in the Plaintiffs' trade mark, though in combination, and if there were not this mass of evidence to shew that it is a descriptive term, I should have had very little difficulty upon the principle of well-known authorities in holding that it could not have been taken out of the trade mark, of which it is a prominent part and used as a trade mark alone without infring-

26 Ch. D.
299.

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ing the Plaintiffs' right. But if the word is used by the Defendant, not as a trade mark, but in circulars, advertisements, and so on, as a descriptive word, it being found that it is a descriptive word, and descriptive of a thing which anybody may make, and which anybody may sell, then it appears to me that the burden is upon the Plaintiffs to shew that it is so used in those circulars and advertisements as in effect to represent, or to have a tendency to make people suppose, that the thing advertized or mentioned in the circulars is the manufacture of the Plaintiffs. Here, again, a little embarrassment arises from the fact that since 1878 the word has actually been registered as the Plaintiffs' trade mark, and consequently has been in a certain sense *de facto* the Plaintiffs' trade mark. But if the Plaintiffs had no right to the registration, ought they to have any benefit from the fact of registration? If the registration is to be annulled, can they have established substantially the same right by the degree of exclusiveness in the use of the word which they practically got by the unauthorized registration? According to the best judgment I can form on that point, after fully considering it, I think [that they ought to have no benefit from it, and therefore, that the question must be considered apart from the fact that they had during that period of time obtained an apparent monopoly of the word by the unauthorized registration of it as a trade mark.

26 Ch. D. 302. COTTON, L.J., referring to the fresh evidence adduced before the C. A., said :—It is most dangerous to allow parties when they have taken their stand at the trial of a particular question on certain evidence relying either on the sufficiency of their own, or the deficiency of their opponent's evidence, afterwards to come, when they find that they have miscalculated the effect of it, and ask to be allowed to produce evidence which they think will meet the point of the case.

26 Ch. D. 303. One difficulty undoubtedly is that which has been adverted to by the Lord Chancellor, that during a certain period "Valvoline" was on the register as the Plaintiffs' trade mark, and, therefore, no one else could use it as describing this particular class of oil. But we have held that it was improperly put on the register. Now, if a man has a patent, and during the term of his patent is the only maker of an article to which he gives a particular name, which name during the continuance of the patent comes to be merely a description of the article, he cannot, in my opinion, after his patent is gone, and the making of the article is free and open to all the world, claim the name as his trade mark.

FRY, L.J.—I am inclined to think that the words “special and distinctive,” import the specializing of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others.

26 Ch. D.
304.

LEVER v. GOODWIN.

[C. A., May, 1887. 4 R. P. C. 492; 36 Ch. D. 1; 57 L. T. 583;
36 W. R. 177.]

Trade Mark—Fancy word not in common use—Act of 1883, s. 64, sub-s. 1 (c)
—Imitation by Defendants of the get-up of the Plaintiffs' good—Account of profits.

Action by *Lever & Co.* (wholesale sellers of soap) to restrain *Goodwin & Co.* (wholesale soap manufacturers) (a) from infringing the Plaintiffs' trade mark, (b) from passing off their soap as the Plaintiffs' soap.

(a) The Plaintiffs were the owners of a new trade mark for soap registered under the Act of 1883 “The Self-washer.” The Defendants subsequently to the Plaintiffs' registration used the term “Self-washing” in connection with their soaps. At the trial of the action CHITTY, J., held that the Plaintiffs' trade mark was bad.

CHITTY, J.—Taking the term grammatically * * I will start with this, that the words are two common English words, and I am satisfied that the word “Self” in composition with the English language is used sometimes in such a sense that the action of the verb passes to the “Self,” and that sometimes it is used in the sense of the action being an action which arises without any extraneous aid or power. (His Lordship gave the following phrases as illustrations: “self-moving,” “self-luminous,” “self-determined,” “self-acting,” and continued):—I am only making use of the observation for the purpose of showing that the term can be used in a sense in which the word implies with reference to “Self-washing” or “Self-washer” that it washes of itself.

4 R. P. C.
479, l. 1.

His Lordship then discussed the evidence, and held that the term “Self-washer” was used in a descriptive sense, and was not a fancy word. There was no appeal on this point and the trade mark was removed from the register.

(b) Prior to 1885 the Plaintiffs put their soap on the market in 12 oz. tablets done up in wrappers or packages of a particular get up. In Feb. 1885 the Defendants put on the market a soap (which was not a new soap and had not formerly been sold in 12 oz. tablets), in 12 oz. tablets, and done up in wrappers whose get-up was so like that of the Plaintiffs' wrappers, that the Court held that the

one wrapper could be mistaken for the other. Among other points of resemblance there were the words "Sunlight Self-washer" on the Plaintiffs' wrappers, and the words "Goodwin's Self-washing Soap" on the Defendants' wrappers. Both the Plaintiffs' and the Defendants' wrappers were of imitation parchment paper, and both contained laudatory matter printed in broken type or spaced printing. CHITTY, J., granted an injunction and account of profits.

4 R. P. C.
498, l. 29.

CHITTY, J.—The law on this head is plain. It is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods, which are being offered for sale, are the goods not of the person who made them, but of some other manufacturer. That is a simple case between the buyer and seller. Then there comes the case, which is a simple one also, and one that does, I am sorry to say, occur where the manufacturer, by subtle devices which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he is putting on the market, are the goods of some other maker. In the second class of cases which I am considering, the trade is not deceived. I am speaking from my large experience in these matters. The retail buyers know from whom they are buying, and if there is anything like a fraudulent device such as I am referring to, they are not taken in, they are not deceived. But what is done by the manufacturer is this—he puts an instrument of fraud into their hands. * * * Have the Defendants in this case, or not, knowingly put into the hands of the shopman who is more or less scrupulous or unscrupulous, the means of deceiving the ultimate purchaser? That is the question which I have to try, and that is a question of fact and nothing else.

The account of profits was in the following form. "An account of the profits made by the Defendants in selling or disposing of soap made by or for the Defendants in any wrapper such as that contained in the exhibits * * * and in the form of those exhibits."

Appeal to the C.A. (Cotton, Lindley and Bowen, L.JJ.) who affirmed the decision of CHITTY, J.

4 R. P. C.
506, l. 2.

COTTON, L.J., dealing with the component characteristics or parts of the two wrappers, said:—There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing off, the Defendants' soap as the Plaintiffs', then, although the Plaintiffs have no monopoly either in "Self-washing" or "Self-

washer" or in the parchment paper or in the spaced printing, yet if those things in which they have no sole right are so combined by the Defendants as to pass off the Defendants' goods as the Plaintiffs', then the Defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction in order to restrain the Defendant from passing off his goods as those of the Plaintiff.

It was contended that no one knew the Plaintiffs, no one knew "Lever," and that "Lever's" name was not here. But CHITTY, J., 4 R. P. C. 506, l. 13. disposed of that, because a good deal of the witnesses' evidence undoubtedly was in terms, "This will be known as the Plaintiffs' soap." * * That is really the ground of complaint in all these cases, because generally there is nothing to indicate to the ultimate purchasers who is in fact the manufacturer of the article which has been simulated, but they recognize the packet or the dress or something about it, as indicating the particular thing which in fact, though not known to the purchasers, is manufactured by the Plaintiff.

It was argued for the Defendants that the account of profits ought to be confined to profits of sales to persons who actually bought the Defendants' soap believing it to be the Plaintiffs'.

COTTON, L.J.—In my opinion the whole gist of the complaint against the Defendants is:—"You have sold a weapon calculated to be used fraudulently by the middlemen;" and the profit for which they must account is the profit which they have made by the sale of soap in that fraudulent dress to the middlemen. It is immaterial how the latter deal with it. * * In my opinion therefore the account of profits is right as it stands, and there ought to be no alteration in that respect. 4 R. P. C. 507, l. 33.

LINOLEUM MANUFACTURING COMPANY v. NAIRN.

[January, 1878. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. 448;
26 W. R. 463.]

Trade Mark—Patent—New substance—Act of 1875.

Action to restrain infringement and passing off.

The Plaintiff Company were the assignees of certain patents recently expired for preparing floorcloth by means of a certain solidified or oxidised oil. The Patentee called the oil "Linoleum" and the floorcloth "Linoleum Floorcloth," the word "Linoleum" being a fancy name invented by him. The Plaintiff Company on

succeeding to the Patentee's rights continued the use of the name, and the floorcloth made by the Company had been extensively used. No one else had hitherto made or sold Linoleum or Linoleum Floorcloth. The Plaintiff Company had registered a trade mark for floorcloth which contained the words "Linoleum Floorcloth." The Defendants manufactured and sold, under the name of "Linoleum Floorcloth," similar floorcloth to that manufactured and sold by the Plaintiff Company.

Action dismissed.

7 Ch. D.
836.

FRY, J.—The Plaintiffs have alleged, and Mr. *Walton* [the Patentee] has sworn, that having invented a new substance, namely, the solidified or oxidised oil, he gave to it the name of "Linoleum," and it does not appear that any other name has ever been given to this substance. It appears that the Defendants are now minded to make, as it is admitted they may make, that substance. I want to know what they are to call it? That is a question I have asked, but I have received no answer; and for this simple reason, that no answer could be given, except that they must invent a new name. I do not take that to be the law. I think that if "Linoleum" means a substance which may be made by the Defendants, the Defendants may sell it by the name which that substance bears.

But then it is said that, although the substance bears this name, the name has always meant the manufacture of the Plaintiffs. In a certain sense that is true. Anybody who knew the substance, and knew that the Plaintiffs were the only makers of this substance, would, in using the word, know he was speaking of a substance made by the Plaintiffs. But, nevertheless, the word directly or primarily means solidified oil. It only secondarily means the manufacture of the Plaintiffs, and has that meaning only so long as the Plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who has been by right of some monopoly the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article. It is admitted that no such case has occurred, and I believe it could not occur; because until some other person is making the same article, and is at liberty to call it by the same name, there can be no right acquired by the exclusive use of a name as shewing that the manufacture of one person is indicated by it and not the manufacture of another,

Here, as I pointed out, the Plaintiffs having invented, or their predecessors in title having invented, a new subject-matter, use merely the name distinguishing that subject-matter, but do not use a name distinguishing that subject-matter as made by them from the same subject-matter as made by other persons. The two cases are essentially different. It appears to me, therefore, that there has been neither infringement of any essential part of the Plaintiffs' trade mark, nor any attempt on the part of the Defendants to represent the goods which they intended to sell, as goods made by the Plaintiffs.

RE LLOYD & SONS' TRADE MARK ;

LLOYD v. BOTTOMLEY.

[August, 1884. 27 Ch. D. 646 ; 54 L. J. Ch. 66 ; 57 L. T. 898.]

Trade Mark—Five years' registration—Act of 1883, ss. 76, 90.

Motion to expunge the words "La Minerva Habana" which had been on the register (as an old mark) for more than five years as a trade mark for tobacco, on the ground that they were at the date of registration, and had ever since been, common in the trade.

Motion acceded to.

CHITTY, J.—Without going through other parts of the Act it is sufficient to say that sect. 76, which enacts that registration shall after the expiration of five years from the date of the registration be conclusive evidence of the right to the exclusive use of the mark, by the concluding words "subject to the provisions of this Act" lets in, and is controlled by, sect. 90 which is paramount to sect. 76, and contains no limitation of time. Any person, therefore, who is aggrieved and can shew that the entry was made on the register without sufficient cause, may apply. The language of sect. 76 is not the same as that of the corresponding sect. 3 in the former Act. (His Lordship referred to these sections and continued) :— Apart, therefore, from *Re Palmer's Application* (*infra*, p. 261), the result of this Act is, that any person aggrieved may apply to get rid of the entry and succeed, notwithstanding more than five years have elapsed since registration.

RE LYNDON'S TRADE MARK.

[C. A., February, 1886. 3 R. P. C. 102; 32 Ch. D. 109; 55 L. J. Ch. 456; 54 L. T. 405; 34 W. R. 403.]

Trade Mark—Registration—User by opposer of mark different from registered mark—Similarity—Comparison—Act of 1883, s. 72, sub-s. 2.

In *April*, 1884, *Bedford & Co.* registered as an old trade mark for cutlery, edge tools, files, saws and the like, in Class 12, a man's head with a small portion of the neck annexed to it but not shewing at all the bust or shoulders. There were a few sparse hairs on the head. The mark, however, impressed by *Bedford & Co.* on their articles, consisted of a head and shoulders, the head being covered with a sort of wig. In *Sept.* 1884, *Lyndon* applied to register as a new trade mark for Class 12, a head of *Athena* having a helmet on and long ringlets hanging behind and shewing a certain amount of the bust and shoulders. *Bedford & Co.* opposed the application on the ground of similarity. PEARSON, J., decided in favour of *Bedford & Co.*, but his decision was reversed by the C.A. (Cotton, Bowen, and Fry, LJJ.)

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104, l. 20. COTTON, L.J.—Is that which is intended to be put on the register so nearly resembling something else already on the register as to be calculated to deceive? I quite agree that we are bound to look not only to the figure on the register, but to consider what that figure will in appearance be when put in use in the way in which it has to be used. In my opinion (and that I think was the opinion of the present M. R. though he differed in the result in the *Worthington Trade Mark* case (*infra*, p. 351)), the question is, if what you propose to register is fairly used, will it be calculated to deceive?

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118.
3 R. P. C.
105, l. 13. In my opinion, if this mark be used fairly, there is not any probability that it will be calculated to deceive, subject to this, that where marks are made very small, it is undoubtedly very difficult to distinguish one mark from another. In my opinion, however, it would not be right to say that because a mark may be made so infinitesimally small that you cannot distinguish it from one already on the register, therefore it must not be registered.

3 R. P. C.
105, l. 33. No one can conceive that the stamp which appears on the knife of Messrs. *Bedford* could have been made as a representation of or a copy of that which they have registered. * * * Simply looking at this as a question of what would be the consequence of a fair use of each of these trade marks, I come to the conclusion that the trade mark proposed to be registered is not so

like the registered trade mark, or what would be the consequence of a fair use of that registered trade mark, as to require us to decide that it is calculated to deceive.

In my opinion therefore, *Lyndon* is entitled to have his mark entered on the register, but of course that does not, and from what I have said, it will not lead to the conclusion that if he does that which is calculated to imitate Messrs. *Bedford's* mark, he will derive any protection from this being registered.

BOWEN, L.J.—It seems to me that a trade mark is calculated by its resemblance to another already on the register to deceive, if in the probable course of its legitimate use in the trade it is likely to do so; and in considering the question whether this result is probable to occur in the course of its use in the trade, it seems to me you have a right to look at the circumstances of the case. I think you have to look amongst other things at the question, whether or not blurring may possibly take place, and if so, whether it is likely to take place. I think you may consider the question, whether, having regard to the special class of articles on which the impression is to be made, if it is an impression that has to be made on articles, there is likely to be such indistinctness produced as is calculated to deceive. It seems to me that you may regard—though I do not think any of these things are definitions to be found in the Act of Parliament—I think you may in many cases be obliged to regard the size of the article upon which the mark is intended to be made or fixed, the material—the ground-work, so to speak—upon which it is to be placed. It seems to me that it would not be wrong to consider the probability, if it was an impression which had to be made on a hard substance, of some letters being more likely to take with distinctness than others, or parts of the design being likely to come out with more perfection, while parts would remain more imperfectly represented. * * * Applying that view to the present matter before us, what is a proper standard of comparison? You will have to take the trade mark which it is desired to register, and the proper standard with which you ought to compare it, is the trade mark already on the register, as registered, although, as we have explained, you are not confined simply to the paper registration, but you may look further afield to see how it will probably in the legitimate user, shew itself on the article upon which it is to be impressed.

FRY, L.J.—If I were not differing from the judgment of the Court below, I should probably content myself with saying that I concur in the judgment of my learned brethren, and that BOWEN,

3 R. P. C.
106, l. 3.

3 R. P. C.
107, l. 12.

L.J., has expressed exactly the view I take in this case. I think the burthen of proof that there is the similarity alleged, rests on Messrs. *Bedford* who object to the registration, and I think that under the peculiar circumstances of this case, and the difference between their registered trade mark and the trade mark appearing on the exhibits, they have failed to discharge that burthen * * The words "calculated to deceive" impart to one's mind in the first instance some design, but I think it is plain both from the subject-matter and the decisions of the Courts that all they mean is this—a mark calculated to deceive, when that mark fairly used is so like a mark on the register, also fairly used, that one is likely to be mistaken for the other.

RE MAIGNEN'S APPLICATION.

[June, 1880. 28 W. R. 759.]

Trade Mark—Signature and descriptive words added—Act of 1875, ss. 6, 10—T. M. R., 1876, r. 18 (infra, p. 390)—Costs.

Motion on behalf of *Monsieur Maignen* that the Registrar might be at liberty to enter his name on the register as the proprietor of a trade mark consisting of the words "Filtre Rapide," in capital letters in combination with a facsimile of his signature, notwithstanding that Mr. *Cheavin* was already registered as proprietor of a trade mark consisting of the words "Rapid Water Filter."

The Registrar had refused to register *Maignen's* mark on the ground that he could not do so under the Act of 1875, s. 6, and T. M. R. 1876, r. 18, without the special leave of the Court.

Notice of this motion had been served on Mr. *Cheavin*, and on the Registrar.

Mr. *Cheavin* did not appear.

It was argued on behalf of the Registrar, that by taking advantage of a slip in the Act, the Applicant was trying to register words (namely, "Filtre Rapide") which were admittedly descriptive.

JESSEL, M.R., said that the Applicant was entitled under the Act to have his signature registered with the words "added," and he should make the order in that form; but that as the Applicant was taking advantage of the Act, he must pay the Registrar's costs, which ought not to be borne in such a case by the Consolidated Fund.

RE MARKS AND TELLEFSEN'S APPLICATION.

[July, 1885. 63 L. T. 234 n.]

Trade Mark—Similarity—Act of 1883, s. 72.

Summons to proceed.

In 1876, *Hudson* registered as an old trade mark for Dry Soap, a mark or label consisting of an upright oblong, having in the centre a device of a hand and dolly in a frame formed of four segments of a circle. Above the frame was the name "Hudson's," and below it were the words "Dry Soap," all in capital letters. At the bottom of the label a horizontal oblong space was left white. This was in practice filled up with the words, "may be used with the greatest advantage in all washing and cleansing operations." Except this space, and that surrounding the device, and two other small circular blank spaces, the whole surface of the label was covered with reticulated lines.

In 1884, *Marks & Tellefsen* applied to register as a new trade mark for Dry Soap, a mark or label consisting of an upright oblong, having in the centre the word "Royal" in a diamond-shaped white space, inclosed in a frame, round which were the words "Trade Mark." Above the frame was the word "Royal," and below it were the words "Dry Soap," all in capital letters, corresponding in size and arrangement to the words in *Hudson's* mark. At the bottom of the label was a horizontal oblong white space, in which was placed a horizontal diamond-shaped frame, inclosing the words "should be used in all cleansing operations." Except the two white spaces, the whole surface of the label was covered with reticulated lines, arranged much more closely than those on *Hudson's* label.

Hudson opposed. Registration refused.

PEARSON, J., read the Act of 1883, sect. 72, and said :—It seems to me, looking at the section which I have already read, that the object of it was to prevent the litigation that used to occur long after people had begun to sell their goods, by preventing *in limine* persons from using trade marks which were calculated to deceive by being very much like other trade marks. What this Court has therefore to do, when a case of this kind comes before it, is to consider very carefully, not whether, according to the old system, it could have restrained the use of the second trade mark, because the first trade mark was already in existence, but whether the second trade mark, which it is attempted to register, is so nearly

63 L. T.
235 n.

resembling the trade mark which has been registered, that it may be considered as calculated to deceive, and may therefore give rise to litigation hereafter. If the Act has that effect, then I cannot help saying that, at all events, I can discover one great utility in it, it would stop litigation at a point where, if not stopped, it becomes very onerous to the parties, and it stops it before one set of goods is in the market. It restrains persons from attempting to do that which, in all fairness and honesty, they ought not to attempt to do. In saying that, I do not think I am going at all beyond what the late M.R. said in *Re Worthington's Trade Mark* (*infra*, p. 351). * * No doubt persons will differ very much when they come to look at the different marks, as to whether they do resemble, and as to the extent to which they do resemble one another. But I accept what Counsel told me was a part of my duty, namely, that I am to use my own eyes, and to determine, as well as I can, whether the one mark resembles the other. In the first place, I am struck with this: the shape of both of them is the same, and I cannot help saying that, in *Worthington's* case, the Court relied very considerably upon the shape of the two. (His Lordship then examined the marks in detail, and came to the conclusion that the application must be refused.)

RE MEEUS' APPLICATION.

[November, 1890. 8 R. P. C. 25; (1891) 1 Ch. 41; 60 L. J. Ch. 96; 63 L. T. 610; 39 W. R. 216.]

Trade Mark—Disclaimer—User—Act of 1883, ss. 69, 71, 72, 74, sub-s. 2—Orr-Ewing v. Registrar of Trade Marks (*infra*, p. 254) *explained*.

Summons to proceed.

In 1888, *Louis Meeus*, an Antwerp firm carrying on business as distillers of the spirit known as "Geneva," applied to register as an old mark in respect of "Geneva Spirit" a device consisting of a key ornamented with ears of corn, across which "Louis Meeus" was written in current hand, the words "Geneva Key Brand" and "Louis Meeus" being printed in a special manner in a circle round the key, and the word "Antwerp" being printed within the circle underneath the key. The application came before the Court upon the opposition of *Blankenheym & Nolet*, a Rotterdam firm of "Geneva" distillers, who alleged that they had exported "Geneva" for 50 years to Great Britain, under the title of "Key" or "Key brand," and that they had for many years

used a key as an essential part of their marks for "Geneva." An application by *Blankenheym & Nolet* to register some of their marks was pending before the Comptroller.

The Applicants admitted that they desired to register merely to obtain a concurrent right to the user of their mark with *Blankenheym & Nolet*, and it was part of their case that they themselves and the Respondents were the only persons trading with this country entitled to use the term "Geneva Key Brand." The evidence shewed that the Applicants had not used the mark in question as a whole before 13th Aug. 1875, the words "Geneva Key Brand" not having in fact been used by them at all prior to that date.

CHITTY, J., referred to the Act of 1883, sect. 69, and said :—What (1891) 1
is the case that according to the language of the enactment Ch. 45.
"stands for determination"? It is the question of registration 8 R. P. C.
of the particular mark brought in, and where it is asserted that it 31, l. 43.
is an old mark, as in the case before me, the application is, as a whole, to register the entire mark, as brought in, as an old mark. The Court then has to determine whether, in the case before it, this application is to proceed or not. I need scarcely observe that if another or a different mark were brought in, that would have to be advertised again, and other opponents who might not think fit to come forward and oppose the registration of the particular mark that they had seen, might for good reasons come forward to oppose an application which was to register, say, a part of the whole mark that was originally brought in. It is conceivable that it might be much more injurious to certain traders, that a part of the whole thing proposed should be registered, than that the whole thing should be registered.

His Lordship discussed the evidence and continued :—

The result is that the Applicant has failed to prove any 8 R. P. C.
user of the mark proposed, as a whole, in the United Kingdom, 32, l. 51.
or indeed, I might add, elsewhere, before the 13th August, 1875. It becomes then in my opinion not necessary to consider the evidence of user of part of the mark, namely, the key with or without the ears of corn, the use of which on behalf of the Applicants is stated as having taken place before the statutory date which I have mentioned. That evidence consists mainly of two importations into ports in this country, merely for the purpose of trans-shipment, on the evidence, to Havanah, from which it would seem that there were two cases with a mark, possibly of the key, outside those cases in the ship's hold, and that there was only a

nominal trans-shipment, that is to say, there was no evidence of any kind distinctly to shew that the goods were taken out of the ship; but it is quite open to hold on the evidence, seeing that the burden of proof is on the Applicant, and I think it would be the right conclusion to come to in such a case as this is, that the ship was touching only at the ports named, Liverpool and Leith, in the United Kingdom, and that the goods, without the case being seen, were passed on in the same ship to the Havanah. * * * If and so far as it [should] be necessary to consider [the evidence of alleged user] in detail, I state my opinion that the result, without going into details, is adverse to the Applicant.

8 R. P. C.
33, l. 32.

[*Re Palmer's Trade Mark (infra*, p. 261)] decided that where the mark proposed to be registered was less than the whole used before the date in question, registration could not be permitted; and it follows from that, that the Applicant, who comes forward and alleges that the mark which he proposes for registration has been used before the statutory date, must shew that it has been just as he proposes it should be registered, that is to say, the whole in combination—I am not speaking of some slight immaterial difference, but substantially the whole. Now in the case before me, unquestionably the words “Geneva Key Brand” form a very important [and material] part of the trade mark.

It was suggested (1), on the authority of *Orr-Ewing v. The Registrar of Trade Marks (infra*, p. 254), that the Court should direct registration of the key and corn ears (which had been used by the Applicants prior to 1875), (2) that the Applicants should disclaim everything except the key and corn ears.

With regard to (1) his Lordship said :—

8 R. P. C.
33, l. 49.

It is important to see how [*Orr-Ewing v. The Registrar of Trade Marks*] came before the H. L. As is well known, the business of forming the first register of trade marks was found to be so serious and so large as regards textile goods, that a Committee of Experts were appointed with regard to goods of this class, for the purpose of sifting the various trade marks used in the trade. The Committee were appointed under general orders which had a statutory effect, and it was their duty to divide the marks which were brought before them into two classes, the first class being those which they considered fit and proper to be registered; and the other, the second class, being those which they thought were not proper to be registered, and it was part of the orders, which had, as I say, statutory effect, that it should not be lawful for the Registrar—as was then the title of the officer who had the

control of the register—to register any person as the proprietor of any cotton mark, in the second class of the list, except in pursuance of an order of the Court. An application for such an order was made to HALL, V.-C., and he directed the Registrar to proceed; but the C. A. were of a different opinion, and held that the Committee of Experts was in the nature of a tribunal of commerce, and that in dealing with their decision the Court ought not to interfere, unless satisfied that they had proceeded on some wrong principle, or in some improper manner. The H. L., however, over-ruled that opinion; looked into the marks of *Orr-Ewing* themselves, and after examining them, thought that he had shewn a *prima facie* case for being allowed to proceed with an application for registration of the distinctive devices that I have already referred to. The result, therefore, of that decision was simply to remove what was a statutory impediment or quasi-statutory impediment, or bar, that had been placed against the Registrar even entertaining the question of the application. The H. L. did not decide that *Orr-Ewing* was entitled to register the devices, as is explained in the speeches of the noble Lords, Lord CAIRNS and others. They left the question entirely open, so that they merely removed that initial difficulty which stood in the way of *Orr-Ewing* by reason of the decision which the Committee had come to. *Orr-Ewing*, after he had obtained the order of the H. L. had to start before the Registrar, and his marks had to be advertised, and any opposition that the persons interested thought fit to make could have been brought forward. That case, therefore, is no authority for the proposition on which the Applicants' Counsel relied. It was difficult exactly to ascertain the nature of the proposition which they put forward, but it seemed as if they were asking me judicially to amend the application that had been made before the Registrar, and which application stands for my determination judicially. Obviously, the decision of the H. L. does not affirm that proposition.

With regard to (2) his Lordship referred to the Act of 1883, sect. 74, and said :—

The disclaimer therefore, according to the section, must be in the application itself. The words are express. Nothing is said about a disclaimer at the Bar in the course of the determination of the matters which I have to determine under the 69th section. Further, the disclaimer that is required here is a disclaimer of “any such common particular or particulars.” “Such common particular or particulars” means words, and so forth, which are

8 R. P. C.
34, l. 50.

common to the trade. There is no pretence for saying that the important words "Geneva Key Brand" are common to the trade.

(1891) 1
Ch. 49.
8 R. P. C.
35, 1. 1.

The evidence * * shews that "Geneva Key Brand" or the "Key Brand Geneva," is a term which for twenty years and upwards has been the designation in the market by which the Respondents' goods have been known. The result is that there is no ground for the suggestion that any disclaimer could be made in such a case as this, under these special statutory enactments, at the bar, because the disclaimer is too late, and the proposed disclaimer is not within the enactment.

RE MEIKLE'S APPLICATION.

[August, 1876. 24 W. R. 1067.]

Trade Mark—Advertisement—Act of 1875—T. M. R. 1876, r. 12 (infra, p. 389).

Summons * for registration as a trade mark of a device containing, amongst other things, the word "Registered." The Registrar refused to register or advertise the proposed mark on the ground that the Commissioners of Patents had given special directions that the word "Registered" could in no case be allowed to appear in connection with a trade mark.

Registration refused.

24 W. R.
1068.

HALL, V.-C.—I am unable to make an order upon this application. The summons asks me to make an order that the name of this gentleman may be inserted in the register of trade marks kept in pursuance of the Act of Parliament. It is impossible for me to make an order that the name should be put upon the register. That is plain. There has been no advertisement whatever such as the Act requires. The object of the advertisement is to give to persons, who might be claimants of the trade mark proposed to be registered, the opportunity of coming forward and objecting; and accordingly there are provisions for that purpose both in the Act of Parliament and in the rules, and it is manifestly impossible for me to make an order for rectification of the register by inserting the name of the Applicant.

* See note to *Ex parte Stephens* (*infra*, p. 321.)

M. MELACHRINO & COMPANY v. THE MELACHRINO EGYPTIAN CIGARETTE COMPANY AND ULYSSE MELACHRINO.

[April, 1887. 4 R. P. C. 215.]

Trade Mark—User—Trade name—Sale—Fraud.

Motion.

In *April*, 1886, the Plaintiffs opened a business under the title of *M. Melachrino & Co.* in Cockspur Street, London, for cigarettes, and soon established a considerable trade and reputation. At the same time they applied to register an elaborate label as a trade mark for cigarettes, comprising, *inter alia*, three coats of arms. The Comptroller refused to register the coats of arms as part of the trade mark, and the label was, in *July*, 1886, registered without them. The Plaintiffs, however, used the label with the addition of the coats of arms. The Defendant *Ulysse Melachrino*, a brother of one of the Plaintiffs, was from *April* to *Oct.* 1886, employed by the Plaintiffs as a salesman at a weekly salary. He had been previously a boot and shoemaker, but had become bankrupt. Early in 1887, he entered into an agreement with the Defendant *Poulides* to act as manager in a cigarette business to be called *The Melachrino Egyptian Cigarette Co.*, which was in fact the business of *Poulides* and was started in *Feb.* 1887, at No. 10, Pall Mall, close to Cockspur Street.

Upon motion in an action brought by the Plaintiffs to restrain infringement and passing off, CHITTY, J., held upon the facts that the conduct of the Defendants was fraudulent from first to last, and that the object they had in view was by fraudulent devices to appropriate to themselves the benefit of the Plaintiffs' trade.

The Defendants used two labels, a pink and a blue one, the use of which the Judge held to be an infringement of the Plaintiffs' trade mark.

With regard to the trade name adopted by the Defendants, his Lordship said :—

It is said that a man has a right to carry on business under his own name, and that is unquestionably so; but where there is already an established business carried on under the same name, it is important to see that the man who happens to have the same name and starts the same business; carries on that business fairly and honestly, and not in such a manner as to deceive the public into the belief that the two businesses are one and the same. Honestly he may trade under his own name, but he must be careful not to trade under his own name in such a manner as

4 R. P. C.
220, l. 56.

to take away that which lawfully belongs to another man. To put an illustration which is often used in these cases, a man might start in business as a banker under the name of *Coutts*, but if he set his business up in the Strand near the well-known bankers of that name, it is scarcely conceivable that he could carry that business on honestly; it is scarcely conceivable that he could be using his name in such a business as that for any honest purpose, or indeed for any other purpose except to get so much as he could get of the business of the well-known bankers. He must be careful therefore not to deceive.

4 R. P. C.
224, l. 51.

The business which is being carried on is *Poulides'*, and I shall hold that a man cannot sell his own name to another for the purpose of carrying on a rival trade, and particularly so where it is for the purpose of carrying on a rival trade fraudulently, and that is, according to the view of the case I take—and I think the only one that can fairly be taken—that is what the Defendant *Ulysses Melachrino* has been doing. It is said that he sold his name to *Poulides*: I say he has lent the use of his name to *Poulides* for the fraudulent purpose of taking away the Plaintiffs' business.

4 R. P. C.
222, l. 3.

In dealing with the pink label his Lordship said:—An argument was addressed to me with reference to that portion of the case which turns on trade mark, that the Plaintiffs were not entitled to any injunction in respect of this trade mark, because the Plaintiffs use the coats of arms * * on the face of their label. It was said, in some way which was unintelligible to me, that that vitiated their trade mark. It appears to me that that proposition of law cannot be maintained for a moment. The Plaintiffs do not put forward their trade mark as being the trade mark registered. I have failed to notice—and I believe I am right in that—that the word “trade mark” occurs upon the Plaintiffs' labels, which are a representation of their trade mark with the exception * * of the [coats of] arms. But I think it would be splitting hairs to hold that the Plaintiffs are not entitled to an injunction if their trade mark is infringed, because they have added the coats of arms, which form no part of their trade mark, and which cannot be registered.

4 R. P. C.
223, l. 32.

In dealing with the blue label his Lordship said:—This could not be mistaken for the Plaintiffs', as regards trade mark, if put side by side with the Plaintiffs', but they have in many respects strong similarities. There is no evidence on the part of the Defendants how this came into being. I take it—it is substantially admitted—that this also was as much an imitation of the Plaintiffs'

trade mark as they dare make, and as is well known, the rule in regard to infringement is not to take the two documents and put them side by side, because that is not what a man does who goes to buy. He sees one at one time and one at another, and carries more or less imperfectly in his mind the one that he has first seen, and he is, generally speaking, not in a position to make anything like an accurate comparison of the two. On this question of fraud and of infringement, I am entitled to look, and I think the Court ought to look to all the circumstances.

His Lordship granted an injunction to restrain the Defendant *Poulides*, his agents and servants, from carrying on at No. 10, Pall Mall, the business carried on by him there under the name of *The Melachrino Egyptian Cigarette Co.*, or of *Melachrino & Co.*, and to restrain the Defendants respectively and their respective agents and servants until judgment or further order from selling or offering for sale cigarettes not of the Plaintiffs' manufacture or merchandise, in boxes or packages having affixed thereto or connected therewith the labels, exhibits A11 and A12, or any other label being a colourable imitation of the Plaintiffs' label.

4 R. P. C.
225, l. 10.

RE MEYERSTEIN'S TRADE MARK.

[March, 1890. 7 R. P. C. 114; 43 Ch. D. 604; 59 L. J. Ch. 401; 62 L. T. 526; 38 W. R. 440.]

Trade Mark—Invented word—Descriptiveness—Acts of 1883 to 1888, s. 64, subs. 1 (c)—Act of 1888, s. 10.

Motion to proceed.

Application under the Acts of 1883 to 1888, by Messrs. *Meyerstein & Co.*, starch and soap merchants, to register "Satinine" as a new trade mark, in respect of Class 47 (which included starch, &c.) and Class 48 (which included soap, &c.). The Comptroller refused registration. Appeal to the Board of Trade, who referred the appeal to the Court. Registration refused.

KAY, J.—This is a word which describes the quality of the goods, and there is marvellously little invention in the matter, because the only invention is, putting at the end of a common word "Satin," which brings to every man's mind in a moment the notion of a glossy surface, the common conclusion "ine," which you will find in "Saline," "Saccharine," and half a hundred other English words. Certainly if that is inventing a word, it is the easiest mode of inventing you can possibly conceive. But I understand that this Act of 1888 is subject to the limitation which the

7 R. P. C.
116, l. 1.

decisions have put on the former Act, that you cannot possibly use any word, fancy word or otherwise, if it is a descriptive word.

* * * Everybody knows that one effect of the use of starch is, that goods which are washed and starched, and are then ironed or colandered, have a much more glossy surface than the same articles would have if they were ironed or colandered without being starched ; that is common experience.

7 R. P. C.
116, l. 24.

It seems to me plain that this Applicant was intending to get a word which would suggest to people buying the starch from him, that it was starch which would conduce to the production of a very glossy surface. That is a description of the effect produced by the use of the article which is, according to this Act, a description of the article, that is, a descriptive word, and that is a very sufficient reason, in my opinion, for refusing, as the Comptroller has done, to register the word.

RE MITCHELL'S TRADE MARK (1).

[August, 1877. 7 Ch. D. 36 ; 46 L. J. Ch. 876 ; 26 W. R. 326.]

Trade Mark—Single letter—Act of 1875, ss. 1, 10—Act of 1876, s. 1.

Motion to rectify.

The Applicants had in this case applied to register the letter A as an old trade mark for a particular sort of steel pen. This was a motion by way of appeal from the decision of the Registrar, who had refused registration.

Motion refused.

7 Ch. D.
40.

HALL, V.-C., read the definitions contained in the Act of 1875, s. 10 (*supra*, p. 5), and said :—The trade mark, which the Applicants in this case seek to register, is not within the first of these definitions, nor is it within the other “a special and distinctive word, or combination of figures or letters.” As I read the words “combination of figures or letters used as a trade mark before the passing of this Act,” the word “combination” is associated with the word “letters” as well as with the word “figures.” Therefore, upon the true construction of the Act, no provision is made for the registration of a single letter.

MITCHELL v. HENRY.

[C. A., June, 1880. 15 Ch. D. 181 ; 43 L. T. 186.]

Trade Mark—Imitation—Expert Evidence—Practice—Act of 1875.

Motion.

In 1877, the Plaintiffs registered for worsted goods a trade mark described as “a white selvage on each side of the piece having a red and white mottled thread interwoven the full length of the selvage between the edge of the piece and the edge of the selvage,” and deposited a specimen at the Patent Office Museum. The specimen so deposited was undyed, and the selvage was white, the warp being white cotton and the woof white mohair ; nearly in the middle of the selvage was a compound warp thread, composed of a thread of white cotton and a thread of Turkey red cotton twisted together. When the goods were dyed black, the cotton threads took the dye imperfectly, so that the warp threads in the selvage became grey while the woof became black, so as to make the selvage dark grey with a dark red mottled line running along it. The Defendants sold black mohair goods with a dark grey selvage of nearly the same shade as that of the Plaintiffs’, with a twisted thread running along its inner edge, which thread was originally white, red, and yellow, but in the course of dyeing the white became dark grey and the yellow a dark olive, which could hardly be distinguished. The Plaintiffs sought to restrain the sale of these goods as an infringement of their trade mark, and moved for an injunction. There was evidence that the selvage of the Plaintiffs’ dyed goods, though not actually white, was what was known in the trade as a white selvage.

There was a conflict of evidence as to whether the selvage of the Defendants’ dyed goods was or was not according to the understanding of the trade a white selvage, and also whether the differences in quality and position of the Defendants’ mottled thread was sufficient to distinguish the Defendants’ goods from those of the Plaintiffs, so as to prevent purchasers from being misled.

JESSEL, M.R., held that, as, upon an examination of the patterns, the Plaintiffs’ selvage was not white, and the mottled thread of the Defendants was different and in a different position from that of the Plaintiffs, there was no infringement, and that an injunction must be refused.

Appeal to the C. A. (James, Cotton, and Thesiger, L.JJ.) ; order of the M.R. dissolved and motion directed to stand over till trial, the Defendants undertaking to keep an account.

15 Ch. D.
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JAMES, L.J.—The M.R. seems to have considered that when he had satisfied himself, by examination of the patterns before him, that the twisted thread of the Defendants was in a position different from that of the Plaintiffs, and that the selvage, when looked at, could not be said to be white, the question was disposed of in favour of the Defendants. I am bound to say that, in my opinion, the question is not whether the selvage is white, but whether it is what the trade know as a white selvage, whether anybody connected with the trade could have any doubt that it came within the description of a white selvage. Then, again, to my mind, the fact that the position of the Defendants' thread is not the same as that of the Plaintiffs' thread, is not at all conclusive. The question resolves itself into the old question, which has always been the question to be determined in these cases, are the Defendants, not in words but by acts and by something on the face of their goods, representing their goods as being the goods of the Plaintiffs, that is to say, are they using some mark which is calculated to pass off their goods as the goods of the Plaintiffs?

15 Ch. D.
191.

In order to come to a satisfactory conclusion, it is necessary to know what the witnesses would say when they are using their own words in answer to questions not leading, whereas we have before us only affidavits which are answers in the solicitor's words to questions the most leading possible.

15 Ch. D.
193.

COTTON, L.J.—In my opinion, the Act in no way interferes with the exercise by a Court of Equity of its old jurisdiction. * * *

The question is not simply whether or no, putting the Plaintiffs' and Defendants' marks side by side, one might be so different from the other as to be capable of registration as a distinct mark, or whether the Plaintiffs have themselves registered trade marks which have no greater distinction between them than the distinction between the mark of the Plaintiffs and that of the Defendants, for slight distinctions between the Plaintiffs' marks may distinguish different classes of the Plaintiffs' goods; but the question, in my opinion, is whether the Defendants are so selling their goods as to pass them off as the goods of the Plaintiffs.

15 Ch. D.
195.

I will say a few words as to the reason why I think we cannot interfere by granting an injunction. If there is a conflict of testimony on the question whether or no goods are calculated to deceive or be passed off as those of the persons by whom they are not manufactured, the Court very often is in a position to judge by its eyes where the truth lies and what ought to be the result.

In the present case, however, the question seems to me to be essentially a question for experts, for when the goods are placed side by side there is great difficulty in arriving at a conclusion whether the triple thread used by the Defendants and the selvage altogether is not calculated to deceive.

THESIGER, L.J.—Although the Defendants are using a mottled thread made up of three distinct colours, instead of a mottled thread made up of two distinct colours, yet I cannot say, by the evidence of my own eyes, whether the threefold thread used by the Defendants might not even to the eyes of an expert be a colourable imitation of the twofold thread used by the Plaintiffs. It appears to me that that must be matter of evidence, and evidence of experts. 15 Ch. D.
196.

There is clearly a conflict of evidence, and such a conflict of evidence as makes it undesirable that this Court should decide the matter on motion. 15 Ch. D.
197.

RE MITCHELL'S TRADE MARK (2).

[February, 1885. 28 Ch. D. 666 ; 54 L. J. Ch. 809 ; 51 L. T. 900 ; 33 W. R. 408.]

Trade Mark—Entry on Register of note limiting user—Act of 1883.

Where two similar trade marks are registered in the same class, the entry on the register a note that the use of the marks registered is restricted by an agreement between the respective owners (the effect of which is not stated), is irregular and contrary to the provisions of the Patents, Designs, and Trade Marks Act, 1883, but following *In re Rabone & Co.* (Seb. Dig. 643), a note of the mutual undertakings not to use the marks except in a certain manner and within specified districts may be entered on the register.

CHITTY, J.—The Comptroller is not bound to receive a copy of an agreement between the parties ; and to place on the register a note for the purpose of showing that the user of the mark is subject to an agreement merely referred to and not stated, and which could only be found by search, would be a violent departure from the principle of the Act. In *In re Rabone & Co.* (Seb. Dig. 643), the late M.R. certainly did allow an undertaking by the parties restricting the user of the trade mark to be entered on the register ; and whether that case was rightly or wrongly decided, I should have great hesitation in overruling it, especially as it has been followed in several cases. The order will be varied by directing 28 Ch. D.
568.

undertakings restricting the use of the mark to certain specified districts, as in *In re Rabone & Co.*, to be entered on the register.

MOËT v. PICKERING.

[C. A., March, 1878. 8 Ch. D. 372; 47 L. J. Ch. 527; 38 L. T. 799; W. R. 637.]

Trade Mark—Lien of wharfinger—Costs.

Action to restrain infringement.

The Plaintiffs, who were producers and shippers of champagne at Épernay, in France, were in the habit of placing on the bottom of each cork, with which their wine of one particular quality was bottled, a brand consisting of the letters "M. & C." together with a star, the word "England" being branded on the side of the cork.

The Defendant, *Joseph Pickering*, was the consignee of fifty cases of champagne, not grown by the Plaintiffs, in bottles with corks branded with a brand similar to that of the Plaintiffs. This wine was in the possession of Messrs. *Besley & Wilson*, wharfingers in London, who were also made Defendants to the action.

The wharfingers by their Defence submitted to act as the Court should direct upon their "charges for rent or warehousing and sampling which have accrued and shall accrue due, being paid or provided for, and upon their costs, charges, and expenses of this action being paid or provided for."

At the trial of the action the wharfingers claimed a lien for their warehouse charges in priority to any claim by the Plaintiffs, and insisted that the bottles ought not to be touched for the purpose of removing the fraudulent corks, until such charges were paid.

FRY, J. (6 Ch. D. 770), granted an injunction against all the Defendants, and made an order that the wharfingers should remove the corks from the bottles in the presence of the Plaintiffs. And he made a declaration that all the Defendants should pay the Plaintiffs' costs of the action, and that the Plaintiffs were entitled to a lien for their costs on the wine, in priority to the lien of the wharfingers for their warehouse charges.

The wharfingers appealed to the C. A. (James, Cotton, and Thesiger, LJJ.). Order of FRY, J., varied.

JAMES, L.J.—The real meaning of [the wharfingers' Defence] is, "We do not claim anything adversely to the Plaintiffs or *Pickering*."

Let the Court settle the matter between the parties who are in dispute. We have nothing to do with it. We do not raise any objection to the Court doing anything as between them it may think right." There is no suggestion in this case that the wharfingers have not acted in a perfectly *bond fide* manner throughout this transaction, and were not entitled to be paid the charges they made for warehousing this wine. I am of opinion that the wharfingers here had a lien upon the goods in question, and that there was nothing to deprive them as wharfingers of their lien because the corks in these bottles of champagne had fraudulent marks which they knew nothing at all about. I think they have done nothing to deprive themselves of their right to the costs of the action, and this lien for wharfingers' charges must be considered prior to any lien which the Plaintiffs may have for costs. The question whether the Plaintiffs are entitled to a lien is not now before us, but it must not be supposed that I assent to the decision in the case that has been referred to, *Upmann v. Elkan* (L.R. 12 Eq. 140, *ibid*, 7 Ch. App. 130), where it was held that the Plaintiff in such a case had a lien for his costs upon the goods that had been warehoused. That seems to me to be something quite new. In the present case I am of opinion that the wharfingers ought to have their costs in the suit, and that they are entitled to a prior lien for their warehouse charges. The order of FRY, J., therefore, will be varied by omitting the declaration that the Plaintiffs have priority with respect to their costs of suit over the Defendants, the wharfingers, for warehouse charges, and that the Plaintiffs pay the wharfingers' costs in the Court below and in this Court.

COTTON, L.J.—The lien of the wharfingers is, I assume, only as 8 Ch. D.
against the bottles and wine when the fraudulent corks have been 376.
removed, but I cannot see any possible ground, when those have been removed, for saying that their lien for warehouse expenses loses any priority that it before had, and which was a first charge against these goods. It must not be supposed that I assent to the view taken in the case that has been referred to in the course of the argument, where it was held that the Plaintiff had a lien for his costs upon the goods; but we cannot decide that question now. * * *

It has been suggested that the wharfingers ought to lose their costs, because they contended at the Bar that the corks ought not to have been removed or interfered with at all till their charges had been provided for. In my opinion that is not sufficient to justify

our making an order that they should pay the Plaintiffs' costs of the suit. Therefore that part of the order cannot be sustained, and I agree with JAMES, L.J., that the ordinary order in such cases must be made that the wharfingers are entitled to the costs of the suit, they having on the pleadings submitted to act as the Court should direct.

RE HENRY MOËT'S TRADE MARK.

[May, 1890. 7 R. P. C. 226.]

Trade Mark—Amendment of notice of opposition—Act of 1883, s. 69—Act of 1888, s. 13—T. M. R., 1890, rr. 31, 54, 55 (infra, pp. 358, 362).

In September, 1889, *H. Moët* applied to register two trade marks, containing prominently his name. The applications were advertised on the 20th and 27th of November, 1889. On the 19th December, 1889, *Chandon et Cie., Successeurs de Moët et Chandon*, gave notice of opposition on various grounds. On the 23rd and 24th of January, 1890, *H. Moët* put in a counter statement. On the 19th of February, 1890, the Opponents applied to amend their notice of opposition by alleging that *H. Moët's* application was fraudulent, and on the 6th of March, 1890, the application was heard by the Comptroller's Deputy, who substantially decided there was no power to amend a notice of opposition, and was also of opinion that he would not allow the amendments if he had power. No actual application had been made for an extension of the time allowed for opposition, which upon the construction put by the Patent Office on the Act of 1883, s. 69, expired on 19th February. *Chandon et Cie.* subsequently applied to the Comptroller for a rehearing of their application, and for a formal extension of time, but the Comptroller refused to rehear the matter. *Chandon et Cie.* then applied for a mandamus that their application to amend might be heard, and, if necessary, their application for an extension of time. Rule for mandamus made absolute.

The Comptroller's Deputy made an affidavit stating his decision.

7 R. P. C.
230, l. 26.

MATHEW, J., after reading T. M. R., 1890, r. 54 (*infra*, p. 362), said:—Now upon looking at the affidavit of the Deputy Comptroller in this case, it is quite clear to my mind that the *ratio decidendi* was, that he had not the power which the rule appears to me distinctly to give him. No reliance was placed by him, and no reliance ought to have been placed by him, on the point that formal application to extend the time had not been made, and had not been granted. His view was that he had no power to amend.

He intimates to us that, if at some future time he should be advised in the way that he was advised when he made the affidavit, he would not grant the amendment on the ground he states. Well, I sincerely hope that he may be better advised when the matter comes before him, and that he may not be of the same mind, for it seems to me that the point, that because a charge of fraud is made, no opposition should be allowed on that ground within the terms of this rule as to amendment is, again, erroneous. It may be that we should not have the power of correcting him, and that some other course would have to be taken about that; but whether we have that power or not, it is quite clear that he was wrong in what appears to govern his decision, his view being that he had not the power of amendment.

MOUSON *v.* BOEHM.

[March, 1884. 26 Ch. D. 398; 53 L. J. Ch. 932; 53 L. T. 784; 32 W. R. 612.]

Trade Mark—Abandonment—Concurrent Registration—Act of 1883—T. M. R., 1876, r. 34.

Action to restrain infringement. Summons to proceed with registration of Defendant's trade mark. Motion to expunge Plaintiffs' trade mark.

In 1874, the Defendant, who carried on business as a soap manufacturer at Offenbach near Frankfort-on-Main, adopted a trade mark, consisting of a kangaroo with the word "Colonial" inclosed in a ring or frame-work, for a particular kind of soap intended to be exported to the English Colonies. Soap marked with this trade mark was for about two years manufactured and sent by the Defendant to this country in large quantities for exportation to Australia, but from 1876 to 1882, the manufacture and sale of soap thus marked fell off until it practically ceased. In 1882, the existence of the mark had been forgotten by the Defendant, but he did not break up the moulds or erase the trade mark from his books or price lists.

In 1880, the Plaintiffs, who were soap manufacturers at Frankfort-on-Main, and who also carried on a large business with the English Colonies through London agents, adopted, in complete ignorance of the Defendant's mark, and registered in England, a precisely similar mark for soap sent to this country for exportation to Australia.

In *April*, 1882, the Defendant's attention was for the first time drawn to the Plaintiffs' mark, and upon being reminded by his

agents of the existence of his own similar mark, he informed the Plaintiffs of his intention to use his own mark.

The writ was issued in *June*, 1882, and in *July*, 1882, the Defendant applied to have his trade mark registered, and moved to expunge the Plaintiffs' trade mark.

CHITTY, J., dismissed the action, refused the motion, and acceded to the summons, all without costs.

26 Ch. D.
404.

CHITTY, J.—It appears to me that Mr. *Boehm* has established, first, that he did acquire a trade mark which became his property in connection with toilet soap, and then the question arises on that whether he ever abandoned it. That is undoubtedly a question of fact. There is nothing in the new Act or the old Act which bears on the point with any definiteness. There was rule 34 under the Trade Marks Act, 1875 (repealed by the Act of 1883), which does not appear to be embodied in the new rules: "The Court may, on the application of any person aggrieved, remove any trade mark from the register, on the ground, after the expiration of five years from the date of registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade mark is registered." Ceasing, therefore, to carry on business for a period of five years under that rule would have been a ground for removing the trade mark from the register. That gives some indication of what was considered proper with regard to this subject, but it has very little bearing on the case before me, because that rule, as I understand it, is now repealed.

Now, on the question of abandonment, it appears to me that intention to abandon must be shewn. There are some analogous cases in law, such as the case of an easement. Mere non-user of an easement, like a right to foul a stream for a considerable period of years, would not be sufficient to prove an intention to abandon it. But if, as in the case of *Crossley v. Lightowler* (L. R. 2 Ch. App. 478), the person who was entitled to such an easement as fouling a stream, has not only ceased from using it for a period of twenty years, but at the same time has allowed the mill in respect of which the right is claimed, to fall into ruins, or has pulled it down, the Court would infer, from the circumstances, an intention to abandon the right which had been previously exercised.

26 Ch. D.
405.

In substance, therefore, the question of abandonment is one of intention to be inferred from the facts of the particular case.

Now, ought I to infer it in the case before me? Mr. *Boehm* retained that mark, he did not break up the moulds according to

the practice which he stated he adopted when he did intend to give up any particular mark. He did not even erase the trade mark from his books, and there were persons in the market who got the goods from him who were endeavouring to effect sales, and he, by sending over those price lists to the number of 1,200 during the years spoken to, was himself endeavouring to effect sales. Now an important point also is this, that he did not give up the business to which the trade mark belonged. It is quite true, as [Counsel] said, that he never attempted to register, but that is only an element, as [Counsel] admitted, to be taken into consideration with the other facts. Registration of the trade mark is no doubt a condition precedent to suing.

It was said that user is the life of a trade mark, and non-user the death of it. Those of course are metaphorical expressions which must be received with caution. No doubt, apart from registration (which the present Act makes equivalent to user) a trade mark was acquired by user, and a very short time has been held sufficient, as in the case of the *Anatolia Liquorice, McAndrew v. Bassett*, 4 D. J. & S. 380. * * * Here it appears to me there was no absolute non-user for any sufficient time, taken in connection with all the circumstances, to shew an intention to abandon. A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose he lost his trade mark by not putting more goods on the market when it was glutted. There was some user, and the result, therefore, is that *Boehm* has not abandoned his trade mark. The trade mark was not of very great value to him; * * * still, I think it was his trade mark before, and he has not lost it by abandonment. 26 Ch. D.
406.

Then comes *Boehm's* application to register. * * * The present Act shews that the principle adopted by the late M. R. as to concurrent trade marks is the right one, and that there may be on the register, up to the number of three, persons entitled by independent user to a trade mark. It follows therefore that *Boehm* is entitled to register his trade mark. 26 Ch. D.
407.

Dealing with the Defendant's motion, his Lordship said:—*Mouson* has been two years on the register; he has acquired title *bonâ fide* and independently, and he has enjoyed during those two years a considerable trade, in fact a greater trade than *Boehm* has done during the eight years that preceded 1882, and it seems to me that I ought therefore to refuse the application to expunge *Mouson's* trade mark, which I do. The case of *In re Powell, In*

re Pratt (before the late M.R. on 12th Jan., 1878, Seb. Dig., 589), is an authority for the proposition that there may be, as I have already stated, two identical trade marks on the register, when the parties have used the mark independently and each party claims *bonâ fide*.

RE MÜNCH'S APPLICATION.

[November, 1884. 50 L. T. 12.]

Trade Mark—Three mark rule—Foreign user—Act of 1875, s. 6.

Summons under the "Three Mark Rule."

In 1884, *Münch*, a German subject, applied to register in England a mark practically identical with a mark registered in England by Messrs. *Murray & Lanman* in 1880, and used by them or their predecessors in title since 1842. *Munch* alleged user in Hamburg since 1869.

50 L. T.
13.

CHITTY, J.—It is quite clear upon the facts that the Opponents could have obtained an injunction against the Applicant at any time up to the date of the Applicant's application to register, and at the present time, on the following ground. The Opponents, Messrs. *Murray & Lanman*, invented their trade mark as long ago as 1842, * * * and that trade mark they have used in connection with the large sales of their goods not only in other parts of the world, but in Great Britain and the Colonies, and they have to my mind established for this trade mark an exclusive user as against the world. * * * The fair inference [from the evidence] is that Mr. *Münch* took bodily the whole of the present trade mark of the Opponents with the exception of the name. But even if that were not so, the case really seems to be quite clear upon the facts that there has been no such user on the part of the Applicant in this country, nor elsewhere, except it may be in Hamburg and according to Hamburg law, as would entitle him to set up his claim to the trade mark in opposition to the Opponents in this country.

50 L. T.
14.

The facts of this application, as indeed I hold to be the case, fall within the 6th section of the Act, and they are not within the principle of *Jelley's case* (*supra*, p. 187).

RE MURPHY'S TRADE MARK.

[April, 1890. 7 R. P. C. 163.]

Trade Mark—Act of 1883, ss. 64, 72, 92.

Motion to proceed.

In 1889, *Murphy & Co.* applied to register as a new trade mark in respect of fermented liquors and spirits, a label containing a lion rampant carrying a sheaf with the words "*fortis et hospitalis*" above it, and surrounded altogether by an oval bearing the inscription, "J. J. Murphy & Company, Limited, Cork." The Comptroller refused registration under the Act of 1883, sect. 72, on the ground that the proposed mark so nearly resembled a trade mark which had already been registered by *Gordon & Holland* in respect of the same goods, and consisted of a label containing a lion rampant carrying a crown with the word "Whitehall" under it, as to be calculated to deceive. The general appearance of the mark proposed to be registered by *Murphy & Co.* was different from that of the mark already registered. Appeal to the Board of Trade, who referred the matter to the Court. Comptroller's decision upheld.

STIRLING, J.—By section 64 of the Act, the trade mark to be entitled to registration must consist of or contain at least one of the following essential particulars. (His Lordship read the section, *supra*, p. 9)—I need not refer to any other parts of the Act; and it is to be borne in mind that under a part of a subsequent clause of the Act, namely, section 92, it is important to have regard to what are and what are not the essential particulars, because the registered proprietors of any registered trade mark "may apply for leave to a Court to add or to alter by striking out or adding or by both, any particular part of a registered mark which is not an essential part within the meaning of this Act," as he may think fit. It is to be borne in mind that it is very convenient, where a mark contains a name, that an alteration should be permitted, because upon the sale of the goodwill of the business and of the trade mark along with it, it is often very desirable to alter the name which is impressed upon the trade mark. Now I have got to consider what is the essential part of the trade mark, particularly the trade mark which is proposed to be registered by *Murphy & Co.*

His Lordship discussed the mark in question and said:—I think that I cannot treat the oval and the name as being essential particulars within the meaning of the Act, and I am left with the

7 R. P. C.
166, l. 9.7 R. P. C.
166, l. 43.

solitary essential particular, namely, the lion rampant carrying the sheaf, which * * * appears to me to be very similar to the lion rampant carrying the crown of *Gordon & Holland*.

7 R. P. C.
166, l. 54.

With reference to an undertaking offered by *Murphy & Co.* to use the label as it then stood, his Lordship said:—The question is whether I ought to accede to that and put [the mark] on the register with that undertaking. Now if these marks had been old marks used by the two parties long before the passing of the Act or a considerable time independently of each other and in ignorance of each other's rights, I think it would have been a very proper thing to have directed the registration to take place and to have accepted that undertaking. But *Murphy & Co.* come here asking me to register a new mark, and when a new mark is sought to be registered, considerations of a different kind I think ought to prevail. I think it is the duty of a person registering a new mark, where there is another already on the register, to seek for something which can really distinguish the two goods, and to register a mark which will not be liable to confusion in any sort of way.

THE NATIVE GUANO COMPANY LIMITED v. THE SEWAGE MANURE COMPANY.

[H. L., April, 1889. 8 R. P. C. 125.]

Trade Mark—Descriptive term.

Action.

In 1869, the Plaintiff Company bought a patent for what became subsequently well known as the A. B. C. process for treating liquid sewage. They subsequently took out other patents for improvements in the process, all of which had expired by 1887. The specification of one of these patents (taken out in 1872) contained the following statement:—"Our said invention consists in the use of what is known as 'Native Guano' for deodorizing, absorbing, and decomposing human excreta or night soil. 'Native Guano' is the precipitate obtained by treating sewage with deodorizing mixtures as described in the specification of Letters Patent No. 1954 of 1868, and Nos. 364, 1354, and 3399 of 1870, which patents are the property of or held in trust for *The Native Guano Company Limited*, the subject-matter of the said patents constituting the process known as the A. B. C. process."

The Plaintiff Company from 1869 onwards always used the term

"Native Guano" to denote the manure made by them under the A. B. C. process as improved from time to time, and in 1882 they registered the words "Native Guano, A. B. C. process," as an old trade mark.

In 1887 the Plaintiff Company having recently discovered that the Defendants were issuing leaflets offering "Native Guano" for sale with directions for use copied verbatim from a leaflet of the Plaintiff Company, which had been registered under the Copyright Acts, commenced an action to restrain the Defendants from issuing the leaflets and from using the words "Native Guano." The Defendants offered to give up issuing the leaflets, but refused to discontinue the use of the words "Native Guano."

Action dismissed with costs.

KAY, J.—The Plaintiffs have proved that they have used the words "Native Guano" from a time before this patent of 1872, and since, to describe the product of this process, which process, as I understand, they have improved from time to time by taking out other patents. But they publish to the world in 1872, as clearly and distinctly as any words could publish it, by the words * * * of the specification, that "Native Guano" was then well known and that it was the product of a peculiar process then the subject of a patent for treating sewage. 4 R. P. C. 476, l. 14.

The truth is that these words have become descriptive, and became, at least in 1872, as purely descriptive of a particular product as a watch or any other common word representing an article of manufacture is at this moment, and having become descriptive of a particular product, it is too late for the Plaintiffs to assert that they do not mean anything at all but manure manufactured by them. Unless they can assert that, they have no right to restrain the Defendants from the use of the words for manure manufactured by them, at least if it were manufactured according to this A. B. C. process. But then the Plaintiffs say this: "Supposing we cannot maintain that 'Native Guano' now means manure manufactured by the Plaintiff Company, still we have a right to restrain the Defendants from using those words because they are using them to describe manure not made by the A. B. C. process." This is the first time I ever heard such a proposition asserted in Court. If the Plaintiffs have that right, having no exclusive right to the name, then everybody in the world has the same right, and that would enlarge the jurisdiction of this Court * * * to prevent tradesmen telling falsehoods, because in that view of the case it is simply a falsehood. It may 4 R. P. C. 476, l. 55.

hurt the Plaintiffs, but it hurts them no more than any other person who manufactures "Native Guano" by the A. B. C. process, and unless the Plaintiffs are prepared to say that everybody who manufactures "Native Guano" by the A. B. C. process has a right to prevent anybody else calling another product "Native Guano," the proposition is not maintainable. Of course Counsel could not for a moment contend (and there is no authority for such a suggestion) that anybody who makes, as anybody may now make, this "Native Guano" by the A. B. C. process, could restrain another man from calling something else "Native Guano" because it was not true. A man who tells falsehoods of that kind generally finds that the old proverb "Honesty is the best policy" is a very true proverb, and in the long run he loses his custom by selling an inferior article under a false name. But this Court does not interfere, and has no jurisdiction to interfere, simply because what a Defendant says is not true, even if that were the case here.

It appeared that the Defendants also called themselves "The Native Guano and Soot Manure Company." At the trial the Plaintiff Company asked for an injunction to restrain the Defendants from using "Native Guano" as part of the name. KAY, J., refused an injunction, as the matter was not pleaded, and declined to give leave to amend.

The Plaintiff Company appealed to the C. A. (Cotton, Lindley, and Bowen, LJJ., 8 R. P. C. 125). Appeal dismissed without prejudice to any action which the Plaintiffs might be advised to bring to restrain the Defendants from representing their goods as goods made by the Plaintiffs, or to restrain the Defendants from trading under the name of the "Native Guano and Soot Manure Company." The Plaintiff Company appealed to the H. L., who affirmed the decision of the C. A.

8 R. P. C.
134, L. 14.

LORD HERSCHELL.—My Lords, it is obvious, to my mind, that during the years prior to the expiration of these Patents, "Native Guano" did describe and was intended to describe a particular product. It was understood in the market as describing a particular product. No doubt, during that time, that product was made only by the *Native Guano Company Limited*. They were the owners of the patents, and during the term of those patents, no one else, except by licence from them, had any right to make the particular product referred to; but as soon as the patents expired, those rights became open to the world, and it is well settled (indeed the legal proposition was hardly disputed by

[Counsel]) that after they had expired, it was open to any one to make the very same product which the Plaintiffs had been making, and to call it by the very same name.

Therefore, my Lords, so far as this action is founded upon any exclusive right to the use of the words "Native Guano" it appears to me, agreeing with the Court below, that the action entirely fails.

But then it was said, and no doubt with perfect truth, that although there may be no right to the name in the sense in which I have hitherto used those words, yet no trader can be allowed to deceive the public into the belief that the goods manufactured by him are really the goods manufactured by another; and if he does that by the circumstances under which he uses the name, then, no doubt, application may well be made to the Courts to restrain any trader from so deceiving the public. My Lords, at the trial no doubt a case of that description was attempted to be made, when it was obvious that the main ground, upon which this action had been brought, was not supported by the learned Judge before whom the case came. But it was then pointed out by the learned Judge that this other case, which was then sought to be set up, was not really raised by the pleadings. Application was then made for leave to amend: that application was refused. But in the C. A. the order which was made affirming the judgment of the Court below in the action was made without prejudice to any rights which the Plaintiffs may have to sustain such a cause of action against the Defendants. That, therefore, left them open if so advised, to bring an action. They are in no way precluded from doing so. All that has been determined is that it is not sufficiently raised in this action without an amendment.

Now, my Lords, I conceive that you would be very loth to encourage any appeal to this House which turned, not upon the rights of the parties, but solely upon the question whether those rights could be asserted in a particular way or in a particular action, or whether they were to be, as the learned Judge below determined, asserted, if at all, in another action as not being sufficiently pointedly raised in this. But in addition to that it seems to me perfectly clear that the case now sought to be raised on behalf of the Plaintiffs is not raised in this action.

Nowhere is any injunction asked for to restrain them from holding out their manufacture as the manufacture of the Plaintiffs, or using that name or any other words in such a way as to lead people to believe, or induce the belief, that the goods sold by the Defendants were manufactured by the Plaintiffs.

8 R. P. C.
135, l. 13.

My Lords, I do not propose to go through a critical examination of the language of the Statement of Claim. It has been often referred to in the course of the argument, and it is sufficient to state the conclusion at which I have arrived.

My Lords, when it is once established that the Plaintiffs have no exclusive right to the use of these words "Native Guano" and that it was open to the Defendants to manufacture the same product and to sell it under the same name, there seems to me to be no ground for alleging that the Plaintiffs have a cause of action, because that which the Defendants sell as "Native Guano" is not made by the same process as the product which had been sold by the Plaintiffs. Therefore the Statement of Claim contains no allegation, even if it would have availed the Plaintiffs that the Defendants sold an article which was inferior or which was not a manure at all, or anything of that kind. It seems to me, therefore, to make no difference that the manure, which they sold under the name of "Native Guano," was not made in precisely the same way as that which the Plaintiffs had before made under that name.

NEWMAN v. PINTO.

[C. A., June, 1887. 4 R. P. C. 508; 57 L. T. 31.]

Trade Mark—Misrepresentation—Infringement—Costs.

Action for infringement of registered trade mark.

The Plaintiff, a cigar and tobacco manufacturer, registered, under the Act of 1875, as a new trade mark for cigars, a label containing a pictorial device in which, among other things, there were two blank shields [see 4 R. P. C. 509], and also the words "La Pureza." The trade mark was used by the Plaintiff only in connection with, and for the purpose of the sale of, certain boxes of cigars imported by him from Bremen in Germany, where they were manufactured. These boxes of cigars were got up as follows:—The registered label, printed in colours and with the shield blanks filled up with the arms of Spain and the arms of Havana, was affixed to the ends of and also inside each box. On the top of each box was branded, within a circle, the words:—

LA PUREZA

HABANA

RAMON ROMNEDO.

On the lock or seal label of each box "Ramon RomnEDO" was printed as a signature. "La Pureza" was the name of a Havana

brand which had ceased to exist for some years, and there was no such person as Ramon Romnedo in existence. The Plaintiff discovered that the Defendants were selling cigars in boxes precisely similar to his own. At the trial, KEKEWICH, J., granted the relief claimed.

KEKEWICH, J.—[It is said] that “La Pureza,” [being proved to be] a common term, therefore according to *Re Hudson’s Trade Mark* (*supra*, p. 168), I ought not to give the Plaintiff the costs on the ground that he has used a common term as an addition to his trade mark without disclaiming it, and that so he has made his trade mark of less importance, or less distinct than it would otherwise have been, and than it ought to be. I am not sure that the point is really one of importance; but here again I am met with this fact, that the Defendants have also copied “La Pureza.” They might have taken “La Pureza” alone, no doubt; nobody says that they might not; but here they have taken the label with “La Pureza” on it. They have copied that, as I say, in every letter and in every possible colour, and it does not lie in their mouth to come forward and say, “There is something on your registered trade mark which ought not to be there, and, that being so, although we have copied your whole trade mark, including that which ought not to be there, we say you ought not to have the costs of a successful action.” To my mind the Defendants are wrong throughout.

4 R. P. C.
514, l. 34.

Appeal by the Defendants to the C. A. (Cotton, Bowen, and Fry, LJJ.), who held that the label could not be separated from what there was on the boxes, and that as the whole combination contained a misrepresentation, the action should be dismissed, but as the Defendants were guilty of the same misrepresentation, without costs; the Defendants to bear the costs of the appeal.

The Court assumed that the word “Habana,” when used in connection with cigars, merely indicated the shape, that the practice adopted by the Plaintiff was made use of by other cigar dealers, and that there was no evidence of deception.

BOWEN, L.J.—It seems to me that the basis upon which our judgment rests is this, that it is admitted, and admitted as beyond dispute, that this trade mark was designed simply for, and has been simply used for, the sale of these cigars in these boxes. If that is so, the inquiry to which we are driven may be described very shortly. It is first of all, what is the article which is being sold in these boxes; and secondly, is there any misrepresentation made by the box itself about that article? Now as to the cigars—the article

4 R. P. C.
518, l. 10.

sold—I will assume—I do not know that it is proved—but I will assume that they are made of Havana tobacco. But it seems to be equally clear that they are articles which are not made in Havana. * * Now if that is the cigar—the article sold—what is the representation, if any, made by the box, because a lie may be told by a box just as well as by the mouth of an individual. (His Lordship described the box and the label as used, and continued :—)

4 R. P. C.
518, l. 58.

Can it be said that that box, taken as a whole, does not represent to the mind of the person who would look at it—he would very likely not believe it, because I think it is quite true that persons, who are accustomed to buy cigars, do not believe much what they are told on the outside of a box, any more than a person who buys a horse believes what the ostler of the horse-dealer tells him—that these cigars—the manufactured article inside—are connected with Havana to some further extent than the mere connection which arises out of the fact that they are made of the Havana leaf? It surely represents that in the manufacture of the cigars some Havana house is concerned, and somebody who is entitled to use the name or facsimile of the signature “Ramon Romnedo.” Well that is absolutely false. This box is made in Germany: the whole of these pictures are devised in Germany: the signature “Ramon Romnedo,” who is a person who never existed, is put on in Germany, and the whole thing is a simple sham. It is true it would not take in an experienced purchaser of cigars, but is not it designed to take in somebody? Otherwise, why is this elaborate concatenation of pictorial lies put upon the box? It is to take in somebody; and anybody who uses that box, knowing all the facts that I know now about it, and does not explain what the box has got in it, is guilty of a fraud. I will not say anything about the Plaintiff except this, that he has been selling these cigars in this box which contains these misrepresentations, and that the trade mark was designed simply to protect this sale or this trade. I think that no Court of Justice can assist a man who is engaged in that operation.

4 R. P. C.
520, l. 10.

FRY, L.J.—It seems to me that this box contains the representation that these are cigars of the brand “La Pureza,” that they are the manufacture or selection of Ramon Romnedo, a person capable of signing and carrying on his business in Havana. Every-one of these suggestions is false. We are asked to say that it is immaterial because there is no evidence that any human being has been deceived by all this concurrence of false statements; but the inquiry arises * * is this a fortuitous concurrence of lies,

or is it a collocation of lies for some purpose and end? * * What is the inevitable conclusion? That the false statements are put together to deceive the unwary. And when we find a deliberate design to deceive, and we are asked to believe that the design has failed, and that nobody has been deceived by it, I say, speaking for myself, that the burden of proving that rests with the greatest weight on the shoulders of him who asserts that the intended deceit has failed. Those who conceive a design for the purpose of deceiving, and who ask the Courts to hold that the design is innocent, must prove it. * * In the present case, no proof of that sort can be asserted—no reason can be given for that concatenation of lies which the box carries on the face of it; and therefore I have come to the conclusion that the business, which the Plaintiff has been carrying on with these boxes, is a fraudulent business.

RE NORMAL COMPANY'S TRADE MARK.

[C. A., February, 1887. 35 Ch. D. 231; 56 L. J. Ch. 513; 56 L. T. 246; 35 W. R. 464; 4 R. P. C. 123.]

Trade Mark—Refusal by Comptroller to register—No appeal to Board of Trade—Jurisdiction—Act of 1883, ss. 62, sub-s. 4, 77, 90.

The *Normal Company*, having applied to register the word "Normal" as a trade mark, the Comptroller refused to register it. The Applicants did not appeal from this refusal to the Board of Trade, but served a notice of motion on the Comptroller to proceed with the registration, under section 90 of the Act. On the motion coming on, the preliminary objection was taken on behalf of the Comptroller, that the Court had no jurisdiction to entertain the motion, and that the Applicants' only course was to appeal to the Board of Trade under section 62, sub-sect. 4 of the Act.

CHITTY, J., held that the preliminary objection was good, and that the motion must be refused with costs.

CHITTY, J.—With regard to trade marks, which are undoubtedly, I think, viewed by this Act of Parliament, and apart from the Act of Parliament may be said, to be a class of property of a very valuable description, the view which I gather solely from the Act of Parliament appears to be this: There may be questions with regard to trade marks first coming on the register of such a character that they can be well disposed of by the [Comptroller and the Board of Trade]; but the Board of Trade is a great department of State, and it is fit to entrust these powers to the Board

35 Ch. D.
235.
3 R. P. C.
273, l. 54.

who, in the exercise of their discretion, and knowing their limited powers, bearing in mind that they cannot administer the oath, bearing in mind the non-publicity of their proceedings, will in the exercise of their discretion refer to the Court all cases of difficulty and complexity. Section 77, which relates to the effect of registration, is also material, and, if I am right in my view of the Act on this point, the result is that a person who, I will assume, is entitled to be, but by some error has not been, put on the register by the Comptroller, or by the Board of Trade, loses his right, because it is useless to have a trade mark which you cannot protect in the case of infringement. As to old trade marks, however, a distinction is drawn, and where there has been a refusal there is the right to institute proceedings to prevent an infringement, or to recover damages for infringement on production only of course of the certificate of refusal. So that the validity of the old trade marks is not dependent on the non-registration.

Appeal to C. A. (Cotton, Lindley, and Lopes, L.JJ.). Appeal dismissed with costs.

4 R. P. C.
125, l. 42.
35 Ch. D.
241.

COTTON, L.J.—In section 5 of the Act of 1875, there was a distinct and specific reference to the case of the Registrar refusing to enter a trade mark, and it is in these terms. (His Lordship read the section *supra*, p. 2.) There being no other provision with reference to appeal from the decision of the Registrar, it was held under that section that any person applying unsuccessfully to the Registrar might come to the Court, if he was so advised. It will be seen that it is not the same in the present Act.

His Lordship compared the Act of 1875, sect. 5, with the Act of 1883, sect. 90, and continued:—There is a special provision in this Act, with reference to a refusal by the Comptroller, who is substituted for the Registrar, to register a trade mark.

4 R. P. C.
126, l. 30.

His Lordship dealt with the Act of 1883, sect. 62, and said:—I myself value the right of appeal, and hold that it should be as extensive as possible; but where there is, as here, a special procedure laid down by an Act, and a special mode of remedying any defect of the judgment of the first person to whom the matter is brought, by reference to a department of State, I think that it would be wrong to say that there was any appeal to this Court. Although therefore “aggrieved” in the previous Act did point to anyone who said that without sufficient reason the Registrar had refused his application, it could hardly be said where the Comptroller under the present Act had done the same thing, and the unsuccessful Applicant who has a right to appeal to the Board of

Trade, has not exercised that right of appeal, that the Applicant's name was without sufficient cause omitted from the register.

Then there is this to be considered : by sect. 62 (sub-sect. 5) a power is given to the Board of Trade to refer the matter to the Court. It is said that it is most unreasonable to suppose that this is the only remedy given to any one whose application has been refused. The question may very often depend, it is said and rightly said, on questions of law and questions of fact, and it is not to be supposed that the Board of Trade would be a tribunal selected by Parliament for the decision of a point of law, and that that tribunal could effectually deal with questions of fact. In my opinion this Act shews that very large powers were intended to be committed both to the Comptroller and to the Board of Trade. There is a mode prescribed of applying for registration, and thus to get the benefits which follow registration ; and an entirely new body is selected, by whom that registration is to be controlled and effected, and it is not at all unreasonable to suppose that this was the way, and the only way, in which questions as to the right of registration were to be decided, when there is the power given to the Board of Trade to refer any questions which arise to the Court. It is wrong, I think, to suppose that an important department of State would exercise a discretion given to it in an unreasonable way. It appears that they never have done so. I do not mean at all to suggest, that in all cases it would be the duty of the department to refer the question to the Court. They may come without hesitation to the conclusion that an existing decision, either of this Court or of the H. L., has decided the matter, and if they came to that conclusion, then they would probably say, and would be right in saying, "This has been already decided." If there was a reasonable question which they did not feel themselves competent to deal with, then no doubt they would exercise their discretion under the special power given them by sending the matter to a Court of Law.

LINDLEY, L.J.—It appears to me that sect. 90 presupposes the mark on the register and applies where any person comes to the Court for a rectification of the register, and it does not apply to such a case as we are now dealing with, a case in which it is for the Comptroller, subject to the superior control of the Board of Trade, to determine whether a particular trade mark is, or is not, to be registered. This is met by section 62, and not, according to my judgment, by section 90 at all.

35 Ch. D.
242.
4 R. P. C.
126, l. 42.

4 R. P. C.
128, l. 44.
35 Ch. D.
246.

NUTHALL v. VINING.

[C. A., January, 1880. 28 W. R. 330.]

Trade Mark—Colour—Act of 1875.

This was an appeal by the Plaintiffs from a decision of Bacon, V.-C.

The Appellants were cigar merchants and were registered under the Act of 1875 as owners of a certain trade mark for cigars.

The Respondents used a label which the Appellants contended was an imitation of theirs.

The Court (Jessel, M.R., Baggallay and Cotton, L.JJ.) dismissed the appeal on the merits, and in the course of the judgment said that, inasmuch as on account of practical difficulties colour could not be registered as part of a trade mark, the Court could not under any circumstances take similarity of colour into consideration in deciding a question of piracy, but that the Plaintiff must prove his case from a comparison of the uncoloured (*i.e.* black and white) diagrams.

OAKEY v. DALTON.

[June, 1887. 4 R. P. C. 313 ; 35 Ch. D. 700 ; 57 L. T. 18 ; 35 W. R. 709.]

Trade Mark—Death of Plaintiff before trial—Actio personalis moritur cum personâ.

Action for infringement of trade mark. The Statement of Claim raised the usual issues and asked for the usual relief. After delivery of the Statement of Claim the Plaintiff died. The point of law was raised by the Defendants whether the Plaintiff's executors could carry on the action, and was set down for hearing under R. S. C. 1883, Order xxv., rule 2.

4 R. P. C.
315, l. 41.

CHITTY, J., decided in favour of the Plaintiff's executors.—The Statement of Claim shews an injury to the personal estate of the deceased Plaintiff, and it shews sufficiently to my mind (about this I entertain no doubt) that the Defendant has been infringing the trade mark which is property; that is to say, there has been injury to the property of the deceased man, and the Statement of Claim shews that there is damage. If that be so, damage has been caused to the personal estate of the deceased which has diminished the amount of the assets. I also think that it is sufficiently shewn (although there is no distinct allegation about profits) that the Defendant had made profits, which profits he seeks to retain. * * * I think the case is covered entirely by principle, the principle

on which I proceed being, that there is an injury to the personal estate of a deceased person, and damages have been occasioned to that person's estate, and profits have accrued to the wrongdoer.

RE ORR-EWING & COMPANY'S TRADE MARKS.

[February, 1880. 28 W. R. 412.]

Trade Mark—Act of 1875, s. 6—*T. M. R.* 1876, rr. 19, 42 (*infra*, p. 390)—
Registrar's Costs.

Motion.

Messrs *Orr-Ewing & Co.* having applied to register marks similar to the marks under consideration in *Orr-Ewing v. The Registrar of Trade Marks* (*infra*, p. 254), the Registrar refused registration without the leave of the Court.

HALL, V.-C., held that the Registrar must be paid his costs of the motion for leave.

ORR-EWING v. JOHNSTON.

[H. L., March, 1882. 7 A. C. 219 ; 51 L. J. Ch. 797 ; 46 L. T. 216 ;
30 W. R. 417.]

Trade Mark—Name acquired in market.

Action to restrain imitation of trade mark.

The Plaintiffs had for many years prior to 1875 manufactured and exported to Bombay and Aden (between which place and Bombay there is a close connection) Turkey-red yarn and twist, in connection with which they used a label or ticket in the shape of a right-angled triangle with the base uppermost and the apex pointing downwards. This ticket was glazed, the ground of it being green. Under the middle of the base was a golden crown. On each side of the crown was a golden elephant with its head turned away from the crown, and suspended from the two elephants was a golden banner which nearly filled the space between the crown and the apex of the triangle. On the banner were printed the words "Prime Turkey Red," in old English letters, the name of the Plaintiffs' firm in Guzerathi characters, and the word "Levenbank" in old English letters. The yarn was sold through the Plaintiffs' agents at Bombay and Aden to native dealers, with whom it had acquired a great reputation. There being no other trade mark in use, either at Bombay or Aden or (so far as appeared by the evidence) anywhere else, having the essential and distinguishing characteristics relied on by the Plaintiffs, the Plaintiffs' yarn became known among native customers as "bhé hathi" (Guzerathi for "two elephants") yarn,

or Grahams' (the Plaintiffs' Bombay agents) "bhé hathi" yarn, or "sooneri (golden) bhé hathi" yarn.

The Defendants were general merchants trading to India. In 1875 they commenced to export to Bombay and Aden Turkey-red yarn in which they had not previously dealt, and to use in connection therewith a ticket* of a similar shape and colour to the Plaintiffs' two-elephant ticket (that being the shape and colour commonly used in the trade), and also having two golden elephants and a golden banner upon it. This ticket differed in several respects from the Plaintiffs' ticket. In the centre, in place of the crown was the "Gunputty" (an Indian goddess, sitting crosslegged, with an elephant's trunk) printed in gold. On each side of the "Gunputty" was an elephant. The elephants had their heads turned towards the "Gunputty," and each elephant had a howdah on his back with a man in it, whereas the Plaintiffs' elephants had nothing on their backs. The Defendants' banner (like the Plaintiffs') nearly filled the space between the "Gunputty" and the apex of the triangle, though it was of a somewhat different shape, because the "Gunputty" was larger than the Plaintiffs' crown. On the banner were printed these words, in ordinary English letters, "Prime Turkey Red. R. Johnston & Co., London."

The figure "Gunputty" had been long used by the Defendants as their trade mark on goods exported to Bombay. The account given by them of the adoption of the ticket complained of was as follows:—In 1875 they received for the first time an order for Turkey-red yarn from a customer of the Plaintiffs, who referred to the Plaintiffs' ticket and said he required that some sort of ticket should be used, and they accordingly inquired about the ordinary character of the label used for such goods. Ultimately they cut out a triangular piece of white paper, in the middle of which they pasted their figure of "Gunputty," and wrote the name of their firm underneath. This they took to an engraver (who happened to be the Plaintiffs' engraver, though of this the Defendants said they were unaware), with general directions to put in some animals and to make a suitable ticket, and he sketched in the elephants and banner, and the ticket was eventually engraved by another firm of engravers in that form. The ticket was first used by the Defendants in *May*, 1875. On the 29th *November*, 1875, the Plaintiffs' solicitor wrote to the Defendants' solicitor threatening legal proceedings unless an undertaking was given within three days not to use the ticket.

* This ticket was referred to in the case as B.

The action commenced in *May*, 1877. No case of deception was actually proved.

FRY, J., at the trial granted an injunction. Appeal to the C. A. (James, Baggallay, and Cotton, L.JJ.). Appeal dismissed.

JAMES, L.J.—What could have been the only motive which can be suggested to a man of the world by a man of the world of the Defendants in doing [what they have], but to do something which was likely to be mistaken for the Plaintiffs' goods, which would be accepted by the customers of the man who had been in the habit of selling them as being a continuation of the same goods which he had been in the habit of supplying to them? It is not necessary for this case to decide that a man actually intended to tell a lie, or that a lie has been told. It is sufficient, in the language of Lord KINGSDOWN, that a man should wilfully use a part of the trade mark of his neighbour, that part so used being by the user of it calculated to enable his goods to be passed off for the goods of his neighbour. I am of opinion, independently of the mass of evidence which has been given in support of that probability, that it was probable, and probable almost to a certainty, that the new ticket of the Defendants would tend to enable anybody so minded to represent those goods as being goods of the same character, proceeding from the same manufacturers, as the goods which had been formerly accepted with confidence under the mark which was a guarantee of the Plaintiffs' goods. It was calculated to do so. Beyond that, supposing that by some accident a man had inadvertently used a ticket which was so calculated to deceive the ultimate purchaser, and therefore so calculated to injure the Plaintiffs in their legitimate right of property in a trade mark, the moment the attention of the Defendants or any persons in their position was called to the fact of the similarity of the two marks, and to the complaint of the persons who owned the first mark that it was likely to injure them, it was their duty to immediately discontinue the use of the trade mark complained of; and, however honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is itself sufficient evidence of a fraudulent intention. The fraud would then consist in continuing to do it even if there had been an original inadvertence in the use of it.

Appeal to the H. L. (Lords Selborne, Blackburn, and Watson). Appeal dismissed with costs.

Lord SELBORNE.—Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other,

13 Ch. D.
453.

7 A. C.
225.

it might easily happen that they might both be taken by natives of Aden or of India unable to read and understand the English language, as equally symbolical of the Plaintiffs' goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that these were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the Plaintiffs' trade mark themselves for reasons of their own; especially as it was a common practice in those markets for the same traders (the Plaintiffs among others), to affix to their inner packages, sometimes one form of mark, and sometimes another, for reasons more material to themselves than to the ultimate consumer. In the *Glenfield Starch* case, *Wotherspoon v. Currie*, L. R. 5 H. L. 508, the difference between the two labels was very obvious to the eye, even upon the most cursory inspection: and they were both intended for markets where the English language (in which they were throughout written) was understood. But the use of the characteristic word "Glenfield" was enough for the purposes of deception; and here the use of two elephants in the upper corners, with an inscribed cloth or banner depending between them, was in my judgment enough for the same purpose. It is true that deception in fact is not in this case proved; but there is a large body of trustworthy evidence to the effect that such deception would be liable, and very likely, to occur, at all events with the more ignorant class of consumers, particularly in the up-country districts; and with this evidence my own judgment concurs. Nor am I able to conceive any satisfactory explanation, under all the circumstances of this case, of the adoption by the Defendants of that particular device—two elephants at the upper corners of the ticket with a cloth or banner suspended between them—knowing as they did the Plaintiffs' ticket, knowing also the character and circumstances of the markets, and entering as they did upon this particular branch of trade with the direct object of competing with and underselling the Plaintiffs, unless it was because they had a desire and intention to approach to the Plaintiffs' trade mark as nearly as they possibly could. For such desire and intention no motive can be suggested, except that of getting some part of the benefit of the goodwill and reputation of the Plaintiffs' trade.

which was a rightful and *bonâ fide* trade mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. To that proposition I should not myself, as at present advised, be prepared to assent. But the Respondents have agreed to the omission from the injunction granted in this case of the only words* which might possibly have been thought to give countenance to such a proposition; though I do not think they were so intended.

Lord BLACKBURN.—If the Plaintiffs had proved that purchasers had actually been deceived by the use of the mark B and that the Defendants after being told of this had persisted in using this mark B, the Plaintiffs would surely have been entitled to an injunction to prevent the continued use of B; and it could be no answer that the purchasers, so deceived, were incautious; the loss to the Plaintiffs of the custom of an incautious purchaser is as great a damage as the loss of that of a cautious one. But in this case the Plaintiffs judged it necessary to proceed without waiting till actual deceit was proved, and I think they judged rightly, for as JAMES, L.J., said (13 Ch. D. 464) “the very life of a trade-mark depends upon the promptitude with which it is vindicated;” and having done so they have to satisfy the Court that the similarity between the two tickets was such as to be calculated to mislead purchasers; and no doubt in deciding this (which is a question of fact) every difference between the one ticket and the other is to be considered.

As against these Defendants their own conduct is evidence; and I think their own conduct is such as to prove against them that the resemblance was calculated to deceive. The Defendants were quite aware of what was the Plaintiffs’ trade mark and what was the view of it taken by the Eastern buyers. They were sending out yarns which they had never dealt in before, for the express purpose of competing with the Plaintiffs, and that they had a perfect right to do; and they had a right to try to persuade the native buyers that their goods, which were cheaper than the Plaintiffs’, were as good or better than the Plaintiffs’; but they had no right to do anything which might lead buyers to think their goods were the Plaintiffs’, so as to get the benefit of the

* I.e., the words “and from employing any mark or words which would be calculated to cause any Turkey-red yarn not dyed by the Plaintiffs to be known in Bombay as Bhé hathi or Do hathi yarn.”

7 A. C.
229.

7 A. C.
230.

Plaintiffs' reputation. Why, then, did they come so near the Plaintiffs' ticket? Why use the two elephants at all unless in the hope that incautious purchasers might mistake one ticket for the other? The Defendants were both called as witnesses, and had every opportunity given them to explain this, and neither could give any answer. Their Counsel argued that the Plaintiffs had no monopoly of elephants, and that their clients had a right to use them. So they had, unless they used them so as to mislead or at least be likely to mislead purchasers as to whose the goods were. And they complained that to use this as evidence of an intention to mislead, and what I think is more the true question, as evidence of what the effect of the similarity was likely to be, was to rely on topics of prejudice; and that the differences between the two tickets were so great that the Defendants could not intend to mislead. I think that the difference was so great that the Defendants hoped that no Court would say that the use of the elephants could mislead. In that they have been mistaken. I certainly think that as against these Defendants this is very strong evidence, and I do not think any hardship is inflicted on honest traders by holding that if they do not take pains when making a new trade mark to make it quite unlike an established one, they do so at the peril of making evidence against themselves. I wish expressly to say "evidence," for I do not think it is a proposition of law.

ORR-EWING v. THE REGISTRAR OF TRADE MARKS.

[H. L., July, 1879. 4 A. C. 479; 48 L. J. Ch. 707; 41 L. T. 239; 28 W. R. 17.]

Trade Mark—Committee of experts—Supervision of the Court—Act of 1875, ss. 1, 5, 10—Act of 1876—T. M. R. 1876, rr. 57 to 63 (infra, pp. 391, 392.)

In 1877, *Messrs. Orr-Ewing & Co.* applied to register in respect of cotton goods (*viz.*, Turkey-red yarns) certain trade marks which had been used by them for several years before 1875. These marks consisted of triangular green labels or tickets, each bearing an inscription upon a curtain, with combinations of a crown and elephant, a demi-lion and elephants, a crown and lions, and a demi-lion and lions. The device in each case was in gold, and the animals formed the supporters of the curtain. The Committee of experts at Manchester placed the marks in the second class as being not entitled to registration, on the ground that the shape and style and principal component parts of the marks were in

common use in the trade, though the exact combinations were only used by the Applicants. The Registrar consequently refused registration. ^{4 A. C. 483.}

Orr-Ewing & Co. moved in the Chancery Division (see Seb. Dig. 586) for a declaration that the marks were true trade marks within the Trade Marks Registration Acts, and for a direction to the Registrar to proceed with the registration.

HALL, V.-C., granted the motion, on the ground that each of the tickets looked at as a whole was distinguishable from the other tickets in use.

Appeal to the C. A. (James, Baggallay, and Bramwell, L.JJ.). Order of HALL, V.-C., discharged on the ground that the Committee of experts were constituted by the Trade Marks Registration Acts and Rules a tribunal to decide as to the validity or invalidity of cotton marks, that their decision should not be reversed except on proof that they had proceeded on some wrong principle or in some improper manner, and that in the case in question this was not established.

Appeal to the H. L. (Lords Cairns, Hatherley, O'Hagan, Blackburn, and Gordon). Appeal allowed and order made declaring that, notwithstanding that the tickets had been placed by the Committee in the second class of cotton marks, the Registrar ought to proceed with the application to register.

Lord CAIRNS, L.C., referred to T. M. R. 1876, rr. 57 to 63 (*infra*, pp. 391, 392), and said:—The C. A. appears to have considered that the effect of these Rules was to constitute the Committee at Manchester a tribunal of commerce, or of experts, to decide whether marks were or were not within the meaning of the Act, and to make it the duty of the Court not to interfere with their decision unless it is satisfied they proceeded upon some wrong principle, or in some improper manner.

My Lords, I cannot think that this is the effect or intention of the rule. The Rules appear to me to provide a rough but useful way of separating, by means of the technical knowledge and judgment of the Committee, the cotton trade marks into two classes. The first class is to consist of those marks which the Committee is of opinion are trade marks within the Act, and proprietors in this class are to have the benefit, arising from this opinion, of being able at once to apply to be registered in respect of those marks. But in doing this they must satisfy the Registrar that they are the proprietors and comply with the conditions of registration as any other Applicants would do. With regard to the second class

there is no decision pronounced against them, but the proprietors cannot apply for registration as a matter of course. They must come to the Court, and it must be for the Court to say whether the Registrar shall proceed on their application to register or not. In deciding this the Court will have before it the circumstance that the opinion of the Committee was adverse to the claim of a trade mark; but this would be an opinion only, and not a decision, arrived at after hearing both sides, or rendered in any judicial proceeding.

4 A. C.
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The triangular shape of the tickets, their green colour, the printing on the green in gold-leaf, the curtain suspended from two animals in the corners, and the words "Prime Turkey Red," are all matters which are shewn by the evidence * * to have been in common use in respect of goods of this kind by many houses in the trade for a great number of years.

Putting aside these particulars, it remains to be seen whether there is anything farther on the labels which will constitute a trade mark as defined by the Act; and I may pause here, my Lords, for the purpose of observing that I cannot think HALL, V.-C. sufficiently appreciated the object and the provisions of the Act of Parliament, when he said that he considered that, in each case, a device or label, registration of which is applied for, must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels, it should be registered. To some extent, no doubt, this is true, but I apprehend the first duty cast upon the Court is to ascertain whether some one, or more than one, of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it.

4 A. C.
485.

His Lordship referred to the figures of certain animals appearing on the tickets and said :—*Primâ facie* these figures, which I have thus described, would appear to me, with the name and address of the firm added, to constitute in each case a distinctive device, within the meaning of the Act, and thus to be a trade mark authorized to be registered under the Act.

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486.

Whether the Appellants can establish their right to be registered as the proprietors of these marks, is another question. For the purpose of establishing their right, the usual process, by advertisement and otherwise, will have to be gone through before the Registrar, and it is possible that in the course of that process

other persons may appear and contest, upon materials not now before your Lordships, the right of the Appellants.

Lord BLACKBURN.—Before 1875 it had, I think, been established, that when a person had used a mark on his goods so as to distinguish them from the goods of any other person, he had a property in that mark to such an extent as to entitle him to an injunction to prevent any other person from continuing to use on other goods, a mark so similar to his mark as in fact to mislead the public into taking them for those of the person who owned the mark; and that this was on the ground that the right to use the mark was his property, so that it was not necessary for the purpose of prevention to prove fraud or an intention to mislead. I think that, at least from the time of *Millington v. Fox* (3 My. & Cr. 338), decided by Lord Chancellor COTTENHAM in 1838, to *Wotherspoon v. Currie* (L. R. 5 H. L. 508), decided by this House in 1872, it has been considered that, for the purpose of prevention of infringement, the exclusive right to use a trade mark was a right of property. 4 A. C.
494.

The mark must have been so used as to have come to be known to designate the goods of the Plaintiff, and it could not do so unless it was to some extent special and distinctive; but it was a question in each case on the evidence, whether it had come to be so known or not; and frequently it was a question on the evidence, whether, having once been so known, the owner of it had permitted it to be so extensively used by others, that it had ceased to be so known; and, as might be expected, there was much litigation, sometimes no doubt arising from improper attempts on the part of the Plaintiff to have a monopoly of the manufacture of goods of a particular kind, but more frequently from improper attempts on the part of the Defendants to obtain the benefit of the Plaintiff's reputation for skill and honesty, by using his trade mark or one like it. In providing a remedy for this inconvenience, there was obviously much more difficulty in dealing with existing trade marks, in which there was a vested right of property, than in dealing with new trade marks as to which no one as yet had a vested right. According to the usual course of legislation in this country, vested rights of property are to be respected, and not interfered with farther than is necessary; but as to rights to be acquired hereafter, it is merely a question of expediency what conditions the Legislature may think fit to attach to the acquiring of those rights. The Act of 1875 seems to have been framed in conformity with these principles.

I cannot construe [section 5 of the Act of 1875], as meaning any- 4 A. C.
497

thing else than that, when the Court of Chancery is satisfied that the Applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within the definition of sect. 10 of the Act of 1875, the Court is, *ex debito justitiæ*, to rectify the register, just as it would, before the Act of 1875, have been bound, *ex debito justitiæ*, on similar proof, to prevent any one infringing the trade mark shewn to be his property. The burden of proof lies upon the person making the application to amend the register; but if he does produce such proof as would, in the opinion of the Court, entitle him to an injunction, I do not think that the words "if satisfied of the justice of the case" can, or ought to be, construed as meaning, to give the Court a discretion to consider whether the nature of the trade mark is such as to make it inconvenient that he should exercise the right of property, which it is proved he actually has.

The 1st section of the Act, as it then stood, took away all right to proceed for an injunction unless the trade mark was registered, but, apparently, left the right to sue for damages unaffected. This afforded an additional reason for construing the 5th section as I have done, but by no means the only one.

Then came the Act of 1876. * * * This alters the Act of 1875 in two respects: it renders registration a condition precedent to a proceeding to recover damages, as well as to a proceeding to prevent infringement; and it provides that if the proprietor of a trade mark in use before the passing of the principal Act, has been refused registration, he may, notwithstanding such refusal, institute proceedings either for prevention of or for damages for the infringement of such trade mark, and need not wait till he has got the register rectified.

But does this alter the construction of sect. 5, or take away his right to have the register rectified, if sect. 5 gave him such a right? JAMES, L.J., seems to think it does. I am unable to come to that conclusion. It seems to me that the effect of the Act of 1876 is that if one who says he is the proprietor of a trade mark wishes to institute proceedings against some one who, as he says, is infringing it, he must first try to have his trade mark registered. If the registration is refused, for any reason, he may apply under sect. 5 to have the register rectified, and then the Court will have to determine as the principal question whether the reason of the refusal was sufficient. But he may also seek for more speedy redress. He may obtain a certificate of the refusal, and then institute proceed-

ings to prevent the infringement, and then the Court will have to determine whether he was the proprietor of the trade mark, and in doing so, will have incidentally to determine whether the reason of the refusal was sufficient; for I take it that he cannot obtain an injunction, unless he proves, to the satisfaction of the Court, that the alleged trade mark was "a special and distinctive word or words, or combination of figures or letters, used as a trade mark before the passing of the Act," and that "he was for the time being entitled to the exclusive use of such trade mark in accordance with law." And if he proves that, he is entitled to have the register rectified.

No rule that I can find gives power to the Committee to call 4 A. C. 500.
upon the Applicant to support his claim, or gives an Applicant a right to be heard before the Committee; and I think, from the nature of the body, it could never have been intended that it should hear the parties, or come to anything in the nature of a judicial determination. It is reasonable to say, if selected persons, who presumably know a great deal of the usages of the cotton trade, are of opinion that a mark is or is not distinctive, that shall, *prima facie*, be taken to be right. The Registrar shall act on that opinion, but the party aggrieved by it may appeal to the Court.

The order of the H. L. was subsequently made an order of the High Court (28 W. R. 412).

RE PAINE'S 'TRADE MARK.

[March, 1892. 9 R. P. C. 130; 61 L. J. Ch. 365; 66 L. T. 642.]

Trade Mark—Fancy word—Act of 1883, s. 64, sub.-s. 1 (c)—Acts of 1883 to 1888, s. 64, sub-s. 1 (c).

Motion to expunge a trade mark consisting of the words "John Bull Brand" registered in 1885 as a new mark for beer. Mark expunged.

KEKEWICH, J., referred to *Re Van Duzer's Trade Mark* (*infra*, p. 334) and said:—Here the words are "John Bull Brand." Now 9 R. P. C. 133, l. 1.
I put aside "Brand" altogether. What does "John Bull" mean? I think I am entitled to consider it as applied to beer.

Here everyone knows what "John Bull" is. I refer to the Century Dictionary, where the word is construed and given its plain meaning. "John Bull": the first meaning of it is an Englishman, but also the English collectively, and the explanation is that it is used with reference to the "coarse burly form and bluff nature ascribed to the typical Englishman." Without going further, you

at once have some description or designation of the article, either that it is made in England, or that its character is that which suits Englishmen. If it is to be sold abroad, probably the inference would be that it is beer which has been brought from England, and is what the English like, and is offered to the appetites of foreigners for that reason. If it is sold in England, it is at least possible to infer, from the trade mark itself, that it is intended to be some potent liquor which would recommend itself to John Bull, the typical Englishman. But I have not to consider whether it must do that, but whether it must not do that. That is the test [of COTTON, L.J.], "which obviously cannot have any reference to any description or designation." Therefore, on that ground, it seems to me that, with these decisions before me,—and there are others besides *Van Duzer's* which I have taken as particularly apposite—I cannot hold that it is a "fancy word."

9 R. P. C.
133, l. 43.

[Counsel for the Respondents] falls back on the word "brand," and he refers to the case of *Pirie & Son* (*infra*, p. 275), and he referred also to an interlocutory observation of BOWEN, L.J., which is not to be found in the Law Reports, but is in the Reports of Patent Cases, in which BOWEN, L.J., pointed out that the mark there in question was not registered as a brand. I confess myself unable to see how a mark could be registered as a brand. I do not see in the Trade Marks Journal any means of distinguishing between a brand and anything else, and the section does not point to it. It is a "distinctive device, mark, brand, heading, label, or ticket." * * It is the trade mark which is to be registered. But apart from that, this does not pretend to be registered as a brand, or to be used as a brand, for this reason. What is registered is the "John Bull Brand." It is not "John Bull" used as a brand, but the "John Bull Brand."

9 R. P. C.
134, l. 7.

Without going further into the meaning of the word "brand," or discussing further why it should have been introduced into this section of the Act of 1883, or retained in the Act of 1888, I think that is a complete answer to the Respondents' argument.

9 R. P. C.
134, l. 27.

Referring to the Act of 1883, sect. 64, sub-sect. 1 (c) as amended by the Act of 1888, his Lordship said:—Instead of "a fancy word or words," you have "an invented word or invented words." It would take more courage than the learned Counsel before me possess to say that "John Bull" are invented words whether with reference to beer or anything else. Then comes (e) "a word or words having no reference to the character or quality of the goods, and not being a geographical name." I am by no means sure that

it is not a geographical name, but I will not consider that. "John Bull" is not the name of a country, but the title of the people who inhabit the country, and perhaps that may not be strictly geographical. But I have already stated my opinion that it has, at any rate, a possible reference to both the character and quality of the goods; and as at present advised, if I were asked to strike it out under the Act of 1888, instead of under the Act of 1883, I should do so just as much as I do now under the former of those two Acts.

RE PALMER'S APPLICATION AND TRADE MARK.

[C. A., May, 1882; June, 1883. 21 Ch. D. 47; 24 Ch. D. 504; 51 L. J. Ch. 673; 46 L. T. 787; 50 L. T. 30; 32 W. R. 306.]

Trade Mark—Cancelling—Lapse of five years—"Special and distinctive"—User—Act of 1875, ss. 3, 5—10.

Application to cancel registration.

In 1876, *J. B. Palmer & Son* registered the words "Braided Fixed Stars" as an old trade mark for matches. When the mark had been five years on the register, *Bryant & May* applied to cancel the registration on the ground that the words ought never to have been registered as a trade mark.

CHITTY, J., refused the application, on the ground that even if the 3rd section of the Act of 1875 did not make the lapse of five years conclusive evidence that the alleged trade mark was a proper trade mark (which *seem* it did), it at all events excluded evidence to shew that words which *prima facie* appeared to be fancy words, and proper to constitute a trade mark, were not capable of constituting one.

Appeal to the C. A. (Jessel, M.R., Cotton and Lindley, L.JJ.).
Appeal allowed.

JESSEL, M.R.—The case must of course depend upon the wording of the Act. The application is under the 5th section. Now it is a well established rule, that in construing Acts of Parliament, as well as other instruments in writing, you are to take the literal construction, unless it is controlled by the context, or is so manifestly absurd that it cannot be the true construction. The words of sect. 5 are too plain for argument. 21 Ch. D. 56.

If there were no other sections, there being no limit as to time expressed in the 5th section, there would be nothing to argue, for this application would be clearly authorized. 21 Ch. D. 57.

But the contention on the part of the Respondents, which succeeded before CHITTY, J., was, that the 3rd section contained a

limitation as to time. Now of course, if one section of an Act of Parliament gives a remedy, and another section says that the application must be made within a certain number of years, the two sections must be read together, and the application cannot be made after the expiration of that time, but where the power is given generally without limit, the subsequent section cannot confine the application to a particular period, unless clear expressions to that effect are used. It is clear that the 3rd section does not expressly say that the application under the 5th section shall not be made after five years, but the Respondents contend that the words which I am about to read impliedly have that effect. (His Lordship read the 3rd section and continued :—) Now what is the meaning of the words, “the registration of a person as first proprietor of a trade mark”? Does it mean his registration as proprietor of “a mark,” or does it mean what it says, his registration as proprietor of “a trade mark”? I think the literal reading is to be preferred. It is true that the Registrar ought not to enter anything which is not capable of being a trade mark, but he may be deceived, and that is alleged to be the case here.

21 Ch. D.
58.

It comes to this, supposing the Registrar to be deceived into registering that as a trade mark which is not a trade mark at all, can it have been intended to give the person who gets it placed on the register, a right to enjoy that as a trade mark which never was a trade mark? I think not, and, indeed, so far from the reason of the thing being against the literal reading, it appears to me to be in favour of it. * * * Consider what a hardship it will be on the trade if we accede to the contention of the Respondents. A man who sells his goods, and affixes thereto a device that is a real trade mark, is bound to go and look at the register, and see if anybody else is proprietor of that device, and if he does not, he must take the consequences. But if he sells his goods under their proper description, he will never dream that anybody has registered that description as a trade mark, and he would actually be led into a liability to an action at the suit of a person who was so improperly registered, though no reasonable precaution could have enabled him to discover the existence of such liability. To take an instance so extreme as to be absurd, but which still it is well to take. Suppose a man going into the soap trade, and determining to sell palm oil soap under the name of “palm oil soap.” He would never dream of going to the register to see whether anybody has registered the words “palm oil soap” as a trade mark, he would be selling his goods

under their proper description as palm oil soap, and suddenly somebody comes down against him and says, "I registered those words five years ago as a trade mark. I therefore change by the force of the Act of Parliament those words which are ordinary words of description into a trade mark, and now I am entitled to restrain you from using them." If this were to be allowed, it would be allowing a man who had taken an improper advantage of the ignorance of the Registrar, and of the Commissioners if it came before them, as to the use of the technical terms of the trade, to lay a trap for an honest tradesman who had done nothing but sell his goods under their proper description.

LINDLEY, L.J.—After careful examination of sects. 3, 5, and 10, of the Trade Marks Registration Act, 1875, I am satisfied that a mark which is not a trade mark, and which therefore ought never to have been registered, does not become a trade mark by being on the register for five years. 21 Ch. D. 60.

The case was accordingly remitted to Chitty, J., that it might be decided on the evidence whether the words "Braided Fixed Stars" were capable of being registered as a trade mark.

It was found that in 1869 the term "Fixed Stars" was known in the trade as denoting a particular class of fusees the heads of which did not fall off when ignited; that in that year *Palmer & Co.* bought a patent for enveloping the stems of fusees with wire, and introduced the term "Braided Fixed Stars;" that the patent expired in 1881; that *Palmer & Co.* had not before the Act used the words "Braided Fixed Stars" separately as a trade mark or otherwise than as a part of a composite label, which they also registered as an old mark in 1876.

CHITTY, J., refused the application.

Appeal to the C. A. (Baggallay, Cotton, and Lindley, L.JJ.). Appeal allowed. Registration expunged.

BAGGALLAY, L.J.—In the first instance it has been contended that, assuming the separate label "Braided Fixed Stars" not to have been used as a trade mark before the Act came into operation, yet that the words "Braided Fixed Stars" appeared in two several portions of this label or envelope, and that there was a sufficient user of those particular words to entitle them to be registered as a trade mark. * * * We are thus driven back to this question: Are these words "Braided Fixed Stars" special and distinctive words, or a combination of letters used as a trade mark before the passing of the Act? In my opinion they are not. It will perhaps be well for me to say at once that even if evidence 24 Ch. D. 515.

had been given of the user of the specific trade mark limited to "Braided Fixed Stars," I should be of the same opinion.

24 Ch. D. 516. His Lordship discussed the evidence, especially as to the term "Fixed Stars," and continued :—The word "braided" was used merely to denote that those were fixed stars made with stems braided in the manner pointed out in the letters patent. I do not think that the combination of the word "braided" with the two words "fixed stars" forms a special and distinctive combination sufficient to bring the case within the intent and meaning of the 4th sub-section of the 10th section of the Act. It is obvious that nobody else could make braided fixed stars so long as the patent continued, and if by reason of the patentee using a word descriptive of the nature of his patent for the purpose of describing his article, he can acquire a title to the exclusive use of that name afterwards, it would simply be enabling him by a perversion of the Registration of Trade Marks Act, to give an indefinite extension to the monopoly acquired by him under the patent.

24 Ch. D. 518. CORTON, L.J.—The Act does not allow words alone as distinguished from the name or the signature of any individual to be used as a trade mark, unless they have been used as one before the Act. What we have to consider is whether this condition has been fulfilled, whether these words were used as a trade mark before the passing of the Act. I have come to the conclusion that what is required is not that it shall be shewn that together with a certain device words have been used which may have been an important part of the trade mark made up of the device and the words, but that the words have by themselves been used as a trade mark. That I think must be so, because under the previous part of the section "a distinctive device, mark, heading, label, or ticket" may be registered under the Act as a new trade mark accompanied with words, but words alone cannot be registered unless it has been shewn that they had been used as a trade mark previously to the Act.

4 Ch. D. 21. LINDLEY, L.J.—It strikes me as plain to demonstration, on the evidence, that this expression "Braided Fixed Stars" meant a patented article which was indeed made by Messrs. *Palmer & Son*, but that it was not intended to denote Messrs. *Palmer & Son* as distinct from other makers. * * *

I do not mean to say that a manufacturer of a patented article cannot have a trade mark not descriptive of the patented article, so as to be entitled to the exclusive use of that mark after the patent has expired ; for instance, if he impressed on the patented

articles a griffin, or some other device ; but if his only trade mark is a word or set of words descriptive of the patented article of which he is the only maker, it appears to me to be impossible for him ever to make out as a matter of fact that this mark denotes him as the maker as distinguished from other makers.

RE THE PATENT PLUMBAGO CRUCIBLE COMPANY'S TRADE MARKS.

[March, 1890. 7 R. P. C. 282.]

Trade Mark—*Alteration of name of proprietor*—Act of 1883, s. 90.

A firm carrying on business as the *Patent, &c. Company*, registered two trade marks in the name of the *Patent, &c. Company*. The firm (without in any way changing its constitution) subsequently changed its name to the *Morgan Crucible Company*. The Comptroller refused an application to register the marks in the name of the *Morgan, &c. Company*, stating that the alteration could only be made through the Court.

A motion was accordingly made under the Act of 1883, sect. 90.

STIRLING, J., directed the Comptroller to insert the following entry on the register :—"The Morgan, &c. Company, formerly trading as the Patent, &c. Company."

RE PERRY DAVIS' TRADE MARK;

PERRY DAVIS *v.* HARBORD.

[H. L., July, 1890. 7 R. P. C. 336 ; 15 A. C. 316 ; 60 L. J. Ch. 16 ; 63 L. T. 389.]

Trade Mark—*User*—"Special and distinctive"—Act of 1875, s. 10.

IN 1877, *Perry Davis & Son* registered as an old trade mark the words "Pain Killer" in respect of a medicine which was known as "Perry Davis' Vegetable Pain Killer." It appeared that on the bottles in which the medicine was sold, the words "Davis' Vegetable Pain Killer" were stamped, and that in no case were the words "Pain Killer" used except in combination with other words or matter.

In 1887, *Perry Davis & Son* commenced an action for infringement against *Harbord*, who thereupon moved to expunge their mark.

KAY, J. (5 R. P. C. 333), granted the application, on the ground that the words, even if special and distinctive (*quod quære*), had

not been used as a trade mark according to the rule laid down in *Re Palmer's Trade Mark* (*supra*, p. 261), and *Re Leonard & Ellis' Trade Mark* (*supra*, p. 205).

Appeal to the C. A. (Cotton, Fry, and Lopes, LJJ.).

Decision of KAY, J., affirmed for the reasons given by him. FRY, and LOPES, LJJ., were also of opinion that the words were not special and distinctive.

5 R. P. C.
340, l. 55.

FRY, L.J.—There remains the inquiry, whether these words are “special and distinctive.” Now I adhere entirely to what has been said already on that point. LINDLEY, L.J., in the case of *Wood's Trade Mark* (*infra*, p. 349), said that “distinctive” must mean some mark which distinguishes the goods to which it is attached, as those made or sold by the person who uses the mark. It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods. It is not necessary to inquire into that point, but in my judgment it has not been shewn in this case that the words “Pain Killer” can be special or distinctive. I think they have neither been shewn to have been used as a trade mark, nor to be special and distinctive. I say that I cannot in my judgment consider them to be shewn to be special and distinctive for this reason, that it is not shewn that anybody else has ever made a “Pain Killer” or sold anything of the same description. How then can words used to describe the thing be held to distinguish the thing as made by one person from the thing as made by another?

5 R. P. C.
341, l. 32.

LOPES, L.J.—It is unnecessary to determine in this case whether the word need be inherently special and distinctive, though, speaking for myself, I should be inclined to think that it must be inherently special and distinctive. But at any rate the authorities are clear to shew that it must be a word distinguishing the article manufactured by one person from a similar article manufactured by another person, and not a word that is merely descriptive of the article itself.

Appeal to the H. L. (Lord Halsbury, L.C., and Lords Herschell, Macnaghten, and Morris), who affirmed KAY, J.'s decision for the reasons given by him. Lords HALSBURY and MORRIS were also of opinion that the words were not special and distinctive.

7 R. P. C.
339, l. 22.

Lord HALSBURY, L.C.—It appears to me that on the plainest possible principles of construction, the decision arrived at by COTTON, L.J., at all events—I think by the whole Court—in

Palmer's Trade Mark (*supra*, p. 261), affirmed afterwards by Lord SELBORNE in *Leonard & Ellis' Trade Mark* (*supra*, p. 205), was obviously the true construction of that section, namely, that the words must have been used alone (not in combination) as a trade mark, if they were to be registered within that part of the section; otherwise the previous part of the section would be unmeaning and useless. Upon the ordinary principles of construction that has been laid down as being the true view.

My Lords, I am also of opinion that the word "Pain-Killer" is not "distinctive." The word "distinctive" itself requires exposition in this respect; "distinctive" in respect of what? I think it has been held (and I certainly think so myself) that the word "distinctive" means distinguishing a particular person's goods from somebody else's goods—not a quality attributed to the particular article, but distinctive in that respect, that it means that it is a manufacture of his as distinguished from somebody else's. The manufacture may or may not be new, but that is the sort of distinction contemplated by the Statute. 7 R. P. C.
340, l. 21.

Then what is the meaning of the word "Pain-Killer"? It is not necessary to go into the grammatical question of whether it is used adjectively, if there is such a word, or as an adjective, or as an epithet. It is enough to say, simply, that it attributes this particular quality to this particular medicine. It appears to me perfectly clear that that is neither "special" nor "distinctive" within the meaning of the Statute. The result appears to me to be, that upon both parts of the case—the user and the "distinctive" nature of the word, which it is necessary for the Appellants to make out—they have failed.

Lord HERSCHELL.—In the present case, assuming the words to be distinctive, have the Appellants shewn that they were used by them as a trade mark prior to 1875? Now, my Lords, it has been held, or the opinion has been expressed at all events by five learned Judges, that on the true construction of the section, words have not been used as a trade mark, if they have been used either in combination with other words, or in combination with any design—in short, that they must be used alone as the trade mark in order to be used as a trade mark within the meaning of that section. No doubt has been cast upon the opinion so expressed by any learned Judges, and it appears to me to be impossible to doubt that that is the true construction of the section, when one reads the last clause of it in conjunction with those which immediately precede. Well, assuming that to be the true construction, have 7 R. P. C.
341, l. 1.

the Appellants brought themselves within it? Clearly not. They have not used the word "Pain-Killer" alone as their trade mark. The words "trade mark" in that section or "used as a trade mark" appear to me clearly to mean that by which a person marks, identifies, or distinguishes the goods which he manufactures or sells. Now how have the Appellants in this case marked, identified or distinguished their goods? Not merely by putting upon them, the words "Pain Killer," but by putting on them the words "Perry Davis' Vegetable Pain Killer." It seems to me impossible to say that they have used the words "Pain Killer" as their trade mark. That being so, my Lords, it appears to me that the conclusion follows, that they are not within the section, and have no claim to register these words as their trade mark, and that they were properly expunged from the register.

RE PHILLIPS' TRADE MARKS.

[July, 1891. 8 R. P. C. 469 ; (1891) 3 Ch. 139 ; 61 L. J. Ch. 40 ;
65 L. T. 373.]

Trade Mark—User—Act of 1883, s. 92.

Motion for leave to strike out the words "Trade Mark" from two square labels (Nos. 15,792 and 15,793), registered in 1878 as old marks for soap. The following is a description of No. 15,792. On the upper part there were printed in thick type of ordinary character the words "Boaler's soap," the words being arranged in two lines. Under the word "Soap" two straight lines were printed running nearly but not quite across the square, so as apparently to disconnect the upper portion of the label from the lower. The lower part of the label contained the words "Trade Mark" printed immediately over a device consisting of printed lines, some arranged diagonally, others vertically and horizontally. In *February*, 1876, the Applicant had registered as an old mark (No. 2641), for the same class of goods, the device contained in the lower part of No. 15,792, with the words "Trade Mark" above it.

The Applicant filed an affidavit in which he stated (in substance) that his user of the mark No. 15,792, before the 13th of *August*, 1875, was of the whole mark as it now stood on the register, including the words "Trade Mark"; that the words "Trade Mark" were not placed upon the mark for the purpose of indicating that any special part thereof was registered as a trade mark, or that any other part was open for any one else to copy, and that the

word "Boaler" was a word which might be used by any person in the soap trade.

The circumstances with regard to No. 15,793 were practically identical.

The Comptroller opposed the application, which was made in consequence of FRY, L.J.'s observations in *Re The Apollinaris Company's Trade Marks* (*supra*, p. 51).

Application refused.

CHITTY, J., described No. 15,792 and continued:—In regard to the mark 15,792, two things are clear. First, if [the Applicant] claimed it as being an old mark, [he] was bound to register the whole of the mark as used; secondly, from the position of the words "Trade Mark," in reference to the rest of the label, it may be contended by any person attacked as an infringer that the only part claimed as a trade mark is that which stands beneath the words "Trade Mark," namely, the device.

8 R. P. C.
471, l. 20.

His Lordship referred to the Applicant's evidence and said:—

In these circumstances I consider that the Applicant must stand or fall by his mark as now registered, and that I ought not to grant the leave asked, and for the following reasons: First, because the mark being claimed as an old mark ought to be registered just as it was used, and to strike out the words "Trade Mark" would, in the circumstances of the case, be to allow an alteration which, though it may be of a non-essential particular, would be a material alteration. Secondly, because in this old mark as it has stood on the register for upwards of twelve years, there is, to say the least of it, an indication of an intention to claim only the device as the trade mark, and the public, and particularly the traders in soap, are entitled to have the same indication of a restrictive claim, and consequently the same protection retained on the register; and Thirdly, because to allow the words "Trade Mark" to be struck out with a disclaimer (as was suggested by the Applicant's Counsel) of the words "Boaler's Soap" would be for most purposes futile, for the effect would be on a question of right to reduce this trade mark to the same thing identically as the trade mark, No. 2641 of 1876, while it would afford the Applicant the opportunity of practically using the whole of the trade mark 15,792, less the omitted words, without the necessity of stating the disclaimer which would be on the register only. The second of these reasons appears to me to be the most important. My decision is not inconsistent with what KEKEWICH, J., did in *Colman's* case (*supra*, p. 100). The circumstances were different, that decision being on new marks only, and the Attorney-General did not there offer any

8 R. P. C.
471, l. 51

substantial opposition, indeed the order seems to have been practically arranged. My decision is quite consistent with *Guinness's* case (*supra*, p. 139), in which I allowed the addition of the word "limited" to a trade mark which had become the property of the Limited Company. The 92nd section expressly authorises an addition.

PINTO v. BADMAN.

[C. A., February, 1891. 8 R. P. C. 181.]

Trade Mark—Imitation—Comparison—Distinctive label—Assignment in gross—Counterclaim to rectify— Act of 1883, s. 70.

The Plaintiffs were the owners of a trade mark for cigars, consisting of a label containing the Spanish words "El Destino," a fac-simile signature, and various devices. In *October*, 1890, they commenced an action for infringement and for passing off against *Badman Brothers*, who sold cigars under a similar label bearing the words "El Destinacion." The Plaintiffs' title was as follows:—*Garcia*, a Mexican cigar manufacturer, was the first proprietor of the label. He commenced to use the label and to sell cigars as "El Destino" cigars about 1875. His manufactory was also called "El Destino." In 1889, *Garcia* sold the label and the "El Destino" brand to *Rendon*, it being agreed that *Garcia* should retain his manufacturing business, but should not sell cigars under the "El Destino" label or brand. Immediately afterwards *Rendon* sold half the rights acquired by him to the Plaintiffs, who had acted as agents for *Garcia*, and had sold his "El Destino" cigars in England. It was stipulated that any registration of the label and brand should be in the joint names of *Rendon* and the Plaintiffs. In March, 1890, the Plaintiffs (who traded as *Garcia & Co.*) registered the label in the name of *Garcia & Co.*, specifying as essential particulars the words "El Destino," a fac simile signature (*Garcia, Hno. & Co.*), and the combination of devices.

The Defendants denied infringement and passing off. They contended that the Plaintiffs' registration was bad and they counterclaimed for rectification of the register by expunging the Plaintiffs' trade mark. The Defendants adduced evidence to shew that in 1881 one *Sondheim* registered the words "El Destino" as a trade mark for cigars, and subsequently sold the mark to his son and one *Windward*, who carried on business in partnership till 1886; that *Windward* then carried on business alone some time longer, and in *March*, 1890, consented alone to the mark

being expunged, though by the terms of the dissolution of his partnership with *Sondheim*, the mark was to be sold. The Defendants submitted on this, (1) that the registration by the Plaintiffs was not in the proper name; (2) that *Sondheim's* registration was improperly expunged, no notice having been given to *Sondheim* the son; (3) that the Plaintiffs' essential particulars had not been taken; (4) that "El Destino" was not capable of registration, as it described the character of the goods (viz., that they were Spanish), and was geographical (as it was the name of the factory).

The jury found that the Plaintiffs' trade mark was imitated, and that the Defendants fraudulently passed off cigars not being the Plaintiffs' as the Plaintiffs'.

DAY, J., on these findings gave judgment for the Plaintiffs on the claim and counterclaim, overruling the Defendants' objections. The Defendants moved before the C. A. for a new trial. They raised the points taken before DAY, J., and also contended that the assignment of the trade mark to the Plaintiffs was bad as being an assignment in gross.

The C. A. (Lord Esher, M.R., Bowen and Fry, L.JJ.) on this last ground directed judgment to be entered for the Defendants.

LORD ESHER, M.R.—The way to have really tried the case, with due regard to the time of the Court and of the public, would have been for the Defendants to have said: We dispute the Plaintiffs' title; we will give in evidence the grounds of it, which are certain Spanish deeds; that is a question we will ask the Judge to reserve and consider afterwards; but we will try the questions which are for the jury before the jury. Those questions were tried before the jury, and those questions really were, whether, assuming the Plaintiffs to have the exclusive right, the Defendants had committed a breach of that right—that is to say, whether their label which they use was nothing but an imitation of the Plaintiffs' label. There was evidence given that it was an imitation; but the strongest evidence, in my opinion, always is in these cases, whether for the jury or the Judge—if a Judge is trying the case by himself for him, or if he is trying it with a jury for the jury—to put the two labels into the hands of sensible men and say: Is the one, not identical with the other, but is it so like it that you must come to the conclusion that it is nothing but a mere imitation calculated to deceive? That is the strongest evidence. You may call evidence of people in the trade to say what their opinion is; but, after all, the tribunal which has to decide it generally decides it upon a view. Certainly the view is

8 R. P. C.
189, l. 37.

part of the evidence, and anybody, to my mind, looking at these two labels, that is the label registered by the Plaintiffs and the label used by the Defendants, could not fail but to see that the one is a mere imitation of the other, with some slight variations, no doubt, but when they are not seen side by side nobody would recollect the differences between them; they would take the Defendants' for the Plaintiffs'. Therefore, when it is said there was no evidence to justify the findings of the jury, it seems to me the evidence was conclusive in favour of the Plaintiffs upon those points that were tried.

8 R. P. C.
190, l. 44.

Then the Defendants took some extraordinary technical grounds. They said the Plaintiff was one of two partners, or one of a set of Plaintiffs, and he had sued in his own name alone, and had not joined the other. Of course, it is very late in the day to take such a point as this. Under the Judicature Act, if you want more Plaintiffs you can ask to have them joined, and the Defendants could have got them joined, but it is no ground of objection that all the Plaintiffs are not joined.

Then it was suggested that upon the Counterclaim the Defendants could ask to have the register rectified to the extent of striking out the Plaintiffs' registration, or to strike out part of it, and that that could be done by way of Counterclaim. The answer to that was given during the argument, that the right of rectifying the register is a new right given by Statute, and in that Statute the mode and manner of doing it is prescribed also. That being so, it being a new right given, and with a remedy for a breach of that right given in that same Statute, it is well-known law that that is the only remedy which is given, and therefore no such claim, as that now put forward to rectify the register in an action like this, can be put forward by means of a Counterclaim.

Then we were taken to the registration of the Plaintiffs and a consideration of their label, and it was said that the registration was bad because the words "El Destino" were written upon the face of it. It was also said that "El Destino" was a known name—was a known word—and that you can only put on a label something which is unknown. That was not confined to words, but it was said you cannot put on a label anything which is known before. As I pointed out, that is preposterous, because unless you put something new—something more dreadful than that monster that stands outside these courts—the griffin—you must put on something that is known. The truth is that the label does not consist of each particular part of it, but consists of the combination of them all.

Then the Defendants said that these words "El Destino" were

a description of the nature and quality of the cigars. That again was shewn to be an impossible thing. I should have thought that the nature and quality of the cigars meant whether they were good or bad or strong or feeble—I am not sure that “German” or “French” would not do, because they are horribly bad generally speaking; but to say that “El Destino,” whatever it means in English, is a description of the quality of the cigars is another of those far-fetched things which we have heard in this case.

Then it was said that “El Destino” was a geographical expression, and the learned Counsel wanted to give us, as I said, a dissertation upon geography. “El Destino” a geographical expression! You might as well say that “my grandmother” is a geographical expression. Therefore, all the points, as I say, which were laboured for hours were all hopeless points, and why anybody should go into a mass of hopeless points when they have a really good point under their hands, which they could bring forward in an hour and a half, I never can understand.

His Lordship then criticised the Spanish deed by which *Rendon* derived title from *Garcia* and said:—

In my opinion, when we have fairly got at the effect of the Spanish deed, all [*Garcia*] sold was [his] right * * to use the label or trade mark which [he] had used. * * Therefore all [he] sold was the trade mark. [He] sold no part of [his] business of which the trade mark was an indication. [He] retained and kept the right to carry on [his] business just precisely as [he] had before, and even to import into England the very same cigars [he] had always imported.

8 R. P. C.
191, l. 47.

Now, on the question as to whether [*Garcia*] might sell the trade mark in that way in Mexico, I am inclined to assume that [he] might. What rights that would confer in Mexico I do not know. [He] having sold that right, when it comes to be exercised in England for the purpose of and by means of registration, the question, whether when that is shewn, [the purchaser] can rely on that registration to give [him] the exclusive right in England, is a matter of English law; and, inasmuch as there was nothing sold but the right to the trade mark, I come to the conclusion that the law of England does not allow the purchaser of such a right, when he purchases the right only, to register that trade mark (the right to register which, as between himself and the seller, has passed to him,) * * so as to obtain, by virtue of the Trade Marks Act, the right to the exclusive use of the mark as against the public or as against any individual member of the public.

8 R. P. C.
192, l. 9.

I think that accords with what is laid down distinctly by the learned Lords who gave the judgments in *The Leather Cloth Company v. The American Leather Cloth Company* (11 H. L. C. 523).

8 R. P. C.
194, l. 3.

FRY, L.J.—By the English law can a trader, who has used a brand upon a particular article, and who continues to manufacture that article, alienate that brand to another person, so as to give that alienee any right whatever? It appears to me that, upon first principles, he can have no such right. The brand is an indication of origin, and if you transfer the indication of origin, without transferring the origin itself, you are transferring a right, if any right at all, to commit a fraud upon the public, and such right is not recognised by the law of England. I confess that seems to me to be the whole principle of the case.

His Lordship referred to the *Leather Cloth Company v. The American Leather Cloth Company*, and said :—

8 R. P. C.
194, l. 52.

It follows, therefore, that it has been laid down by the clearest authority that a trade mark can be assigned when it is transferred together with, to use Lord CRANWORTH'S language, "the manufacture of the goods in which the mark has been used to be affixed." Beyond that, so far as my knowledge goes, and so far as any case that has been cited to us at the Bar is concerned, no authority can be produced. Therefore, I conceive that that is the limit of the assignability of a trade mark. It can be assigned, if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor.

Now another indication that that is the law is to be found in this, that both the Statutes of 1875 and 1883 have regulated the right of transfer after registration, and in both cases they have confined it to assignment or transfer with the goodwill of the business in the article in respect of which the trade mark is registered. It is obvious that the Legislature in so enacting are intending to confine the right of assigning the trade mark after registration within the same limits by which it is confined at law and in equity before registration. Therefore, there can be no doubt, to my mind, that before and after registration a trade mark cannot be assigned independently of the manufacture of the goods to which it relates. It never can be assigned in any way which will enable the transferee to represent something different to that which it represented in the hands of the transferor.

PIRIE v. GOODALL.

RE PIRIE'S TRADE MARK.

[C. A., November, 1891. 9 R. P. C. 17; (1892) 1 Ch. 35; 61 L. J. Ch. 79; 65 L. T. 640; 40 W. R. 81.]

Trade Mark—"Brand"—Act of 1883, ss. 64, subss. 1 (c), 2, 3, and 74.

Action for infringement and motion to expunge.

In 1885 *Alexander Pirie & Sons* registered the words "*Pirie's* Parchment Bank" as a new trade mark for paper and envelopes, the words being printed one over the other, together with the following disclaimer:—"The Applicants do not claim any right to the exclusive use of either the word 'Parchment' or the word 'Bank' appearing in connection with this mark." The Defendants in an action for infringement moved to expunge the mark.

VAUGHAN WILLIAMS, J., ordered the mark to be expunged. Appeal to the C. A. (Lindley, Bowen and Fry, LJJ.)

It was suggested in the argument that the Plaintiffs' trade mark was a distinctive brand.

BOWEN, L.J.—Your mark is not registered as a brand.

9 R. P. C.
19, l. 7.

Appeal dismissed with costs.

LINDLEY, L.J., read the disclaimer and said:—It may mean, and I will assume that it does mean, what Counsel contends it means, that [Messrs. *Pirie*] do not claim the exclusive use of either of these words separate—that is, put quite separately. They have not put that in, but I will assume that it means that. If it does mean that, then the matter must be a little further considered. I will assume that it does mean that, and that that disclaimer entitles them to say that although they have disclaimed the right to the exclusive use of either the word "Parchment" or the word "Bank" separately, they can still claim the use of these words in combination either together or with the word "*Pirie's*" or without the word "*Pirie's*."

9 R. P. C.
20, l. 9.

His Lordship, after pointing out that "*Pirie's*" was neither the name of a firm nor an individual, continued:—[Counsel] says it is a brand, and he says a brand may be a brand within the meaning of this clause although it consists, and only consists, of a combination of words. In fact, he says, a brand need not be something burnt into something else, nor impressed upon something else, as is the case with metal goods. He says that a brand may be something woven into the texture of paper, such as a water mark, or so incorporated into the substance of the thing as not to be upon it or annexed to it, and, perhaps, "brand" may be used

9 R. P. C.
20, l. 38.

in that large sense. I am not sure of that. Personally, I confess I do not know what doubt existed which led to the introduction of the word "brand" into the Act of 1883. The word "brand" was not in the previous Act of 1875. Probably some doubt suggested itself to somebody and it was thought that it would be useful to put the word "brand" in. I do not see myself, even, now why "mark" does not include "brand." A brand is a particular kind of mark, and the doubt may have been whether anything burnt into or forming part of the thing would come within this definition.

9 R. P. C.
20, l. 55.

Now let us see what the real meaning of this section is; whether it means, now that the word "brand" is in, something different from what it meant before that word was used—so different, I mean, as to give this clause a construction totally different from that which has ever been put upon it before.

9 R. P. C.
21, l. 8.

His Lordship read the Act of 1883, sect. 64, subsect. 1 (c) (*supra*, p. 9), and said:—Now omitting for a moment the word "brand," that section has been construed in several cases, of which *Re Stephens* (*infra*, p. 321), *Leonard v. Ellis* (*supra*, p. 205), and *The Great Tower Street Tea Company v. Smith* (*supra*, p. 134), are the leading ones. It has been construed in this way, which I think is obviously the right way; and it is more plainly the right way the more you consider the section. It may consist of a distinctive device, mark, heading, brand, label, or ticket, but if you are going to use words as your trade mark, the words must be "fancy word or words not in common use." Now that that is the true construction follows not only, I think, from the cases to which I referred, but is made tolerably plain by the sub-clauses 2 and 3.

9 R. P. C.
21, l. 23.

His Lordship read them and the proviso, and continued:—So that when you are dealing with words you may register two things under this Act of Parliament. You may use either fancy words not in common use, or you may use words or combinations of words if they be used as a trade mark before *August*, 1875, and the only other mode of using words at all is under the clause I have just read—"words or combinations of words added to any of the foregoing particulars." If you go on to sect. 74, I think that construction to which I have alluded comes—I do not say more plainly, but as plainly. Sect. 74 is confined to what may be used as an addition to any trade mark, and you may add as an addition to any trade mark "any distinctive, &c." (His Lordship read the section (*supra*, p. 11), and said:—) Now, it appears to me, that it would be utterly ludicrous to say that the words

"distinctive device, mark, heading, label, ticket" cannot consist of words unless they are fancy words, or unless they have been used before 1875, and yet say that "brand" lets in things which the other words do not let in. What is the difference between a mark and a brand? On what conceivable theory can we say that a brand can consist of words of which a mark cannot? It appears to me to be almost a *reductio ad absurdum*.

RE PRICE'S PATENT CANDLE COMPANY.

[July, 1884. 27 Ch. D. 681; 54 L. J. Ch. 210; 51 L. T. 653.]

Trade Mark—Label—Fancy words not in common use—Act of 1883, ss. 64, subs. 1 (c), 72.

In 1884 *Price's Patent Candle Company* applied to register as a new mark for candles, a label got up in the ordinary conventional manner with the name and address of the Company and the words "National Sperm" printed thereon.

In 1881 *Pepler & Co.* had registered for candles a trade mark which the Comptroller considered so like the Applicants' proposed mark as to be calculated to deceive. He accordingly refused the application.

The Comptroller's decision was confirmed by PEARSON, J. It was admitted that "National Sperm" were words in common use.

PEARSON, J.—I have a mark which does not contain either of the particulars which are essential to a trade mark under this Act, because it does not contain the name of the Company printed in a distinctive manner, and it does not contain any fancy word or words which are not in common use. [It is said] at all events this is a distinctive label or distinctive ticket. I very much doubt whether this is a distinctive label or ticket; and, certainly, unless I had something very strong to show that it was so distinctive from other labels purely from the colours in which it is printed, and from the design of it, I am not prepared to hold that this is what is intended under this Act to be a distinctive label or device. I do not say those words are not hard to construe, because I think they are. I should conceive that in a label of this kind, the name of the firm being printed in common letters, would not be a distinctive label. The intention seems to me, not that it is to be a design in this shape, but a design practically to constitute a trade mark apart from the words "Price's Patent Candle Company," and so forth, and "National Sperm." * * * You might have the label alone as a trade mark,

27 Ch. D.
686.

if it was a distinctive trade mark absolutely unlike all other labels; but what the Comptroller is here asked to register is not the label, but the label with all manner of words on it which do not conform to the regulations under the Act. Then the 72nd section is no doubt very important. * * * I am of opinion that the Comptroller would be perfectly justified in saying, and it would be the course which he ought to adopt, "Inasmuch as there is already a trade mark on the register either the same as, or nearly identical with, the one you are proposing to register, I cannot register yours until you have got the opinion of the Court authorizing me so to do."

RE RALPH'S TRADE MARK.

RALPH *v.* TAYLOR.

[November, 1883. 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. 504;
32 W. R. 168.]

Trade Mark—Person aggrieved—Act of 1875—T. M. R. 1876, r. 33.

In 1886 *F. W. Ralph* purchased the patent of a machine called the "Home washer," and in 1876 he registered the words "Home washer" as a trade mark for the machine. During the continuance of the patent (which expired in *February*, 1882), *Ralph* never manufactured the machine himself but merely received royalties from his licensees. From 1877 to 1882 the Defendants in the above action were his sole licensees. Between the date of the expiration of the patent and the commencement of the action (a period of 21 months) *Ralph* had not himself or by any agent manufactured the machine, being confined to his house by illness.

In 1883 *Ralph* commenced an action, and moved against the Defendants (who had continued to sell "Home washers") to restrain infringement of his trade mark. The Defendants thereupon moved to expunge the trade mark. The two motions came on together. *Ralph's* trade mark was expunged, and his motion refused.

25 Ch. D.
198.

PEARSON, J.—This application is made under the 33rd clause of the revised rules, which is in these words, "The Court may on the application of any person aggrieved remove any trade mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods, within the same class as the goods with respect to which a trade mark is registered." * * I can hardly conceive any person who could

be described as aggrieved, if persons against whom an injunction is sought for the use of that which they say ought not to be on the register, are not persons aggrieved. It seems to me they come completely within the category, and that therefore they are persons who are entitled to make this application to the Court. The only other question is this,—whether or not Mr. *Ralph* comes within the 33rd rule ? * * Really the only question I have to determine is whether one year and nine months is sufficient cesser on the part of Mr. *Ralph* to shew that he comes within the 33rd rule, and is not a person engaged in any business concerning the goods within the same class as the goods with respect to which this trade mark is registered. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The Legislature in that has shewn by its enactment when a business is supposed to be carried on, and what amount of cesser shews that the business is not being carried on.

RANSOME v. GRAHAM.

[April, 1882. 51 L. J. Ch. 897 ; 47 L. T. 218.]

Trade Mark—Pattern mark—Patent—Act of 1875.

Action to restrain infringement. Motion to rectify.

The Plaintiffs had for many years made and sold large numbers of ploughs and wearing parts of ploughs (*e.g.* shares) ; and in order to distinguish the various makes, patterns, and sizes, they stamped both the frames of the ploughs and the different wearing parts with letters or combinations of letters and numerals (*e.g.* R.N., R.N.B., R.N.I.). The effect of this, as the Plaintiffs alleged, was that a purchaser of one of their ploughs, requiring a new wearing part, could, by buying the same stamped with the same letters, &c., as his original plough, be certain of obtaining, *first* an article of the Plaintiffs' manufacture, and, *secondly*, one which would accurately fit his plough. The Plaintiffs registered seventeen of these combinations of letters, &c., under the Act of 1875 as old marks.

The shares, which were made in accordance with a patent taken out by a former partner in the Plaintiffs' firm in 1803 (which patent had expired in 1817), were also stamped with the word "patent."

Injunction granted. Motion refused.

51 L. J.
Ch. 900.

BACON, V.-C.—The law relating to trade marks has been established by decisions extending over centuries, and although its application has been somewhat modified by the recent Statutes relating to trade marks, and thereby adapted more conveniently to modern usages, the law has undergone no change in its essential principle. That principle may be stated thus:—a manufacturer who produces an article of merchandise which he announces as one of public utility, and who places upon it a mark, by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is thenceforth called his trade mark.

By the law of this country, and the like law prevails in most other civilised countries, he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners.

51 L. J.
Ch. 901.

The marks in question, as well upon what may be called the frames or bodies of the ploughs, as upon the several parts which, when combined together, form the entire working practical plough, were originally impressed by the Plaintiffs for the purpose of characterising the entire ploughs as articles manufactured by them, and in order that such articles might be known in the trade and by persons who might buy them as being made by the Plaintiffs, and the marks are, therefore, properly described as trade marks. Farmers and other persons buying ploughs and parts of ploughs are in the habit of ordering them by the letters and marks which constitute the trade marks, and purchasers would be misled and deceived, if having so ordered and expecting to receive them, they were to be furnished with ploughs or parts of ploughs made by any other persons than the Plaintiffs. It is wholly disproved by the Plaintiffs' evidence that the marks on the parts of ploughs are meant only to designate the patterns of the ploughs to which such parts may apply or be designed to fit.

51 L. J.
Ch. 902.

Performing * * the function of a jury, I have come to the conclusion and I find that the Plaintiffs' marks * * have always been and are their trade marks, and in every sense their property.

51 L. J.
Ch. 903.

The Defendants insist that the Plaintiffs have fraudulently stamped the word "patent" on their ploughs, and they refer to

cases well known and of unquestionable authority in which it has been decided that the fraudulent use of the word "patent" will disentitle the person using it to relief which he might otherwise obtain. In my opinion none of these cases nor the principles on which they are founded have any application to the present case.

* * [The Plaintiffs] make their shares according to the invention in [the] expired patent, as everybody else may; but to suggest that they have in any manner claimed anything under or in respect of that patent, and that they have done this fraudulently and to deceive the public, is merely desperate, and opposed to the truth of the case.

READ v. RICHARDSON.

[C. A., April, 1881. 45 L. T. 54.]

Trade Mark—Trade name—Interlocutory injunction.

Motion.

The Plaintiffs and the Defendants were bottlers of beer for export. The Plaintiffs' label consisted of a bull-dog's head on a black ground surrounded by a circular band, on which were the words "Read Brothers, London. The Bull Dog Bottling." The Defendants' label (which had been adopted by them only a few months before the commencement of the action), represented a rough terrier's head on a black ground, surrounded by a red circular band, on which were the words "Celebrated Terrier Bottling, E. Richardson." The Plaintiffs' beer was well known in the Colonies as the "Dog's Head" beer, and they alleged that the export by the Defendants to certain Colonies of beer with the terrier's head label led to their beer being substituted and taken for the Plaintiffs' beer.

Both the Plaintiffs and the Defendants had registered their labels as trade marks. The Plaintiffs had, however, used their label, with the words "specially registered trade mark" after application, but before registration.

It was admitted that the Defendants' trade was not dependent upon the use of the terrier's head. The Plaintiffs commenced an action for infringement and passing off, and moved for an interlocutory injunction.

JESSEL, M.R., refused the motion.

Appeal to the C. A. (James, Brett and Cotton, L.JJ.). Appeal allowed.

JAMES, L.J.—What we have to consider is the balance of in-
convenience and convenience in dealing with the thing in the

45 L. T.
57.

meantime, before it is heard. If the Plaintiffs should happen to be right at the hearing, and we should, in the meantime, upon this interlocutory application, confirm the view of the M.R., that the Plaintiffs are not entitled to an interlocutory injunction, the injury [to them would be irremediable and incalculable. Their particular trade mark, their particular reputation in the meantime would be utterly destroyed.

45 L. T.
58.

Upon the balance of convenience and inconvenience, it seems to me better that the Defendants should abstain from doing that which is a novelty, and that they should not, during the litigation, interfere with the names the Plaintiffs say they have got. There is one other point; it is said there is something not strictly true in the Plaintiffs' labels: that is to say, that there was something which was not strictly true in the Plaintiffs' labels at the time when they first used them, by reason of which use it is that the name or description grew into existence. Whether that is an objection or not, and to what extent that would prevail, and what are the circumstances under which that designation was used in the interval between the application to register and the actual registration, are matters which I think will keep very well for the hearing of the cause. We need not discuss them now. It does not seem to me a sufficient reason for not granting the interlocutory injunction at present.

45 L. T.
58.

BRETT, L.J.—The Defendants say that the Plaintiffs have prevented themselves from using the process of the Court, by the fact, which the Plaintiffs seem to admit, that the Plaintiffs' label had been used in its present form before the actual registration of it under the Trade Marks Act. Whether that, at the hearing or upon further consideration, will be considered to be such a misconduct as to disentitle the Plaintiffs to the relief asked for by them, I cannot say. To my mind it is not at all satisfactory to suppose that it would be held to be such misconduct, and certainly the M.R. did not enter upon that point.

45 L. T.
59.

COTTON, L.J.—The only point which caused me any doubt about this case, is the alleged misstatement in the Plaintiffs' label by using the name "Special registered trade mark" before the actual registration of the trade mark. That, no doubt, is a matter upon which there may be some argument. We do not decide it finally here, but, as far as my present opinion goes, there is not sufficient shewn as regards the use of that (which possibly was used when it was incorrect), to disentitle the Plaintiffs from coming for the relief which they asked. They do not seek to

protect that label but the name which they have acquired by the use of that label. It is the name which is protected; and as far as the cases have hitherto gone, they decide simply that when a man comes to protect a label with anything like a misstatement upon it, the Court will not interfere. If we thought that *prima facie* that destroyed the right of the Plaintiffs, of course we ought not to grant an injunction. But all we know about it is that they had carried in an application to register this trade mark, and before they got their certificate of registration—I do not know for how long, or under what circumstances—they did use this label, with these words “Special registered trade mark.” In my opinion that does not make it such a *prima facie* case against the Plaintiffs as would prevent us from interfering for their protection.

The injunction (which is given *in extenso*, 45 L. T. p. 60, Sebastian, p. 511), restrained the Defendants from using the figure of a dog’s head upon any label, &c.

REDDAWAY & COMPANY v. BENTHAM HEMP SPINNING COMPANY.

[C. A., July, 1892. 9 R. P. C. 503; (1892) 2 Q. B. 639; 67 L. T. 301.]

Common Law Trade Mark—Passing-off—Evidence to go to jury.

Motion for new trial.

The Plaintiffs had for many years made and sold belting for machinery, which they called “Reddaway’s Camel Hair Belting,” but they had not registered any trade mark. The Defendants made and sold similar belting, which, up to 1890, they called “Bentham’s Hair Belting,” but in that year began to call “The Bentham Camel Hair Belting.” An action having been brought by the Plaintiffs to restrain the Defendants from (in effect) infringing their unregistered trade mark, and for damages, the Plaintiffs gave evidence that their belting (which was made of a material called in the trade “Camel tops” and composed of cotton, goat’s hair, and sheep’s wool, with a small quantity of camel’s hair added,) and no other belting, was known to the trade as “Camel Hair Belting,” but they offered no evidence to prove that the Defendants had ever sold their belting as the Plaintiffs’ belting, or that any person had bought the Defendants’ belting upon the supposition that it was made by the Plaintiffs. CAVE, J., at the trial at Manchester, stopped the case without hearing evidence for the De-

fendants, and the jury by his direction gave a verdict for the Defendants.

The C. A. (Lindley and Lopes, LJJ., *dissentiente* Smith, L.J.) ordered a new trial.

9 R. P. C.
506, l. 8.

LINDLEY, L.J.—This is an action brought by the Plaintiffs against the Defendants for infringing what may be called a common law trade mark of the Plaintiffs. It is not a registered trade mark.

9 R. P. C.
506, l. 45.

His Lordship then stated, that there was in his opinion a case to go to the jury and continued :—The reasons for my opinion are these :—The first question is, what does “Camel Hair Belting” denote ? If it denotes belting made only by the Plaintiffs, the Defendants have no right to sell their belting by the same name, unless they take sufficient precaution to prevent buyers from being misled. But if the expression “Camel Hair Belting” denotes a particular kind of belting, which any one may make, then any one, who makes that kind of belting, may sell it by the name by which it is known in the trade. In the case now supposed, the name will have become *publici juris*, although it may originally not have been so.

9 R. P. C.
507, l. 32.

His Lordship referred to *Singer Manufacturing Company v. Loog* (*infra*, p. 306), and to *Ford v. Foster*, (L. R. 7 Ch. App. 611, 628), and continued :—It is true that the Defendants call their belting “Bentham’s” and that the Plaintiffs call theirs “Reddaway’s”; but in commerce these words are soon dropped; ordinary purchasers do not know of them; and if it be true that “Camel Hair Belting” denotes belting made by the Plaintiffs, then belting made by the Defendants will soon be known by the same short name, and may then be easily mistaken for the belting made by the Plaintiffs. CAVE, J., gave judgment for the Defendants on the ground that the Plaintiffs had not proved any instance in which a purchaser had been misled. If this action had been an action for damages only, CAVE, J., would perhaps have been right. * * * But I am convinced that the learned Judge had not present to his mind the equitable doctrine established by Lord COTTENHAM in *Millington v. Fox*, (3 Myl. & Cr., 352), and recognised and acted on by the H. L. in *Orr-Ewing v. Johnston* (*supra*, p. 249). To obtain an injunction in a case like the present, it is not necessary to prove an intention to mislead, nor to prove that any one, in fact, has been misled. All that need be proved is that the Defendants’ goods are so marked, made up, or described by him as to be calculated to mislead ordinary pur-

chasers, and to lead them to mistake the Defendants goods, for the goods of the Plaintiffs. The fact that no proof can be given, that any one has been misled, will be some evidence to show that no one is likely to be misled. But the absence of such proof is by no means conclusive; much must depend on the time the Defendants have been carrying on their business in the way complained of. I cannot say that there was no evidence on which a jury could properly find against the Defendants on this question of likelihood to mislead, if such a question had been left to them. The catch-words are "Camel Hair Belting," and as in the *Glenfield Starch* case, *Wotherspoon v. Currie*, (L. R. 5 H. L. 508), so in this, the use of the catch-words alone may establish the Plaintiffs' right to relief. The Plaintiffs have no right to the exclusive use of these words, but they have a right to restrain any one from so using them as to pass his goods off as the goods of the Plaintiffs. There ought, in my opinion, to be a new trial; and two questions at least should be left to the jury, namely: 1st. What does "Camel Hair Belting" mean? Does it mean belting made by the Plaintiffs, as distinguished from belting made by other manufacturers, or does it mean belting of a particular kind without reference to any particular maker? 2nd, If it has the first of these meanings, then the next question will be, do the Defendants so describe their belting as to be likely to mislead purchasers, and to lead them to buy the Defendants' belting as or for the belting of the Plaintiffs? The second question, if answered in the affirmative, would entitle the Plaintiffs to an injunction without proof of any intent to deceive.

REINHARDT v. SPALDING.

[December, 1879. 28 W. R. 300; 49 L. J. Ch. 57.]

Trade Mark—"Distinctive words"—*Act of 1875*, s. 10.

Action for infringement and passing off.

The Plaintiffs had for 15 years sold a medical preparation under the name of "Family Salve," which words they had registered as an old trade mark under the Act of 1875. It was proved that the Plaintiffs' preparation had a reputation in the market, and had been continually supplied by them under and in wrappers bearing the name "Family Salve" or "Reinhardt's Celebrated Family Salve."

The Defendant sold a similar preparation under the title of

"Spalding's Universal Family Salve," which title had been registered by him at Stationers' Hall in 1868.

At the trial, HALL, V.-C., granted an injunction.

28 W. R.
300.

HALL, V.-C.—[The Plaintiffs] have been registered as the first proprietors of the trade mark ; and that being so, they are by the Statute *prima facie* the owners of, or have the right to the exclusive use of, this trade mark.

28 W. R.
301.

I do not mean that the word "Family" combined with every substantive would be distinctive. It is not necessary for me to say that ; but I do say, as regards this particular thing, "Family Salve" is that which would be ordinarily distinctive, and might well be considered as describing, distinguishing, or denoting a particular article of commercial use sold in the market. These are general observations.

His Lordship discussed the evidence, and said :—[That] clearly proves that the Plaintiffs, or their predecessors in title, were the possessors and proprietors of a trade mark—that is, the trade mark in question—and the article was sold as, and known by the name of "Family Salve" * * * Nor is it material to the case, that in using this name [the Plaintiffs] have used it combined with their own name and the word "Celebrated." They have put their own name before it, and called it "Reinhardt's Celebrated Family Salve," but that does not make any difference.

Nor, on the other hand, is it any answer for the Defendant to say, in reply to the complaint made against him by the Plaintiffs, that he combines with the words "Family Salve" the words "Spalding's Universal." In my opinion these words are not material, as regards either Plaintiffs or Defendant.

RE REISS' TRADE MARK.

[April, 1888. 5 R. P. C. 291.]

Trade Mark—Alteration—Essential particular—Act of 1883, s. 92.

In 1879 *Reiss Brothers* (of Manchester) registered for cotton piece goods, a combination trade mark (No. 19314), consisting of a crown, two horses, the words "Grass Bleach—Best Quality" in a circular garter, and, at the foot of the mark, the name and address "Reiss Brothers, Manchester." In 1888, "Grass Bleach," being a style of bleach no longer in use, *Reiss Brothers* applied to the Court, under sect. 92 of the Act of 1883, for leave to alter their trade mark by substituting the word "Reiss" for "Grass."

It appeared there were other marks on the register for cotton goods in which the name of *Reiss & Co.* (of Batavia) appeared. These later marks were all combination marks, the component parts being quite distinct from those of mark 19314, and the address of the Batavian firm of *Reiss & Co.* appearing thereon as well as their name.

NORTH, J., made the order asked.

RICHARDS v. BUTCHER.

[C. A., May, 1891. 8 R. P. C. 249; (1891) 2 Ch. 522; 60 L. J. Ch. 530.]

Trade Mark—User—Old Mark—Act of 1875, s. 10.

Motion to expunge.

In 1882 *Heidsieck & Co.* registered, as old marks for wine, the words "Monopole" and "Dry Monopole." On an action for infringement being commenced by *Heidsieck & Co.*'s successors against the Defendants, the latter launched a motion to expunge these two trade marks. The user of the marks by *Heidsieck & Co.* before 1875 was proved to be as follows:—(a) user upon two kinds of labels (both of which labels were also registered as old marks), containing the words "Monopole" or "Dry Monopole" at the top and the name and address of *Heidsieck & Co.* and certain other letterpress underneath; (b) user upon corks, "Monopole" or "Dry Monopole" being branded upon the side, and a device of a comet and the words "*Heidsieck & Co., Reims,*" being branded at the bottom of the corks; (c) user on paper wrappers, on which were printed "Monopole" or "Dry Monopole" in one line, "*Heidsieck & Co.*" in the next line, and "Reims" in the third line; (d) user on packing cases, "Monopole" or "Dry Monopole" being stencilled upon one side of each case, and *Heidsieck & Co.* and the device of an anchor being stencilled upon other sides.

The words "Monopole" and "Dry Monopole" had been registered as trade marks in France.

KAY, J. (8 R. P. C. 37), ordered the two marks to be expunged.

Appeal to the C. A. (Lord Esher, M.R., Fry and Lopes, L.JJ.). Appeal dismissed.

Lord ESHER, M.R.—I will take first the one word "Monopole." 8 R. P. C. 254, l. 4C.
Whether that word was used as a trade mark before 1875 does not depend upon whether it was registered as a trade mark in 1876. I do not think that the registration of it is of any importance except as evidence. It may be used as evidence of what was used before,

but it is not otherwise material whether it was registered or not. The question is whether the word was used as a trade mark. Now, observe, it is not simply whether the word was used by *Heidsieck & Co.*; it is whether it was used as a trade mark. That must be a question of fact. Now, the Plaintiffs say "It was used as a trade mark." The answer is, "It was never used as a trade mark; it was used joined with some other words as a trade mark, or joined with something else as a trade mark, but it was never used alone as a trade mark." Now, what constitutes the use of anything as a trade mark? Not the mere using of it, but the using of it in a particular way and with a particular result. You use it as a trade mark, if you have used it in business, or, as is often said, on the market as a mark to denote your goods, and to distinguish your goods from anybody else's. Therefore you use it, not merely as a writing; you use it as a mark, and as a mark in the market, and you must shew that you used it in the market for the purpose of distinguishing your goods; and I think you must shew that the market accepted it as a distinguishing mark of your goods—then you used it as a trade mark.

8 R. P. C.
255, l. 14.

Now what is the evidence? When you find that they put all the words on the label on their wine, or on their bottles, if you please, what is the true inference, and what is the truth? I think then you must use the same reasoning as I ventured to use in the case which has been cited of *Re Spencer* (*infra*, p. 318), and I should ask myself this: These people, who are men of business, desire to distinguish their goods in the market: What do they do? They put the word "Monopole," and they put with it the other words "Heidsieck & Co." Is the true inference that they meant the word "Monopole" to be their trade mark and not the others? If so, why did they put the rest? Is it true in fact? Why did they put the rest? Why do they want to put the rest if "Monopole" alone is the distinguishing trade mark? For, if it is, the market do not want their name. If "Monopole" by itself is their distinguishing trade mark, that means "Heidsieck & Co.'s Monopole." It is not business that a man should trouble himself to place anything on his goods when it will be wholly unnecessary, unless it is to be part of his trade mark. Therefore, the truth is that they put all that because they meant all of it to mark their goods and to distinguish them. If that is so, the whole of it was their trade mark.

Now, another view which I take of the matter is this. What is a trade mark? A trade mark is not an essay. It is not a

thing that it is necessary people should read and construe. A word may be a trade mark, and I am inclined to think that "Monopole" by itself might be in that sense a trade mark, because it is a foreign word. Nobody calls English goods "Monopoles." They say in English it is a "Monopoly wine," but "Monopole," I should have thought, would do, because it is a foreign word. But you want a picture. If you would have "Monopole" as a picture there it is. But here the picture, which was always put on as a label was not "Monopole" alone, but "Monopole" with something else added to it, and, without the person reading it carefully and construing it grammatically, he would see that the mark is a compound mark of many words and figures. He would say, "That is *Heidsieck and Co.'s* wine." If he saw another thing with only one word he would not stop to read it. He would say, "That cannot be *Heidsieck and Co.'s* label; *Heidsieck and Co.'s* label is not a short word like that; I shall not read that; I will "look at the picture which is always on their labels." Therefore, I think the true conclusion from the evidence is, that they used the whole of it as their trade mark. I think the evidence of the fact of what they did use, and what they used as their trade mark, and what, therefore, must have been accepted on the market as their trade mark, is immensely increased by their having registered the whole, "Monopole" with "*Heidsieck & Co.*" and the rest, and, when you have once got that on the register, I have not the slightest doubt that it is a picture and nothing else. Therefore, that is a strong admission against themselves that they did not rely, and that they did not mean the market to rely, on the word "Monopole" alone, but that they relied on the whole as what they habitually, constantly, and invariably put on their wines. That, therefore, disposes, as I think, of the first point taken, and it cannot be said that *Heidsieck and Co.* ever, before 1875, used "Monopole" alone, unless it can be said that they did it on the packing cases. * * * I doubt whether what was on the packing cases can be brought in, but I will assume that it can, and if they could show a separate use of "Monopole" on the packing cases, that that would be sufficient. But did they? Now, there was never a packing case sent out by them with the word "Monopole" alone on it. There is the word "Monopole" on the packing case by itself on one side, but never, when they used the word "Monopole" on one side of the packing case, did they omit putting on the packing case the rest of it, and even more, they put on an anchor with it. There,

again, you come into *Spencer's* case, and you ask yourself, what is the truth? Not what can be argued. Anything can be argued almost. But what is the truth—the truth not to a refined mind, but the truth to a buyer or seller? In *Spencer's* case it was said, that when you put part of the thing on one side of the file, and part of the thing on the other side, they were two separate trade marks. The Court thought that that was not the true view. As to the packing cases, I should again ask myself whether they put the word “Monopole” on the packing case as their trade mark, and then went to the trouble of putting that thing on the other end for nothing at all. I say they did not. It is said that they did. I come to the conclusion that they did not. * * * The same of course applies equally to the two words combined together, “Dry Monopole.”

RE RIVIÈRE'S TRADE MARK.

[C. A., February, 1834. 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. 63; 32 W. R. 390; 55 L. J. Ch. 545; 53 L. T. 237.]

Trade Mark—Person aggrieved—Substitution—Act of 1875, s. 5.

Motion by *McDowell & Co.*, wine and spirit merchants of Madras, to expunge from the register (English) the name of *Rivière & Co.*, of London, wine and spirit merchants, and for the substitution thereon of the name of *McDowell & Co.*, as owners of a certain trade mark registered in the name of *Rivière & Co.*

McDowell & Co. did not, and did not intend to, carry on business in England.

PEARSON, J., decided that, as a matter of law, persons carrying on business abroad, could not be persons aggrieved within the meaning of the Act of 1875, sect. 5, and refused the motion. Appeal to the C. A. (Lord Selborne, L.C., and Cotton, L.J.). Case remitted to Pearson, J., to be decided on the merits.

26 Ch. D.
54.

LORD SELBORNE.—Of course if it could be shown *a priori*, that in point of law persons in a certain situation could not be aggrieved, then the conclusion would be right, that the Court must refuse to hear them on the merits; but, unless that can be demonstrated, I find nothing in the Act of Parliament which limits and defines the kind of grievance which may entitle a man to apply. I entirely agree with what has been said, that it must be a legal grievance; it must not be a “*stet pro ratione voluntas*”; the Applicant must not come merely saying, “I do not like this

thing to be done"; it must be shewn that it tends to his injury or to his damage in the legal sense of that word. * * *

Doubtless under this Act [a trade mark] must be connected with some goods or classes of goods. We will assume that it must be connected with some business carried on, or at all events to be carried on directly or indirectly in those goods or classes of goods. I will go further and assume, but I do not decide, that there must be evidence of a business being so carried on, or intended to be so carried on, in some way or other within the jurisdiction, in order to entitle a party to register a mark as a trade mark. I do not decide that, but for argument's sake I assume that to be so, as the learned Judge seems to have thought. But then is it quite impossible that a person not carrying on within the jurisdiction a business in respect of which he is himself entitled to register a trade mark, should be aggrieved by some other person proposing to register something as a trade mark? It is perfectly clear from the terms of the 5th section that persons may be aggrieved by the registration of something as a trade mark which is not authorized to be registered under the Act, as for instance, something which is *communis juris*, as in the case just now mentioned, a common mark used by a great many people, and which ought not to be registered at all. It is plain then that a person may be aggrieved though he is not entitled to register in respect of that mark of the registration of which he complains; and as it cannot be a necessary condition that he should be entitled to register in respect of that mark, I do not know how it can be shewn that it is a necessary condition that he should be entitled to register in respect of some other mark. * * * It is to my mind a matter of fact to be decided on the evidence, and not to be determined *a priori* as a matter of law.

COTTON, L.J.—Undoubtedly the grievance must be a grievance ^{26 Ch. D} which the law recognises as one in respect of which a party can ^{57.} complain in a Court of Justice, and not a merely sentimental grievance; but is it possible for us to say *a priori* that, assuming (though I by no means decide) the Applicant to be a person who, having regard to the business which he carries on and the place where he carries it on, cannot register that which the Respondents have registered, he cannot be aggrieved? * * * I can conceive many circumstances under which registration by a person carrying on business in England of that to which he is not entitled as his trade mark, and which is the trade mark of a person carrying on

business not here but abroad, might be a substantial grievance to the person who is carrying on business abroad.

PEARSON, J., subsequently dismissed the motion on the merits. Appeal to the C. A. (Cotton, Lindley, and Fry, LJJ.). Appeal dismissed. The Court held that the second part of the motion could not in any case have been acceded to.

55 L. J.
Ch. 545.

COTTON, L.J.—A person who has succeeded in striking the name of an owner of a trade mark off the register, should, before he be allowed to register his own name in lieu thereof, be required to apply to the Registrar in the usual way, and his application should be advertised and any other proceedings usual in registration in the first instance should be taken. For this reason; there may be cases, and I can imagine them, where, though as against the person applying to strike the name off the register, he may be entitled to say that that person is on improperly, yet there may be persons not present to the litigation, who have a right as against the Applicant to rectify the register, should the Applicant himself be placed upon it, and to say that the Applicant was not entitled to prevent them using the mark.

LINDLEY, L.J.—If the Applicants had succeeded in making out a case to remove the name of *Rivière & Co.*, I don't think they would have been entitled to have themselves registered in respect of this mark. * * * They could not have registered anew in respect of the old mark without advertising and taking the other steps required by the Act and Rules. I say that on behalf of the public.

RE ROBERTSON, SANDERSON & COMPANY'S APPLICATION (1).

[March, 1892. 9 R. P. C. 213.]

Trade Mark—Applicant domiciled in Scotland—Notice of Motion—Practice.

Robertson, Sanderson & Co., of Leith, North Britain, applied on the 21st of October, 1890, to register a trade mark, No. 151,288, for Scotch Whiskey. This application was opposed by *John Gillon & Co.* The Comptroller decided that the mark should be registered. The Opponents appealed to the Board of Trade, who referred the matter to the Court. The Opponents thereupon gave the usual notice of motion, addressed to the Comptroller and to *Robertson, Sanderson & Co.*, but the latter having given no address for service in England, their English solicitors refused to accept service on their behalf.

Upon an *ex parte* application being made on behalf of *John Gillon & Co.*, STIRLING, J., ordered the notice of motion to be amended by striking out the name of *Robertson, Sanderson & Co.* as Respondents, and directed that the same course should be followed as in *Re La Compagnie Générale d'Eaux, &c.* (*supra*, p. 101).

RE ROBERTSON, SANDERSON & COMPANY'S APPLICATION (2).

[April, 1892. 9 R. P. C. 264; (1892) 2 Ch. 245; 61 L. J. Ch. 470; 66 L. T. 673; 40 W. R. 569.]

Trade Mark—Opposition—Appeal—Amendment of notice of opposition—Acts of 1883 to 1888, s. 69—T. M. R. 1890, rr. 31, 54, 55 (infra, pp. 358, 362).

Motion.

On 21st Oct., 1890, *Robertson, Sanderson & Co.*, of Leith, applied to register for Scotch Whiskey, a trade mark containing (*inter alia*), the words, "The Original Mountain Dew." The mark was not claimed as an old mark.

On the 11th of March, 1891, *John Gillon & Co.*, of Leith, gave notice of opposition, the grounds of opposition being given as follows:—"The words, 'The Original' before 'Mountain Dew,' 'Mountain Dew' having been instituted by our firm nearly fifty years ago, and used by us ever since. Registered 31st of March, 1886, No. 48,465."

No. 48,465, was a mark registered by *J. Gillon & Co.* in 1886 containing the words "Real Mountain Dew." When the case came before the Registrar, representing the Comptroller, on the 7th July, 1891, Mr. *J. C. Dawson*, a member of the firm of *Gillon & Co.*, who appeared in person, tendered in evidence a declaration made by one *Peter Mackenzie* on the 2nd of July, and of which a copy had been sent to the Applicants' solicitors only the previous night, purporting to shew that a firm of *Young & Co.* had used the phrase earlier than either of the contending parties. Counsel for *Robertson, Sanderson & Co.* objected to this evidence being received, and the Registrar rejected it, on the ground that the notice of opposition was limited to user by the firm of *John Gillon & Co.*, and therefore that the declaration was irrelevant to the issue he had to decide. No application for leave to amend the notice of opposition, or for an adjournment was made, and the evidence on the part of *Robertson, Sanderson & Co.* shewing that they had used the words "Mountain Dew" at least as far back as 1851, and that on the part of *Gillon & Co.*

failing to prove user by them before 1852, the opposition was disallowed and the registration directed to proceed. Appeal to the Board of Trade. Appeal referred to the Court with liberty to either party to adduce such evidence, as might be advised.

On 1st *March*, 1892, *J. Gillon & Co.* gave the ordinary notice of motion and filed evidence seeking to establish the prior user of *Young & Co.*, which *Robertson, Sanderson & Co.* refused to answer on the ground of irrelevancy.

On the 21st *March*, 1892, *Gillon & Co.* gave a second notice of motion by which they asked for leave to amend their notice of opposition by adding, as new grounds of objection, that "(a) the Applicants were not, nor were their predecessors in business, the original distillers or sellers of 'Mountain Dew' whiskey; (b) the use of the word 'The Original' as part of the trade mark No. 151,288 is calculated to deceive."

Motion refused.

STIRLING, J., referred to the two notices of motion and said:—

9 R. P. C.
267, l. 35.

It is the second application that I have to dispose of on the present occasion, and the question is, what jurisdiction have I to entertain it? It seems to me I am precluded from entertaining it, because of section 69, sub-section 4, of the Patents, Designs, and Trade Marks Acts, 1883 and 1888. * * What is my jurisdiction? Simply to hear and determine the appeal. If I am to hear the appeal as an appeal from the refusal of the Registrar to admit the evidence in question, I should be of opinion, as I have already said, that the Registrar was right in his refusal, [*as*] no application was made to him for leave to amend the notice of opposition. If I am to entertain the motion, I should have to deal with matters which were never brought before the Registrar, or considered by him. It appears to me that my function is limited to "hearing and determining the appeal" referred to me by the Board of Trade, and I think, therefore, that I have no jurisdiction to grant the application made by the notice of motion of the 21st of *March*, 1892; but at the same time it would seem to me that having regard to the circumstances I have already mentioned, such an application is one that is worthy of consideration. I therefore, feeling unable to make an order on the motion, refuse it; but that will be without prejudice to any application which Messrs. *John Gillon & Co.* may see fit to make to the Registrar with reference to amendment.

RE ROBINSON'S TRADE MARK.

[June, 1880. 29 W. R. 31.]

Trade Mark—Colour—T. M. R. 1876, rr. 57, 63 (infra, pp. 391, 392).

An application by Messrs. *Robinson* to register a gold mohur as a coloured cotton trade mark, was opposed by Messrs. *Dewhurst*, the proprietors of another cotton mark, consisting of a silver rupee. Messrs. *Robinson's* mark had been placed in the first class by the Committee of Experts, and had been duly deposited and advertised.

JESSEL, M.R.—The only trade mark which is protected by the Act of Parliament is the registered trade mark, and, where it is a cotton mark like this which is deposited and advertised the only trade mark registered is that of which the representation can be seen at the places mentioned in the advertisement, and no other is ever registered, and the register refers to the deposited trade mark which remains in the possession of the Registrar, and can be produced; so that there is no pretence for saying that this gold mohur and silver rupee are at all similar. * * That which would have been an infringement of a trade mark as regards that registered thing before the Act is still an infringement, and nothing else. 29 W. R. 32.

ROBINSON v. FINLAY;

WARD v. ROBINSON.

[C. A., May, 1887. 9 Ch. D. 487; 39 L. T. 398; 27 W. R. 294.]

Trade Mark—Joint adventure.

Cross actions to restrain infringement.

In 1870 an arrangement was made between *Ward*, a cotton manufacturer at Manchester, *Robinson*, a shipping agent at Manchester, and *Galbraith & Co.*, a firm carrying on business at Rangoon, that *Ward* should consign cotton cloths to *Galbraith & Co.* in Rangoon, paying them an inclusive commission. The goods were to be exported through *Robinson*, who acted as shipping agent and was to see to the goods being finished and packed, receiving for these services a commission from *Galbraith & Co.* Particular marks were by arrangement between the three parties adopted for the goods. In the case of each of these marks some portions and the general arrangement of the mark were new, while other portions consisted of *Robinson's* name and arms, and of a symbol which had formerly been used by *Galbraith & Co.* in

Burma, and of some numbers which (apparently) represented *Ward's* contribution to the mark. After goods had been regularly exported for some years under this arrangement, *Ward* ceased to send goods through *Robinson*, and commenced exporting them to Rangoon through the agency of *Finlay*, continuing to use the old marks, except that the name and arms of *Finlay* were substituted for those of *Robinson*. At the same time *Robinson* commenced exporting other goods under the old marks.

BACON, V.-C., granted an injunction in *Robinson v. Finlay*, and dismissed *Ward v. Robinson*.

On appeal the C. A. (James, Baggallay, and Bramwell, L.JJ.) held that both actions should be dismissed.

9 Ch. D.
497.

JAMES, L.J., referred to the marks and said:—Those were the marks which the three agreed to use upon the goods in which the three were interested in the way I have stated. What, then, did those marks indicate? If anybody had asked that question, he would have been told that they indicated goods either manufactured or bought by *Ward*, which passed through *Robinson's* hands (who, to a certain extent was answerable for the mode in which they were finished), and were sent out to *Galbraith & Co.*; that is to say, it was a mark invented by the three for the business in which they were respectively interested. That is the only fact that we have got before us from which we are to deduce the rights of the parties.

9 Ch. D.
498.

In my opinion, under those circumstances, it is impossible to say that either *Ward* acquired a monopoly of that trade mark against *Robinson*, or that *Robinson* had a monopoly of it against *Ward*. * * * The result is this: the case is not like one depending on the relation of master and servant, or principal and agent, but it is more like a partnership; that is to say, the mark was adopted by persons joined in a matter in which they were interested jointly, not as master and servant, but by way of a partnership. The *onus probandi* is thrown upon the Plaintiff in each case to prove that he has that monopoly and sole right which he alleges to use the marks, or combination of marks, and that the Defendant is unlawfully using the same. Each Plaintiff has, to my mind, entirely failed to discharge that onus, and the result is that each action ought, in my opinion, to be dismissed with costs. But to avoid complication it will be best that both actions should be simply dismissed, without making any order as to costs here or below.

9 Ch. D.
499.

BAGGALLAY, L.J.—We have not now to consider whether

Robinson would have a title in respect of the portions of the trade mark which were his before the year 1870, or any of them, but whether he has a property in the whole design which will entitle him to have an injunction.

I think we have only to turn to the admitted facts of the case to see that it is impossible to hold that any one of the three parties interested in the adventure, for the purpose of which the design was adopted, can claim to be entitled to that design, when the adventure is put an end to. (His Lordship described the marks and continued :—) We have then a particular design for the purpose of giving a character to goods, in the export of which the several parties are interested, and that particular design contains something which represents the interest, more or less, which each of the three several parties has in the goods so exported. It may be a very good design, so long as the purpose for which it was invented continues to be effectuated, but when the parties cease to carry on this particular adventure, I am at a loss to understand upon what ground it can be said that that design has become the property of any one of the three parties concerned who were using it. It appears to me, therefore, that *Robinson* has no exclusive title to this design ; and it being clear upon the evidence that the designs were designs in which three persons were interested for the purpose of carrying on a business or adventure in which all three were interested, it follows that, upon the termination of that adventure, none of the three could claim any title against the other, and that *Ward's* action must fail, as well as that of *Robinson*.

ROSE v. EVANS.

[May, 1879. 48 L. J. Ch. 618.]

Trade Mark—Person aggrieved—Act of 1875, s. 5.

Motion to rectify.

In 1877, *Evans & Co.* registered the word “Limetta” (the scientific name of a particular tree) as a trade mark for lime juice, though they had not used this word as a trade mark before the passing of the Act of 1875. *Rose & Co.* had for many years used the word in connection with lime juice (e.g. Limetta Ginger Cordial).

On *Evans & Co.* commencing against *Rose & Co.* an action for infringement, *Rose & Co.* moved to expunge *Evans & Co.*'s trade mark.

Motion granted.

48 L. J.
Ch. 620.

HALL, V.-C.—It being shown that they were not entitled by prior user, they could only claim the mark in question on the footing of a new mark; and being a single word it was not admissible to registration as a new mark. Then the present Applicant, Mr. *Rose*, claims to be a “person aggrieved” within the other part of the 5th section, because he has used the word himself in his business without claiming it as a trade mark. * * As a dealer in lime juice he is, in common with other persons in the trade, injured by a word which they had been using and treating as a common word of description, being attempted to be turned into a word of property. I think that Mr. *Rose’s* firm are, within the meaning of the Act, parties aggrieved by the registration.

ROSENTHAL v. REYNOLDS.

[April, 1892. 9 R. P. C. 189; (1892) 2 Ch. 301; 61 L. J. Ch. 508; 67 L. T. 162; 40 W. R. 521.]

Trade Mark—Disclaimer—Acts of 1883 to 1888, s. 74, sub-s. 2.

Motion in an action by *William Rosenthal*, trading as *William Rosenthal & Co.*, corset manufacturer; the Defendants being *Waterhouse, Reynolds & Co.*, a firm of corset manufacturers. The Plaintiff claimed an injunction to restrain the Defendants from using the words “W.R.” on corsets in such a way as to lead to the belief that the Defendants’ corsets were made by the Plaintiff. The Plaintiff alleged, and there was evidence to shew, that the Plaintiff’s goods, by reason of their being marked with the initials “W.R.,” were known on the market, as “W.R.” corsets. It was shewn that the Defendants had manufactured and sold corsets marked with the letters “W.R.” in the same place (an unusual place for that purpose) as the Plaintiff’s corsets; and that persons had bought such corsets as corsets made by the Plaintiff. There was no allegation of any other resemblance in the get up of the goods of the Defendants to the get up of the goods of the Plaintiff. The Plaintiff had only used the letters “W.R.” on corsets for four or five years.

The Plaintiff had four registered trade marks, consisting of labels containing either fancy words or a device combined with the letters “W.R.” or “W.R.C.” in large Roman type. One such mark, registered in *January*, 1890, was “Whalonia W. R.” on a label; another, registered in *February*, 1890, was a label with the device of an eagle and flowers with the letters “W.R.” The Plaintiff had in each instance in his application for registration confined his

claim to parts of the label which did not include the letters "W.R." and disclaimed "the exclusive use of the added matter."

Motion refused.

NORTH, J.—There is one ground which I think sufficient to prevent me granting an injunction at the present time. It is this:—that the Plaintiff has registered his trade mark in respect of corsets, and he has expressly disclaimed any exclusive right to or interest in these two letters "W.R." in connection with corsets. Those, therefore, not only do not form part of his marks, but in registering the marks and securing the benefit which such registration gave him, he has expressly disclaimed and told the world that he has no monopoly whatever of the use of those two letters in connection with this mark. Under those circumstances, I do not see my way to interfere on his behalf and say that although he has registered what he can register, and has disclaimed what he cannot register, yet he is to have precisely the same benefit conferred on him in respect of what he cannot register as in respect of that which he could and did deliberately register.

9 R. P. C.
192, l. 25.

RE ROSING'S APPLICATION.

[C. A., November, 1878. 54 L. J. Ch. 975 n.]

Trade Mark—Similarity—Nature of goods—Sheffield mark—Act of 1875, ss. 6, 9—Costs.

Motion by *F. Rosing* for leave to register a new trade mark.

In 1833, the *Cutlery Company* of Sheffield, granted to *Michael Hunter* of Sheffield a corporate mark for hardware goods, consisting of the device of a curved bugle-horn suspended by cords, which met at a point above the bugle, and formed two loops side by side. Beneath the device was the word "Libertas." The device without the word was used by *Hunter* upon his hardware goods continuously down to 1861, when he transferred his business and the corporate mark to his son *Michael Hunter* the younger, who from that time continued to use the mark upon his hardware goods including steel and iron goods, all kinds of cutlery, files, edge tools, skates, sheepshears, hoes, shovels, and various other kinds of tools and general articles manufactured and sold by him.

In 1878, *F. Rosing*, of London, general merchant, applied to register as a new trade mark for certain metal goods in Classes 5, 12, and 13, the device of a curved bugle-horn with a twist in the middle surmounted by a rose branch bearing two roses and five leaves, the roses being at the top of the whole device in a position

corresponding to that occupied by the loops in *Hunter's* corporate mark. The goods in Class 5 were not included in the Cutlers' Company's Acts; the goods in Classes 12 and 13 were, however, included in these Acts, being in fact the same goods as those manufactured and sold by *M. Hunter* the younger. *Rosing's* application being opposed by the *Cutlers' Company*, he launched this motion, asking that the *Cutlers' Company* should pay the costs.

BACON, V.-C., made the order asked. Appeal to the C. A. (Jessel, M.R., Baggallay and Thesiger, L.JJ.). Order of BACON, V.-C., varied.

54 L. J.
Ch. 976.

JESSEL, M.R.—The simple question we have to decide is whether these marks proposed to be registered are, as regards the two Classes 12 and 13, within the words of the Act. If we think they are, the question of *bona fides* does not arise. At the same time, when discussing such a question, I think it not unreasonable to ask the trader why he adopted a mark so like one already in use. Of course if he answers, "I never heard of the mark in use," that would be an answer. But if he knew the mark was in use, I should expect him to give me some reason or other for his conduct; although he may, if he pleases, withhold any reason, and say, * * that he has taken the mark because he liked it; and if the law did not prohibit it, I could not prevent his liking to use a mark very nearly resembling the mark of the old established trader.

Now, I am of opinion, having regard to the circumstances of this case, to the nature of the goods, to the nature and size of the mark, to the mode of stamping it, and to what would happen in practice—for all these things must be looked at—that this mark is completely within the words of the Act of Parliament. In the first place, the mark, as appears from the actual things sold by *Mr. Hunter*, is on many of the things, if not on all the cutlery goods, very small. In the next place, it is a punched mark, very liable to get more or less blurred—as is actually the case with two out of the three marks handed up to us, two of the three marks are more or less blurred; and, in the third place, we must have regard to the fact, as I said before, of the use of the mark in the trade, and to the question whether it is a mark which is likely to get blurred, or one which is likely to remain. One sees at once that the horn is a thing likely to remain, and that the loops are most likely to get blurred or obliterated. That being so, we must consider whether two marks of that size, the one consisting of a horn, with a twist, and with two roses above it with the stalks crossed, and the other consisting of a horn without a twist, but hung up by what I call a

treble loop, are so like one another, when stamped on such articles of such a size, as to prevent the manufacturer or merchant, who is going to use the former for the first time, from taking it, in spite of the opposition of the trade, or the *Cutlers' Company*, or the manufacturer who has used it for forty-five years. I must say that I do not impute any want of good faith, or any immorality or intentional design on the part of the Applicant. * * * Without imputing anything of the kind to him, I am of opinion that this mark most clearly infringes on the wholesome provisions of the Act of Parliament, and ought to be disallowed as to the two classes in question, and that the V.-C.'s order should be amended in that respect. Then as regards Class 5, the registration in that class is to be limited to the articles claimed.

As regards the costs, I think, in substance, we should apply the strict rule. Now the strict rule is this:—that when an application partly succeeds and partly fails, the Court does not go into the minutiae, but says, “no costs.” When an application succeeds, the successful Applicant gets costs. The result will therefore be to relieve the *Cutlers' Company* from costs in the Court below, because they opposed in its entirety an application which succeeds as to one of its objects; and to give them the costs of the appeal, because they have succeeded entirely upon the appeal.

RE ROTHERHAM'S TRADE MARK.

[C. A., May, 1880. 14 Ch. D. 585; 49 L. J. Ch. 511; 43 L. T. 1.]

Trade Mark—Distinctive device—Act of 1875, s. 10—Costs.

Motion to rectify.

In 1878 Messrs. *Rotherham & Co.*, of Coventry, applied to register the word “Tod” in Arabic characters as a trade mark for watches exported by them to Messrs. *Tod & Co.* of Alexandria. The word “Tod” in Arabic means “a high mountain.” The Registrar, by the direction of the Commissioners of Patents, refused registration on the ground that words in a foreign language could not be registered.

Registration directed by BACON, V.-C. (11 Ch. D. 250).

Appeal to the C. A. Appeal dismissed.

JAMES, L.J.—There may be a difficulty in dealing with such marks as this, but I think that the Registrar must put up with the possibility, which I think is a very remote possibility, of his

14 Ch. D.
587.

suffering some inconvenience, and also of somebody else suffering some inconvenience, because he is not able sufficiently to distinguish words written in Oriental characters. The V.-C. was of opinion, as it seems to me quite rightly, that this was a distinctive device. In *Gout v. Aleploglu* (6 Beav. 69 n.), the Plaintiff's name and the word "Pessendede" in Turkish characters were held to be a distinctive device and a good trade mark. If so, why should it not be registered if now brought for registration. I cannot see any distinction between "Pessendede" in Turkish characters and "Tod" in Arabic characters, and I think that this device ought to be registered. It is a distinctive device, and a word which any-one knowing the language would understand.

BAGGALLAY, L.J.—I am of the same opinion. It seems to me that this device comes within the second definition contained in the 10th section of the Act; for it is the name of an individual printed in a particular or distinctive manner.

14 Ch. D.
588.

The Court, though of opinion that it was a case of hardship, and that the appeal ought not to have been brought, held that they had no jurisdiction to give costs.

THE RUGBY PORTLAND CEMENT COMPANY, LIMITED *v.*
THE RUGBY AND NEWBOLD PORTLAND CEMENT COM-
PANY, LIMITED.

[C. A., November, 1891. 9 R. P. C. 46.]

Trade Mark—Descriptive expression.

Action to restrain infringement and passing off.

The Plaintiffs and Defendants both had works near Rugby, where they manufactured Portland Cement out of the blue lias found in the neighbourhood.

The Plaintiffs were the owners of a registered trade mark containing (*inter alia*) the words "Rugby Portland Cement," and they alleged in their pleadings that this Portland Cement was known as the "Rugby Portland Cement," and that the phrases "The Rugby," and "Rugby" has always been understood as denoting Portland Cement of their manufacture and no other. The Defendants had admittedly manufactured Portland Cement as "The Rugby," or "Rugby" Portland Cement.

The trial of the action took place before Vaughan Williams, J. (8 R. P. C. 241), who held that there was no evidence of any infringement of the Plaintiffs' trade mark as a whole; that the

evidence shewed that the terms "Rugby," and "Rugby Portland Cement" did not denote the Plaintiffs' cement and no other, but were terms known in the trade as applied to cement from this district, and that there was no evidence of deception on the part of the Defendants.

The action was accordingly dismissed with costs.

Appeal to the C. A. (Lindley, Bowen and Fry, L.JJ.), who dismissed the appeal with costs.

LINDLEY, L.J.—This is an attempt to turn a trade mark into a nuisance. The Plaintiffs cannot monopolize the use of the name "Rugby" as applied to all Portland Cement made out of the blue lias formation which is situated in the neighbourhood of Rugby. The Plaintiffs have a trade mark, and if the Defendants had infringed that trade mark, of course there would have been no difficulty, but the Defendants avoid doing anything of the kind. The Plaintiffs' case is a simple case, that nobody can call his cement made out of this blue lias formation "Rugby Portland Cement," which is utterly absurd.

9 R. P. C.
48, l. 29.

RE RUST'S TRADE MARK.

[June, 1880. 44 L. T. 98 n. ; 29 W. R. 393 n.]

Trade Mark—Erroneous registration—Practice.

In 1877, *Arthur Rust*, a partner together with several other persons in the firm of *T. W. Rust & Co.*, registered by mistake a trade mark belonging to the firm in the name of "Arthur Rust, trading as *T. W. Rust & Co.*" Upon motion by the firm for rectification JESSEL, M.R., ordered the register to be rectified by cancelling the name of the registered proprietor and inserting the names of all the co-partners trading under the firm's name.

THE SANITAS COMPANY, LIMITED v. CONDY.

[December, 1886. 4 R. P. C. 195 ; 56 L. T. 621.]

[October, 1887. 4 R. P. C. 530.]

Trade Mark—Infringement—Fraudulent passing off—Costs.

In 1884 the Plaintiffs registered the word "Sanitas" as a trade mark for disinfectants. The Defendant (who traded as the *G. Condy's Sanitants Co.*, and the *Condisanitant Co.*), subsequently advertised a disinfectant under the name of "Condisanitas." The Plaintiffs commenced an action against the Defendant to restrain

him from infringing their trade mark, from selling or advertising any disinfectant under the name of "Sanitas," either alone or in combination, and from trading under any name so resembling the Plaintiffs' name as to be calculated to deceive; and they moved for corresponding interlocutory injunctions. KAY, J., granted an interlocutory injunction against infringement, and directed the other part of the motion to stand to the trial.

4 R. P. C.
196, l. 43.

KAY, J.—In this case the Plaintiffs registered as their trade mark in 1884 the word "Sanitas," and nothing else. * * The Defendant, rejoicing in the name of *Condy*, some little time ago, approached as nearly as he dared to the use of the word in using the word "Sanitants." That occasioned a negotiation between him and the Plaintiffs. * * However, they did not proceed against him to restrain him from using the word "Sanitants," and thereupon becoming emboldened by that impunity, he proceeds to use the word "Sanitas," and in order to veil his dishonest intention to acquire the business and profits of somebody else, he adds on the letters "*C-o-n-d-i*," which do not spell his name rightly, because his name is *C-o-n-d-y*; and he calls his preparation "Condisanitas," which he advertised very largely, and which obviously was intended to lead the public to enquire for his disinfectants, for it was for disinfectants that he advertised this word under the form of "Condisanitas." The purpose is so apparent, that I suppose he must consider Courts of Justice to be as blind as they are figured in fables. No tradesman ought to be dishonest, and this act of dishonesty I at once put a stop to by granting an injunction to prevent him from using the word "Sanitas" in conjunction with the word "Condi," or in any other way which shall be an infringement of the Plaintiffs' trade mark.

The action was subsequently tried before KEKEWICH, J., who granted both the injunctions claimed, but refused to order damages or an account, or to give costs on the higher scale, on the ground that the evidence of sales was insufficient to make the former worth while, and that there was no sufficient reason for the latter which were not given as a matter of course.

4 R. P. C.
531, l. 30.

KEKEWICH, J.—The Plaintiffs are entitled to have the trade mark protected; and further than that, they are entitled to have their business protected to this extent, that if any person has used the words which they employ so as to pass off, or so as to tend to pass off, the goods of that other person as the goods of the Plaintiffs, then the Plaintiffs are entitled, apart from their trade mark, to insist that that should be restrained.

It is quite open to the Defendant to sell a disinfectant, or deodorant, and to manufacture it, and if he can produce precisely the same article, he is perfectly at liberty to do that ; and he may call it by any name he likes which is his own. But having not only the English language before him but every language living or dead, to choose where he pleases, he will take up the Latin word "Sanitas"; and to my mind the very choice is a distinct indication of fraud. He is perfectly aware, and I must take him to be aware, that "Sanitas" was appropriated by the Plaintiffs; and why on earth he should not have taken some Greek, French, Italian, or any other word, and called his mixture or compound by that other word, unless he desired to pass his goods off as those of the Plaintiffs, it is beyond my ingenuity to conceive.

4 R. P. C.
532, l. 53.

RE THE SANITAS COMPANY'S TRADE MARK.

[November, 1887. 4 R. P. C. 533 ; 58 L. T. 166.]

Trade Mark—Registration refused by Comptroller—Fresh objections taken on his behalf before the Court—Fancy word—Act of 1883, ss. 62, 64, sub-s. 1 (c), 72.

Summons to proceed.

The Sanitas Company Limited applied to register under the Act of 1883 the word "Sanitas" as a new trade mark for medicine (Class 3). There were at the time two marks on the register in the same class, one of which (registered in 1876) comprised *inter alia* the phrase "Sanitas sanitatis omnia sanitas," and the other (registered in 1878) the phrase "Sanitas felicitas morbus misera." The Comptroller refused the Company's application. On the matter coming before the Court registration was refused.

KAY, J.—I have not the least hesitation about this case. It is a case in which the word "Sanitas" is sought to be registered as a trade mark for medicine. * * The truth is that if this word were applied to medicines, it would mean to any ordinary person that the medicines were health medicines ; that is, health-giving medicines ; and that is descriptive of the quality or of the effect of the use of these medicines. How is it possible to say that it is not descriptive ? On that ground alone I should be prepared to refuse this application. But it has been argued seriously before me that if the word has acquired a secondary meaning, although it may not be that which could be called a fancy word originally, yet if it has acquired in the trade a secondary meaning denoting that the goods marked with that word are made by a particular manufacturer, then you may register it. All I can say is, that is exactly contrary

4 R. P. C.
534, l. 20.

to the Act of Parliament. The Act of Parliament says it must be a "fancy word not in common use." You cannot register a word which otherwise is not a fancy word because it has come to have in the trade that special secondary meaning. * * If a man has used a word in connection with his goods which has come in the market to be known as a word distinguishing goods made or selected by him, he need not put that upon the register at all, because he would have a right to prevent anybody using that word in connection with similar goods, and might obtain an injunction against him.

4 R. P. C.
535, l. 19.

The registration of the word "Sanitas" by itself would clearly, after these marks were on the register, tend to produce confusion.

* * * However, mainly on the first ground, which I have stated, I think the Comptroller was quite right. It is suggested that that reason not having been given by the Comptroller, the Court ought not to consider it. I do not think that is tenable, because what a very awkward position that would place the Court in when asked to put itself in the position of the Comptroller for the purpose of the particular question, if an objection were to occur to the Court which did not occur to the Comptroller. Is the Court bound to let the mark go on the register notwithstanding the objection? Of course, it is an argument which could not be seriously contended, and indeed the argument altogether seems to me to have been one which was rather adopted in desperation.

SINGER MANUFACTURING COMPANY v. LOOG.

[H. L., December, 1882. 8 A. C. 15 ; 52 L. J. Ch. 481 ; 48 L. T. 3 ;
31 W. R. 325.]

Trade mark—Trade name.

Action to restrain infringement of trade mark and use of trade name.

The Plaintiffs, the *Singer Manufacturing Company*, used the word "Singer" as a designation of all the sewing machines manufactured by them, accompanied by specific words to distinguish different kinds. The Defendant was the English agent of the *Sewing Machine Manufacturing Company*, a company established in Berlin. He sold sewing machines which he described in his invoices, price lists, and circulars as being made on the Singer system and the like, with explanations showing that they were made in Berlin. He also put on some machines a label containing the words "Singer Machine" and some additional

words referring to the foreign makers, which label was however similar to the label used by the Plaintiffs. The Defendant did not insist on continuing the label, but justified his use of the word "Singer" by alleging that it had ceased to designate machines manufactured by the Plaintiffs and had come to mean machines made upon a certain system, by whomsoever made.

BACON, V.-C., granted the injunction both as to the label and the name "Singer" as used by the Defendant in the documents above mentioned. 18 Ch. D.
395.

Appeal by the Defendant to the C. A. (James, Cotton and Lush, L.JJ.), who held that the injunction ought to be refused, except as to the label, on the ground that the documents in question were not calculated to deceive by representing the Defendant's machines to have been manufactured by the Plaintiffs. 18 Ch. D.
412.

JAMES, L.J.—I have often endeavoured to express what I am going to express now (and probably I have said it in the same words, because it is very difficult to find other words in which to express it)—that is, that no man is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer. That being, as it appears to me, a comprehensive statement of what the law is upon the question of trade mark or trade designation, I am of opinion that there is no such thing as a monopoly or a property in the nature of a copyright, or in the nature of a patent, in the use of any name. Whatever name is used to designate goods, anybody may use that name to designate goods; always subject to this, that he must not, as I said, make directly, or through the medium of another person, a false representation that his goods are the goods of another person. That I take to be the law. Now, applying that law to the facts of this case, I am of opinion that the label which the Defendant was, as I conceive, very well advised to discontinue the use of, and to submit to be enjoined from using in future, was calculated to deceive, and was calculated to make a false representation as between somebody who did not know who the real manufacturer was and his vendor, and that upon many grounds. The label was of the same shape, of the same metal, of the same colour, placed in exactly the same position in which the Plaintiff Company's label was put, and it did contain the word "Singer," no doubt, with other words

annexed to it, but which might very easily have been overlooked ; and, therefore, in my opinion, it comes entirely within those cases in which it is calculated, and, if calculated, must be assumed to have been intended, to make a false representation. But when I come to the other documents, I am really unable, after all I have heard, to see anything which could deceive any human being.

Appeal by the Plaintiffs to the H. L. (Lords Selborne, Blackburn, Watson, and Bramwell). Appeal dismissed.

8 A. C.
18.

LORD SELBORNE, L.C.—The imitation of a man's trade mark, in a manner liable to mislead the unwary, cannot be justified by shewing, either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled.

8 A. C.
20.

Referring to the Defendant's invoices, price lists and circulars, his Lordship said :—It was admitted by the Plaintiffs' witnesses, and to me it seems clear, that no purchaser of the class to whom alone these documents were issued by the Defendant could possibly be thereby deceived or misled into supposing that the machines sold by the Defendant were of the Plaintiffs' manufacture, or that the business carried on by the Defendant was the Plaintiffs' business. All such purchasers must necessarily have understood that the articles which they ordered or bought were manufactured by the Berlin Company, though some of them were made upon a "system" which was called "the Singer system."

8 A. C.
22.

The question, therefore, is, whether the Defendant, not representing the machines which he sells as of the manufacture of the Plaintiffs, but, on the contrary, representing them as manufactured by the *Berlin Company*, is at liberty to say that he makes them "on the Singer system"? I agree with the C. A. in thinking that he is at liberty to do so, and that by so doing, (if, in substance, he does no more), he infringes no rights of the Plaintiffs.

8 A. C.
26.

The Counsel for the Appellants lastly argued, that the Plaintiffs trading under Mr. *Singer's* name, and using his trade mark, had acquired such a right of property in that name as to entitle them to restrain any rival in trade from introducing it into any of his price lists, circulars, or advertisements, even in such a way as might exclude the possibility of its being understood to represent, directly or indirectly, that the goods sold by him were manufactured by the Plaintiffs, or that his trade or business was identical or connected with the trade or business of the Plaintiffs. For that argument no authority was cited ; and it cannot, in my opinion

be maintained on any principle. The reputation acquired by machines of a particular form or construction is one thing; the reputation of the Plaintiffs, as manufacturers, is another. If the Defendant has no right, under colour of the former, to invade the latter, neither have the Plaintiffs any right, under colour of the latter, to claim (in effect) a monopoly of the former. If the Defendant has (and it is not denied that he has) a right to make and sell, in competition with the Plaintiffs, articles similar in form and construction to those made and sold by the Plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common in his trade, provided always that he does this in a fair, distinct, and unequivocal way. The C. A. has thought that (apart from the infringement of the trade mark) this is all that he has done. I think the same, and I therefore move your Lordships to dismiss this appeal.

Lord BLACKBURN.—The original foundation of the whole law is 8 A. C.
29. this, that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established (alike at law: *Blofeld v. Payne*, 4 B. & Ad. 410, and in equity: *Edelsten v. Edelsten*, 1 D. J. & S. 185), that it is an actionable injury to pass off goods known not to be the Plaintiff's as and for the Plaintiff's, even though not inferior.

The modes in which goods may be passed off as and for the Plaintiff's vary. The most usual is where a particular mark on the goods or on the packages in which they are sold has been used to denote that they are made by a particular firm to such an extent that it is understood in the market to bear that meaning. The law as to those trade marks is now regulated by statutes, but before there was any legislation on the subject, it was well settled that when any one adopted a mark so closely resembling the trade mark of the Plaintiff that it would be likely to be mistaken for it, and put it on his goods and sold them, knowing that though the persons to whom he sold them were well aware that they were not the Plaintiff's make, yet that they were meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the Plaintiff's, he might be properly found to have knowingly and fraudulently sold the goods as and for the Plaintiff's goods: *Sykes v. Sykes* (3 B. & C. 541). And, so far, there was no difference between law and equity. But

at law it was necessary to prove that an injury had been actually done. In equity it was enough to shew that the Defendant threatened to do, and would, if not prevented, do that injury.

8 A. C.
31.

It is, to my mind, obvious that though the Defendants might have committed no actionable wrong whilst using the Plaintiffs' trade mark innocently, yet, if they persevered in the use of it after they had knowledge of the facts, they would do wrong, and there would be evidence to support a claim at law for damages for knowingly selling the Defendant's goods as and for the Plaintiffs'.

8 A. C.
37.

It was not denied that everyone was at liberty to make and sell machines in every respect identical with those made by the Plaintiffs, and to say that the goods he made and sold were identical with those made by the Plaintiffs in shape and construction, and to allege that the materials were better than those used by the Plaintiffs, and more skilfully put together, and sold cheaper, and all this for the purpose of rivalling the Plaintiffs. But it was said that the Plaintiffs' family name must not be used at all for such an object. No authority was cited in support of such an extensive proposition, and I do not think it is founded on sound principles.

SLAZENGER & SONS v. FELTHAM & COMPANY.

[C. A., March, 1889. 6 R. P. C. 531.]

Trade Mark—Invalid Patent—Passing off—Injunction—Erasure.

In 1884, the Plaintiffs registered a representation of a demon's head with the words "The Demon" on it as a trade mark for tennis racquets. They used the trade mark only upon tennis racquets having handles made according to their patent, No. 226 of 1884. The words "The Demon" were usually stamped on the top of the racquet, and the Plaintiffs' name was also stamped on another part of the racquet. The racquets were generally known and ordered as the "Demon" racquets.

In 1888, the Plaintiffs commenced an action against the Defendants, who were selling almost identical racquets with the word "Demotic" stamped on them in the same place as the words "The Demon" were stamped upon the Plaintiffs' racquets. The Defendants also stamped their firm's name on their racquets.

The Plaintiffs claimed an injunction restraining the Defendants from stamping the word "Demotic" on any racquets manufactured by them and from misrepresenting in any other way, by the use of

the word "Demotic" or otherwise, that the racquets manufactured &c. by them were the "Demon" racquets manufactured &c. by the Plaintiffs; also damages or an account, and destruction of all racquets stamped with "Demotic."

Two days before the trial of this action, the validity of the Plaintiffs' patent was tried before KEKEWICH, J. who decided that the patent was invalid.

Injunction granted as claimed.

KEKEWICH, J.—To my mind, the only question I have to decide, 6 R. P. C.
532, l. 36. is one of fact; not by any means an easy question of fact; but still one of fact. The case has been presented to me on behalf of the Defendants as a mere question of law, and, it is said, that according to decided cases and the principles by which the Court is governed, the Defendants have a legal right to use this name "Demotic." It is rested mainly on this, that there is nothing to prevent Messrs. *Feltham & Company* from making and selling a racquet precisely the same as that made and sold by the Plaintiffs, irrespective of the use of the word "Demon" or "Demotic." That is so.

His Lordship then referred to the patent action and said:—That brings me to the only question I have to decide, which is: Is 6 R. P. C.
533, l. 12. the use of the word "Demotic" on a racquet precisely similar to that of the Plaintiffs and placed in a similar position, calculated to deceive purchasers so as to induce them to believe that they are buying a racquet of the Plaintiffs?

Now, if a manufacturer is bound to be more careful in one case of this kind than in another, it is where the necessity of manufacture imposes a similarity—an almost identical form. If "Demotic" had been placed on a racquet of entirely different description, a racquet made for a somewhat different game, the case would present itself certainly in a different manner. But I think that the Defendants wishing to find a name to distinguish their racquets, were bound to exercise extraordinary care in the selection, so as not to interfere with any manufacturer, because the form of the article was necessarily similar or almost identical.

His Lordship then reviewed the facts of the case, and gave judgment for the Plaintiffs with costs.

Appeal to the C. A. (Cotton, Lindley, and Bowen, LJJ. who had previously confirmed Kekewich, J.'s decision with regard to the patent.)

Appeal dismissed with costs.

COTTON, L.J.—It has been said here that all the Defendants have 6 R. P. C.
535, l. 53. done has been in accordance with the decision in the *Linoleum*

case (*supra*, p. 211), because they have taken the description, or rather the name, which the Plaintiffs had applied to their own lawn tennis bat, and that they are perfectly right in doing; that, now the patent is gone, they can make lawn tennis bats exactly like those which the Plaintiffs make, and they can use the name which the Plaintiffs have used for the purpose of describing this new lawn tennis bat. Now, I think I had better point out the great distinction there is between this case and the *Linoleum* case. In the *Linoleum* case there had been a new substance manufactured by the Patentee—that is to say, *Walton*, who had assigned to the Plaintiffs, had manufactured a new commercial substance. It was called floor-cloth, and it was to a certain extent floor-cloth,—but it was called Linoleum floor-cloth—Linoleum being a short description of it which was given by the Patentee to his new manufacture. It was a new substance, or at any rate, was a new manufacture, so as to be sufficient to entitle him to a patent for the new manufacture of it; and then, when the patent was at an end, that was the name which had been used by him for the purpose of describing the new article which he was offering for sale and selling to the public under the patent.

Now, here, this name, “The Demon,” is not confined to this new lawn tennis bat, if you can call it new—I will consider that presently—but it was a name connected with all those matters in respect of which this was registered as a trade mark of the Plaintiffs. It was applied, it is true, to this lawn tennis bat; but what was this lawn tennis bat? It was no new thing; it was only that a particular way of making the handle of this new lawn tennis bat was considered such a novelty that the Plaintiffs could take out a patent for it. It was decided that they could not, because it was considered there was no invention or difference in substance between that and any other lawn tennis bat; and that entirely distinguished it from the *Linoleum* case.

6 R. F. C
536, l. 36.

Then why was this name taken? I could understand the argument on behalf of the Appellants here much better if they had actually used the word “Demon,” because then “Demon,” it might have been said, would describe this new lawn tennis bat which has had this name applied to it by the manufacturer since he has manufactured it. But the Defendants have not done that; they have used another name, a name which cannot be taken to describe the manufacture of the particular lawn tennis bat to which the name “Demon” was applied; because, though the word “Demon” may point out the particular kind of lawn tennis bat with these

variations of grooves and enlarged end of the handle, yet "Demotic" certainly cannot do it. Now why was this name taken?

His Lordship referred to the cases of the Singer Sewing Machines and said :—

In the second case (*supra*, p. 306), it was held that the Defendant was not to be restrained from the use he had made of this word "Singer." Why? Because he had used it on his invoices and his advertisements in such a way as to satisfy the C. A., and the H. L. afterwards, that he was not using that in any way to attempt to describe the maker of the machine, and to gain any part of the credit belonging to the *Singer Manufacturing Company*, but using it only to describe the class of machine which he was advertising, and selling. * * But in the earlier case (*Singer Manufacturing Company v. Wilson*, 3 A. C. 376) there had been an injunction granted, or rather it had been sent back to the Court below to hear the case out, because the H. L. was not satisfied that the words "Singer Machine" were not used in such a way as to attempt to represent, not what the class of machine was, but who was the maker of the machine which the Defendant in the action was selling.

The injunction was modified so as to restrain the Defendants from stamping the word "Demotic" on their lawn tennis bats so as to represent that their lawn tennis bats are manufactured by the Plaintiffs or in any other way from passing off their lawn tennis bats as the goods of the Plaintiffs.

In lieu of destruction the Court (with the consent of the Plaintiffs) directed the word "Demotic" to be erased from the Defendant's racquets in the presence of the Plaintiffs or their agents.

SMITH v. HARRIS.

[June, 1883. 48 L. T. 869.]

Trade Mark—Production—Practice—R. S. C. 1875, Ord. XXXI, rr. 14, 16, 17.

Motion.

The Plaintiff, having commenced an action against the Defendant for infringement of a trade mark, consisting of the word "Glenlivet" and registered by the Plaintiff for whiskey, alleged in his Statement of Claim, paragraph 2, that during a certain period he and his father had used the word "Glenlivet" on their invoices, letters, and bill-heads, and had branded the same on their casks.

Upon the application of the Defendant an order was made in Chambers for production by the Plaintiff of all invoices, letters, bill-heads, and brands on casks referred to in the second paragraph of the Statement of Claim.

Motion to discharge this order refused.

48 L. T.
870.

CHITTY, J., referred to Statement of Claim, paragraph 2, and said:—It is said that that is only a general reference to documents, but, in my opinion, that is both a general reference and also a special reference to each and every bill-head, and each and every letter; because the Plaintiff instead of setting out each document separately refers to them compendiously, that is no reason why inspection should not be allowed. The result is that, in my mind, the case falls clearly within Order XXXI. r. 14. * *

The order is drawn so as to include “brands.” The only way in which a brand is used, is that the word “Glenlivet” is branded on the casks; and for the purpose of this motion I hold that casks are not documents, as I could not have made an order that the casks should be rolled into Court. * * The order must be rectified by striking out the words “casks branded with the word Glenlivet,” and the order, with this exception, will stand as made in Chambers, which is the common form order for production of documents.

RE THE SMOKELESS POWDER COMPANY LIMITED’S, TRADE MARK.

[February, 1892. 9 R. P. C. 109; (1892) 1 Ch. 590; 6 L. J. Ch. 391;
66 L. T. 407; 40 W. R. 507.]

Trade Mark—*Act of 1883*, ss. 64, *sub-s.* 2, 73, 74, *sub-ss.* 1 (b), 2—*Acts of 1883 to 1888*, s. 64, *sub-s.* 3 (i).

Motion to expunge.

In *March, 1888*, *The Smokeless Powder Company Limited* registered as a new mark an elaborate device consisting, amongst other things, of the disc of a target with the words “Smokeless Powder” round the upper half and the words “Company Limited” round the lower half.

In *January, 1892*, *The Schultz Gunpowder Co. Limited* moved to expunge this mark.

Motion refused.

9 R. P. C.
111, l. 27.

CHITTY, J.—It is said that the registration having taken place, as it did, under the Act of 1883, it was incumbent upon the Respondents to disclaim the term “Smokeless Powder.” It is

observable that the words "Smokeless Powder" form part of the Company's name. The Company has lawfully taken the name which I have stated. What is the meaning of the name in itself? It does not assert any monopoly of the right to make smokeless powder; but it merely is an indication to the public that this company manufactures and sells, or carries on a business relating to smokeless powder.

His Lordship referred to the Act 1883, sect. 64, sub-sect. 2, and sect. 74, sub-sect. 1 (b) and sub-sect. 2 (*supra*, pp. 9 and 11), and said:—That, therefore, which is to be disclaimed, in the language of the Legislature is, "a distinctive word or combination of words," and though it is common to the trade. Now, in my opinion, the words "Smokeless Powder" are not distinctive words or a distinctive combination of words. They are two ordinary English terms denoting that the powder is smokeless—that no smoke, or but little smoke, comes from the powder. That being so, it follows that no disclaimer is required. 9 R. P. C.
111, l. 53.

His Lordship dealt with the question whether the words were an addition to the trade mark (Act of 1883, sect. 74, sub-sect. 1), and after citing *Re The Apollinaris Company* (*supra*, pp. 51, 60) and *Pinto v. Badman* (*supra*, pp. 270, 272), continued:—

That therefore is enough for me, and upon these authorities it appears to me that the Applicants cannot succeed.—The Act of 1883 unquestionably did give rise to some difficult questions with regard to additional words and the like, but the Act of 1883 has been amended by the Act of 1888, and it is clear that, under the Act of 1888, the Respondent Company would not be required to disclaim the words in question because it is not to be required to disclaim its own name. That is by a proviso (I am speaking of the 64th section of the Act of 1883, as amended) which does not give rise to the argument that the Legislature, in framing the new section 64, considered that it was incumbent under the Act of 1883 to make the disclaimer, because the 64th section, as now placed on the statute book by the Legislature, contains a much clearer enactment with regard to what may be added, and the proviso as to not compelling the Applicant to disclaim his own name is a proviso which relates to the new matter in the section as to added words. 9 R. P. C.
112, l. 40.

SOMERVILLE v. SCHEMBRI.

[P. C., March, 1887. 4 R. P. C. 179 ; 12 A. C. 453 ; 56 L. J. P. C. 61 ; 56 L. T. 454.]

Appeal from the Maltese Court of Appeal.

Cigarettes manufactured by the Appellants' firm had become favourably known in Malta and elsewhere under the trade mark "Kaisar-i-hind."

In Malta there is no Law or Statute establishing the registration of trade marks, and no authority exists from which an exclusive right to a particular trade mark can be obtained.

An injunction granted by the Court of Commerce in Malta against the Respondents who were using "Kaisar-i-hind" in connection with cigarettes not manufactured by the Appellants, was dissolved by the Malta Court of Appeal on the ground that "Kaisar-i-hind" was used in England and elsewhere as a trade mark for hats, soap, pickles, &c.

Appeal to P. C. Appeal allowed.

4 R. P. C.
182, l. 38.

LORD WATSON.—The rights of the parties to this cause are dependent on the general principles of the commercial law, some of which are referred to in the judgment of the Court of Commerce.

* * As soon as a trade mark has been so employed in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes to that extent the exclusive property of the firm, and no one else has a right to copy it or even to appropriate any part of it, if by such appropriation, unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs. Had it not been for the views expressed by the Court of Appeal in giving judgment, it would hardly have been necessary for their Lordships to observe that the acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection with goods of a totally different character, and that such use by others can as little interfere with his acquisition of the right.

In the present case it is beyond dispute that these cigarettes, made by the Appellants' firm, were favourably known in the markets where they were sold, under the appellation of "Kaisar-i-hind." The use of the name by others as a name for ships or as a trade mark for hats, soap, or pickles, could not impede this

acquisition of an exclusive right to use that as a trade mark for their cigarettes.

Injunction granted to restrain the Respondents using a particular label especially complained of, and also from using the name or trade mark "Kaisar-i-hind" in connection with any cigarettes other than those manufactured by the Appellants' firm so as to represent or induce the belief that any such cigarettes were manufactured by the said firm.

RE SPEER'S TRADE MARK.

[January, 1887. 4 R. P. C. 521 ; 55 L. T. 880.]

Trade Mark—Act of 1883, s. 72.

Summons to proceed.

In 1886, *Joseph Speer* applied to register in Class 27, for linen and hemp piece goods, a new trade mark, the principal ingredients of which were a dog, a tower, and a harp.

The Comptroller refused registration on the ground of its resemblance to three marks (No. 3747 and two others), already registered in Class 27. Appeal to Board of Trade, who referred the appeal to the Court.

Registration refused.

KAY, J.—The Comptroller is in this position. This trade mark, No. 3747, is on the register with respect to linen goods. The present Applicant comes and asks to register his trade mark with respect to linen goods—the same goods. What the Comptroller has to consider is, "Are these so nearly resembling one another, as to be calculated to deceive? Am I to register a trade mark, which, when registered, and being put on the goods would be calculated to deceive?" I could quite conceive a case, in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying, "These marks are so nearly resembling one another, at any rate, that I will not by allowing the registration, encourage the use of a mark which may lead to litigation hereafter." It seems to me that is a matter which the Comptroller ought to consider. Then, I think the phrase "calculated to deceive" is used advisedly in this section of the Act. It means that the Comptroller has a right to consider the course of trade which is familiar to everybody, and must be very familiar to him, because he continually has to consider what amount of resemblance

4 R. P. C.
524, l. 40.

should prevent him from allowing the registration of a similar trade mark. To my mind it seems to be clearly within his duty to regard these considerations.

RE SPENCER'S TRADE MARK.

[C. A., February, 1886. 3 R. P. C. 73 ; 54 L. T. 659.]

Trade Mark—Old Mark—User of words—Act of 1875, s. 10.

Summons to rectify.

In 1868, *Walter Spencer* became entitled to a certain corporate mark granted by the *Sheffield Cutlers' Company*, which he thereafter used combined with the words "Diamond cast steel;" but he never used the words "Diamond cast steel" upon any goods except in combination with or by way of addition to the corporate trade mark. In the case of files he used to stamp the corporate mark on one side and the words on the other. In 1876, *Spencer* registered the words "Diamond cast steel" as an old mark for steel in Class 5, and files in Class 12. On a summons by a Sheffield firm to expunge this last mentioned mark, CHITTY, J. made the order asked. Appeal to the C. A. (Lord Esher, M.R., Lindley, and Lopes, L.JJ.), who affirmed the decision of CHITTY, J.

3 R. P. C.
74, l. 3.

Lord ESHER, M.R.—It seems to me that we are bound to apply to this case the test which was applied in *Palmer's* case, (*supra*, p. 261), and if we do so it follows, as a necessary consequence, that the mark which has been struck out is properly struck out. The question is this:—the thing registered is the words "Diamond cast steel," and that can only be a proper trade mark if these words were used as a trade mark before the passing of the Act of 1875. That leads us to this question:—Were those words, in fact, used as a trade mark before 1875? What is the test? It seems to me that *Palmer's* case says this:—"Is it usual in the trade?" How does a man use a trade mark in his trade? By putting it on his goods. By using it either by stamping it on his goods, or by putting a label on his goods. You do not use a trade mark by having it shut up in your warehouse; you do not use a trade mark by having it put up in your warehouse; and you do not use a trade mark by advertising it in a newspaper. It is only by putting it on your goods, so that when your goods are sold in the market there is the distinguishing mark. Therefore, the learned Judges said:—"In order to see what the user has been, we must take the things which were used in the market, and which were offered for sale or shewn in the market. When you

look at that you must see what was used on those goods as the distinguishing mark."

What was used before 1875 by this gentleman, was one distinguishing mark, which one mark was a combination of a mark which had been granted to his father by the *Cutlers' Company*, and a mark which he invented himself. The two together being put on his goods in order to distinguish his goods that made it one trade mark, and I do say this distinctly that, whether the things which are put on to make a distinction (for that is all that is wanted) are put close together, or are put at two ends of the same goods, or are put one on one side of the goods and one on the other, if they are on the goods for the purpose of making a distinction they are one mark, and the mere fact that, on the files, they have been put on the two sides, does not make them separate marks.

3 R. P. C.
74, l. 53.

LINDLEY, L.J.—We are asked to say that that is a proper registration, or that it is too late to rectify it. Now that turns entirely upon a question of fact, and the question of fact is whether these words so registered, "Diamond cast steel," apart from anything else, without anything to explain them, ever were, in the language of section 10, special or distinctive words used as a trade mark before the passing of the Act of 1875. Upon that question of fact it appears to me, I confess, the evidence is all one way. It is impossible to say they were because the evidence is that it was not so.

3 R. P. C.
75, l. 37.

LOPES, L.J.—We have to ask ourselves whether the words "Diamond cast steel" were special and distinctive words used by themselves as a trade mark before 1875. Putting that question to myself the only answer I can give is that they were not. In my opinion they were not used by themselves as a trade mark, but they were used in conjunction with something else, which, with the words in question, made up and composed the trade mark.

3 R. P. C.
76, l. 5.

STEINWAY & SONS v. HENSHAW.

[December, 1887. 5 R. P. C. 77.]

Trade Mark—Infringement—Resemblance.

Motion in action to restrain infringement.

In 1883 *Messrs. Steinway & Sons*, the well known manufacturers of pianos, New York, registered in England as an old mark for pianos the words "Steinway & Son" printed in old English letters. Early in 1887 they registered in England a mark (which they had

in fact used for 10 years on pianos sold in England) consisting in broad outline of a double S moulded into the form of a lyre.

In 1885, the Defendant, a piano manufacturer at Manchester, applied to register the word "Steinberg" (in Italian letters) and the device of a lyre, as a trade mark for pianos. The Defendant's lyre in broad outline consisted of a double S, and though differing in detail from the Plaintiffs' lyre, bore a general resemblance to it. The application was abandoned because of Messrs. *Steinway's* opposition. The Defendant continued to use his proposed trade mark, and this action was commenced. The motion was treated as if it were an application by the Defendant to proceed with the registration of his trade mark.

The Defendant gave an account of how he came to adopt the trade mark in question, and swore that when he adopted the word *Steinberg*, he never thought about *Steinway & Sons*, and that when he adopted the lyre, he did not know that the Plaintiffs used any device at all.

Injunction granted.

STIRLING, J., commented unfavourably on the story told by the Defendant, but did not find as a fact the Defendant had intentionally endeavoured to imitate the Plaintiffs' trade mark.

5 R. P. C.
80, l. 12.

STIRLING, J.—I cannot forget that he seeks to use that [device] and does use it in connection with the word *Steinberg*. Now I have to ask myself, Is the trade mark which he uses, looked at as a whole, calculated to deceive? It is not a question whether it is calculated to deceive the trade at all. The Court does not protect the trade, who are well acquainted, or supposed to be well acquainted with the various forms of instruments, but the public; and where, as in this case, a person who is not familiar with the details of the marks used by different manufacturers, but goes to buy a piano with some general notion that some foreign pianoforte makers have got a reputation, as the Plaintiffs have, trading under the name of *Steinway*, and use a mark which has got externally something like a double S outside of it, and certain things in it, I think that the Defendant's combination is very much calculated to deceive, and none the less that the pianos sold by the Defendant are very much cheaper and of lower quality than those sold by the Plaintiff.

EX PARTE STEPHENS.

[July, 1876. 3 Ch. D. 659 ; 46 L. J. Ch. 46 ; 24 W. R. 963.]

Trade Mark—Word—Act of 1875, s. 10.

Motion* for registration as a new trade mark of the Greek word AEILYTON (sic).

It was argued that the above combination of letters was a device.

Registration refused.

JESSEL, M.R.—The only question I have to decide is, what is the meaning of a trade mark within the 10th section? According to that section a trade mark consists of “one or more of the following essential particulars, that is to say, a name of an individual or firm impressed or woven in some particular or distinctive manner.” If the argument addressed to me were right, that any word would do, any word would include a distinctive word. The name of a firm is a very distinctive word indeed ; therefore that can hardly be so. It then proceeds thus : “or a written signature or copy of a written signature of an individual or firm”—Why should a written signature be specified, if any signature will do?—“or a distinctive device, mark, heading, label, or ticket ; and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures.”

3 Ch. D.
660

The word “figures” there means numerals ; therefore it is this, that you may add to this thing, which is a distinctive device, mark, heading, label, or ticket letters, words, or figures. Does not that shew that it is not a letter, or word, or figures itself? It may be added, Why does the Act give leave to add? You would never give leave to add words to words. Then it goes on, “Any special and distinctive word or words, or combination of figures or letters used as a trade mark before the passing of this Act may be registered as such under this Act.” That would be struck out of the Act if I were to adopt this construction. Here is a power to register a special and distinctive word, if used before the Act, shewing that it cannot be registered under the Act. Otherwise it would be contravening the well-known rule, that when there is a special affirmative power given which would not be required because

* Under the Act of 1875, if the Registrar declined to register a proposed trade mark, the proper course was to move to rectify the register by the insertion of the Applicant's name as the proprietor of the trade mark in question : *Ex parte Stephens*, 24 W. R. 819.

there is a general power, it is always read to import the negative, and that nothing else can be done, so that the power to register a trade mark used before the passing of the Act clearly negatives the conclusion that a distinctive word can be used as a trade mark first used after the passing of the Act.

3 Ch. D.
661.

There being power to register a distinctive word used before the Act, it is conclusive to my mind that it cannot be registered if first used after.

RE STRINGER'S APPLICATION.

October, 1891. 8 R. P. C. 445.]

Trade Mark—Practice.

In 1891, *Stringer*, the owner of an old mark registered in respect of iron, applied to register it for steel. The Comptroller-General refused to proceed with the application because there was a similar mark on the register belonging to a Swedish Company. *Stringer* moved the Court for a direction to the Comptroller to proceed, giving full information of the nature of the application to the Swedish Company. The latter took no notice, but there was ample evidence that the communication had reached them.

STIRLING, J. directed the Comptroller to proceed without prejudice to any opposition, the Applicant undertaking to give due notice to the Swedish Company of the advertisement.

RE THE SWIFT SPECIFIC COMPANY'S TRADE MARK.

[May 1889. 6 R. P. C. 352.]

Trade Mark—Registration—Disclaimer—Act of 1883, ss. 73, 74.

Summons to proceed.

In 1887, *The Swift Specific Company*, an American Company, deriving its name from an American named *Swift*, applied to register in Class 3 in respect of a patent medicine called "Swift's Specific," a new trade mark consisting of a distinctive device, but having in addition the words "Swift's Specific." The application was opposed by *Charles Henry Swift*, a chemist of Huddersfield (who also manufactured and sold a medicine called by him "Swift's Specific"), on the ground that the Company's mark would be calculated to deceive.

With regard to this, STIRLING, J., said:—

6 R. P. C.
354, l. 57.

We know that any man may make his medicine and vend it under his own name, and when opposed it must be done in such a

way as not to amount to fraud. I am not prepared to say that the use of the words "Swift's Specific," without something said or done to indicate that the goods sold by the Applicants were being sold as those of the Respondents, would be made a ground for saying that the latter was entitled to oppose, and I think that the application cannot be refused on that ground.

After the matter was adjourned into Court, an affidavit was filed on behalf of the Company consenting to disclaim the right to the exclusive use of the words, but in a subsequent affidavit the Opponent required the Company to distinguish their specific as an American one. As to this his Lordship said :—

In my opinion [the Opponent] was right down to the time the affidavit was filed by the Applicant, and afterwards wrong ; and therefore I think that the registration with the disclaimer should proceed, and I make no order as to costs.

6 R. P. C.
355, l. 21.

RE SYKES & CO.'S TRADE MARKS.

[November, 1880. 29 W. R. 235 ; 43 L. T. 626.]

Trade Mark—Cotton mark—Note on register.

Motion to proceed.

In 1880, Messrs. *Sykes & Co.*, a firm of calico bleachers at Edgeley, applied for registration of two old marks for cotton goods, consisting of a shield, or frame in the shape of a shield, with (1) letters indicative of the firm itself, (2) the representation of a swan, and also letters indicative of the firm. Varying letters were also used upon each mark, indicative of the date and packer of each parcel of calico.

The Committee of Experts placed these marks in the second Class (see *infra*, p. 391).

It was proved that it is the custom in the bleaching trade to place the bleachers' marks inside the folds of the pieces of calico, which are then stitched up ; that the manufacturers' and merchants' marks are placed outside ; that the bleachers' marks are only looked for by skilled buyers for shippers and retail dealers, who by these means are able to distinguish the parcels of calico which have been prepared and measured by particular bleachers. Calico bearing Messrs. *Sykes & Co.*'s marks was always recognised as having been bleached by them.

Messrs. *Sykes & Co.*'s Counsel offered an undertaking not to use the marks otherwise than in the folds of the calico.

29 W. R.
36.

HALL, V.-C.—It is urged on behalf of the application that the marks have no reference to quality, except as indicating that the goods have been bleached by a particular firm having a certain reputation, and it is said that by seeing these marks used and applied in a particular way, the public—in this case, the shippers and merchants—are able to distinguish the goods as being calicoes bleached by the Applicants. That being so, it appears to me upon the evidence that these particular marks are “distinctive” within the meaning of the Act, and not calculated to deceive, and as such should be registered in the first Class, provided that the Court is satisfied that they are so registered as not to be liable to be confused with other marks which may be used in the trade to denote the particular manufacture and quality of cotton goods. I consider that the undertaking offered will be sufficient protection against any misuser of the marks. That undertaking ought to be given with reference to each mark, and I should not have directed registration without it. It having been given, registration ought to proceed as if the mark had been placed in the first Class, and a note of the undertaking will be entered on the register as in *Whiteley's* case, (*infra*, p. 343).

TALBOT v. WEBLEY;

RE TALBOT'S TRADE MARK.

[July, 1886. 3 R. P. C. 276.]

Trade Mark—Special and distinctive word—Act of 1875, s. 10.

Cross motions.

Prior to 1875 the Plaintiff bought the business of one *Gearing*, a manufacturer of fire-proof and burglar-proof safes. In 1876 he registered as an old trade mark for safes the word “Baffle.”

Gearing had formerly owned a patent now admittedly invalid for certain bars to be affixed to safes generally known as “Baffle” bars.

The Defendant in his price-list of safes advertised “Baffle” bars. The Plaintiff moved for an injunction in an action against the Defendant for infringement, and the Defendant moved to expunge the Plaintiff's trade mark. BACON, V.-C., refused both motions with costs.

3 R. P. C.
277, l. 19.

BACON, V.-C.—I cannot find that [the Defendant] uses [the word “Baffle”] as a trade mark, or that by any stretch of imagination or any twisting of the words it can be said that when he publishes a price list of a variety of iron safes, and in the description below

them he says, some may be fixed up with "Baffle" apparatus and some not, there is any invasion of the Plaintiff's right. * * *

[The Plaintiff] had a right to select any name he liked. It appears that he had a very good right and a very good reason for taking the word "Baffle," and if anybody sells safes with the trade mark "Baffle" upon them, they would invade his right.

RE THOMPSON'S TRADE MARK.

[December, 1888. 6 R. P. C. 213.]

Trade Mark—Fancy word—Act of 1883, s. 64, sub-s. 1 (c).

In 1888, *S. Thompson & Co. Limited*, of the Manor Works, Wolverhampton, tin and terne plate manufacturers, applied to register "Manor" as a new trade mark for tin and terne plates.

NORTH, J. held the case was covered by *Re Van Duzer's Trade Mark* (*infra*, p. 334), and refused registration.

A different objection had been raised by the Comptroller when the case was before him. With his consent, therefore, no order was made as to costs.

THOMPSON v. MONTGOMERY ;

RE JOULE'S TRADE MARKS.

[H. L., May, 1891. 8 R. P. C. 361 ; (1891) A. C. 217 ; 60 L. J. Ch. 757 ; 64 L. T. 748.]

Trade Mark—"Stone Ale"—Act of 1883, s. 74.

Prior to 1888 the Plaintiffs and their predecessors in title had for upwards of a century carried on business at Stone, a small town in Staffordshire, under the name of *Joule & Co.*, there having been practically speaking no other breweries carried on there. The ales manufactured by the Plaintiffs had gained a high reputation, and, although in advertising them the name of *Joule & Co.*, under which the brewing business was carried on, had generally been associated with the words "Stone Ale," it was proved beyond dispute that the Plaintiffs' ales had become known to the market, and to the public, under the terms "Stone Ales" or "Stone Ale," the latter being exclusively applied to a particular quality of beer, and that anyone asking for "Stone Ale" or "Stone Ales," would desire to be supplied, and expect to be supplied, with the ale manufactured by the Plaintiffs. The Plaintiffs had in 1881 registered five trade marks each consisting of a distinctive device and including the words "Stone Ale" or "Joule's Stone Ale." In 1888 they registered "Stone Ale" (No. 74,764) as an old trade mark.

The Defendant, *Thomas Montgomery*, was a licensed victualler at Liverpool, and sold the Plaintiffs' ale in his business as "Stone Ale." In *April*, 1888, the Defendant commenced to build a brewery in the town of Stone, being induced to do so, as he said, by the superior quality of the water there and the convenience of the place with respect to railway accommodation. He caused a board to be placed over the unfinished building containing a notice that the brewery was to be called "Stone Brewery." The Defendant also designated his ales "Stone Ales." The Plaintiffs thereupon commenced an action and moved against the Defendant for an injunction to restrain him from selling or advertising under the names "Stone Ales" or "Stone Ale" any ale or beer not made by the Plaintiffs, and from carrying on the business of a brewer under the title of "Stone Brewery" or "*Montgomery's* Stone Brewery," or any other title calculated to induce the belief that the business carried on therein was the Plaintiffs' business, and from infringing the Plaintiffs' trade marks.

The Defendant moved to rectify the register of trade marks by adding to the registration of the Plaintiffs' trade marks a note disclaiming any exclusive right to the word "Stone," or by removing such word therefrom, or for such other rectification as might be just.

The two motions were heard on the 9th of *November*, 1888 by CHITTY, J. (6 R. P. C. 404, 41 Ch. D. 35), who granted an injunction restraining the Defendant until judgment or further order from carrying on the business of a brewer at Stone, under the title of "Stone Brewery" or "*Montgomery's* Stone Brewery," or under any other title so as to represent that the Defendant's brewery was the Plaintiffs' brewery, and from selling any ale or beer not the Plaintiffs' under the terms "Stone Ales" or "Stone Ale," or in any way so as to induce the belief that such ale or beer was of the Plaintiffs' manufacture, and from infringing the Plaintiffs' registered trade marks or any of them. The motion to rectify was dismissed.

Appeal to the C. A. (Cotton, Lindley, and Lopes, L.JJ.).

The C. A. held (1) that the injunction was rightly granted ; (2) that "Stone Ale" by itself must be removed from the register, there being no evidence of user of the words (No. 74,764) alone as a trade mark before 1875 ; (3) that, with this exception, the motion to rectify failed.

The hearing of the motion was by agreement between the parties taken as the trial of the motion, and the injunction was accordingly made perpetual.

LINDLEY, L.J.—As regards rectification of the register, the notice of motion before CHITTY, J. did not in terms seek to rectify the register by striking out No. 74,764, although an order to that effect might have been made by the Judge if he had been asked to make it under the general words at the end of the notice of motion, those general words being that “such further or other order may be made for the rectification of the register as to the Court shall seem just.” But that, however, was not what the Applicant wanted. What the Applicant wanted and asked for by his notice of motion was something totally different, and that was to compel the Plaintiffs to disclaim, or in other words to discontinue the use of the word “Stone” in every one of the six trade marks which they had registered. That application was made under section 74 of the Patents, Designs, and Trade Marks Act of 1883, and it appears to me that the application is not warranted by the section. The section only applies where there are words and figures, and so on, common to the trade. Nothing, I apprehend, can be common to the trade, which is used only by one person in the trade. We have not any such words as “Stone Ale,” common to any trade here, but they were exclusively used by the Plaintiffs in their trade, and it appears to me that that section does not apply at all, and that its language does not fit the case.

6 R. P. C.
412, l. 9.

Appeal by the Defendant to the H. L. (Lords Herschell, Watson, Macnaghten, Morris, and Hannen). Appeal dismissed.

Lord HERSCHELL.—It was not contended at your Lordships' Bar by the learned Counsel for the Appellant that no injunction ought to have been issued, nor did they take exception to the terms of the injunction, save in one respect. They insisted that the Appellant ought not to have been restrained from “selling or causing to be sold any ale or beer not of the Plaintiffs' manufacture under the term ‘Stone Ales,’ or ‘Stone Ale.’” They contended that such an injunction was too wide in its language; that the Plaintiffs had no property in the word “Stone” as applied to ale, and that they could not monopolise the use of the name of that town merely because for a time they had been the only brewers there, and exclude the rest of the public from employing it to describe the place of origin of such beer as they might choose to brew there. I do not think the principle on which the Court ought to act in such a case as the present is open to doubt. The Respondents are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public

8 R. P. C.
365, l. 13.

into the belief that they are obtaining the ale of the Respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if the persons seeking the injunction had a right of property in a particular name.

It appears to me idle to argue in opposition to the injunction that it is against the public interest to permit a monopoly of the use of the name of a town for trade purposes, when the only effect of allowing its use by the person, and for the purpose sought to be restrained, would be to deceive the public. The injunction might, no doubt, have been framed in more general terms, and thus have been free from the objection raised ; but had it been so, the same question as has been discussed at the Bar would have arisen on an application to commit the Defendant for breach of the injunction in respect of his selling his ale as "Stone Ale" ; and the Court having come to the conclusion that he could not sell the liquor manufactured by him under that name without inducing the belief in the mind of the purchaser that he was obtaining the Plaintiffs' ale—a conclusion from which I see no ground for differing—I do not think that it was improper to frame the injunction in the form adopted, and thus to determine the question at once, instead of leaving it to be raised and contested on an application to commit. * * *

I see no reason to think that the Court below has erred in making the order appealed from, and I therefore move your Lordships that it be affirmed, and the appeal dismissed with costs.

8 R. P. C.
366, l. 24.

LORD WATSON.—The Defendant does not resist an injunction, and he takes no exception to the order of the C. A., in so far as it relates to the title of his brewery or to the Plaintiffs' trade mark. But he objects to that part of it which prohibits him from selling ale or beer other than the Plaintiffs' under the terms "Stone Ales," or "Stone Ale," which are not registered trade marks. He maintains that the prohibition as it stands is too stringent ; that he has a legal right to use one or other or both of these terms in describing ale or beer brewed by him at Stone, so long as he uses them in combination with other words which sufficiently distinguish his manufacture from that of the Plaintiffs, and that the injunction as framed deprives him of that right.

The precise terms in which an injunction ought to run must depend upon the particular facts of the case. In the present case I feel somewhat hampered by the consideration that the only appeal is at the instance of the Defendant, and the injunction

cannot be recast in any way to his disadvantage. Had the matter been open, I should have preferred an order restraining the Defendant "from using the word 'Stone' as descriptive of or in connection with ale or beer manufactured by him, or ale or beer (not "being of the Plaintiffs' manufacture) sold or offered for sale by him, "without clearly distinguishing such ale or beer from the ale or beer "of the Plaintiffs." That was substantially the form adopted by Lord HATHERLEY (then Vice-Chancellor) in *Seixo v. Provezende* (L. R. 1, Ch. App. 192), which was confirmed on appeal by the LORD CHANCELLOR (Cranworth), and it was followed, after consideration by this House in *Johnston v. Orr-Ewing* (*supra*, p. 249). But it appears to me that an injunction in these or similar terms would involve a prohibition against selling ale or beer other than the Plaintiffs' under the terms "Stone Ales" or "Stone Ale," and might in other respects be more stringent than the order as settled by the LJJ.

In these circumstances I have come to the conclusion that the best course to follow in this case is to affirm the order of the C. A.

Lord MACNAGHTEN.—It is not the first time in these cases that water has got an honest man into trouble and then failed him at the pinch. Neither CHITTY, J. nor the learned LJJ. could be persuaded that the Appellant was attracted to Stone by the peculiar virtue and chemical properties of the water. They thought he went there simply with the object of stealing the Plaintiffs' trade, and in the hope of reaping where he had not sown. They were satisfied that he meant to make a fraudulent use of the term "Stone Ales," and that he could not possibly use that term honestly.

8 R. P. C.
367, l. 30.

With the judgment that has been passed upon his character and conduct the Appellant does not quarrel. Protesting that it was somewhat harsh, his Counsel use it to point their argument. Granted, they said, that the Appellant is a fraudulent man—as fraudulent as you please—still his demerits cannot enlarge the Plaintiffs' rights. The injunction being absolute and unqualified in its terms will secure to the Plaintiffs the monopoly of brewing in Stone. With such water Stone might be as Wrexham or Burton. The injunction makes it the private preserve of the Plaintiffs. Then, they argued, the Appellant is not to be deprived of his rights because he has behaved badly. All the Court ought to do is to keep him strictly within his rights. He had a perfect right as everybody has to set up a brewery in Stone. Ale brewed in Stone is Stone ale for all that the Court can say or do. The

Appellant is entitled to call his ale what it really is, and to sell it under its true name if he takes care that his customers are not induced to believe that it is of the Plaintiffs' manufacture.

My Lords, I confess I feel the force of these arguments, and I should be disposed to give some effect to them if it were not for the peculiar circumstances of the case. The order, it will be remembered, was made first on an interlocutory application. The Appellant had announced his intention of selling his ales as "Stone Ales." The Court held that that would be a fraud and that nothing could justify it. So the Court interfered to prevent the particular fraud which the Appellant was at the time threatening to commit. I apprehend that under the circumstances the interlocutory order was right. Is the order right now that it has been made perpetual?

My Lords, there are two considerations which lead me to think it ought not to be disturbed. In the first place, I cannot forget the way in which the Order came to be made perpetual. Though the Order was certainly not a consent order, it was made on the invitation of the Appellant. It may be that if it had not been for that invitation—if the action had followed its regular course—the injunction would have been in a different form. Under these circumstances I apprehend that your Lordships would be slow to alter it to the disadvantage of the Plaintiffs. In the next place I do not see my way to alter it at all, except by making it more stringent and more severe; and that would hardly be fair to the Appellant on his appeal. * * *

It is obvious, I think, that if the injunction had been in [the same form as in *Seixo v. Provezende*,] the Appellant could not have used the term "Stone Ales" at all. It would have been impossible for him to have distinguished his ales from those of the Plaintiffs. Any attempt to distinguish the two, even if it were honestly meant, would have been perfectly idle. Thirsty folk want beer not explanations. If they get the thing they want, or something like it, and get it under the old name—the name with which they are familiar—they are likely to be supremely indifferent to the character and conduct of the brewer and the equitable rights of rival traders.

For these reasons, though I think the form of the injunction is open to objection, I agree that the appeal must be dismissed.

TOWGOOD BROTHERS v. ALEXANDER PIRIE & SONS,
LIMITED ; RE TOWGOOD BROTHERS' TRADE MARKS.

[February, 1887. 4 R. P. C. 67 ; 56 L. T. 394 ; 35 W. R. 729.]

Trade Mark—Fancy word—Act of 1883, s. 64, sub-s. 1 (c).

Cross motions.

In 1885 the Plaintiffs registered the word "Jubilee" as a new mark for water-marked paper. On their commencing an action and moving against the Defendants for infringement, the Defendants moved to expunge the mark.

Mark expunged. Plaintiffs' motion refused.

CHITTY, J., after referring to *Re Van Duzer's Trade Mark*, (*infra*, p. 334), said :—As far as I have gathered, the C. A. did not lay down this proposition which I am about to enunciate in so many words, namely, that a word or words cannot be a fancy word or fancy words not in common use under the Act, where the word or words are common English words, but fancifully applied. But it does appear to me that their judgments go to negative the right of any person to register a trade mark consisting of a word or words only, where the word is a common English word, and only the application is fanciful. I am not quite sure that that is the true effect of their judgments, but of this I am satisfied, that they did hold that the word must be obviously meaningless as regards the particular goods or the article to which it is applied, and I am satisfied that, taking that proposition as one which is the result of all the judgments, the word "Jubilee" is not capable of being registered with reference to notepaper, because it may be notepaper which is produced in the Jubilee year. I have said the Jubilee year. [Counsel] argued at some little length that the word "Jubilee" was not a good English word, but it is plain it is a common English word, and used also without reference to the term "year."

4 R. P. C.
69, l. 19.

UPMANN v. FORESTER.

[June, 1883. 24 Ch. D. 231 ; 52 L. J. Ch. 946 ; 49 L. T. 122 ; 32 W. R. 28.]

Trade Mark—Innocent Consignee—Costs.

Motion.

The Defendant, who was a china manufacturer, purchased abroad for his own private use 5,000 cigars which were consigned to him at the docks here in cases bearing a spurious brand, purporting to be that of the Plaintiffs, who were cigar manufacturers. The

Defendant was not aware that the brand was spurious, nor, except from seeing it on the invoice, that any such brand was in use.

The Plaintiffs having discovered that the cases in question were standing to the order of the Defendant at the docks immediately, and without any communication with the Defendant, issued a writ, and served the Defendant with notice of motion for an injunction to restrain him from selling the cigars. The Defendant thereupon stated that he had no intention of selling the cigars, and offered all the relief asked for by the writ, and afterwards on the hearing of the motion agreed to an undertaking in the terms of the writ, the question of costs being reserved.

CHITTY, J. held that the Defendant must pay all the costs of the action.

24 Ch. D.
234.

CHITTY, J.—The first point is: Has there been an infringement? The Defendant has imported into this country 5,000 cigars in boxes bearing a spurious trade mark. He says he was not aware of any infringement of the Plaintiffs' right until he was served with the writ, and that he never intended to sell or distribute the boxes. Although it may be the Defendant's misfortune that the boxes should bear a spurious trade mark, yet, according to the authorities, he must be held to have committed a clear infringement of the Plaintiffs' right sufficient to entitle the Plaintiffs to an injunction for the purposes of this action.

24 Ch. D.
235.

Now the next question is: Ought I to deprive the Plaintiffs of their costs because they did not give the Defendant notice before commencing their action? I do not think that is a case where it would be just for me to deprive the Plaintiffs of their costs. A Plaintiff in these cases is placed in circumstances of difficulty, because if he were to give notice there is a great probability of the Defendant at once getting rid of the spurious articles before the Plaintiff could interfere; and the Plaintiff, therefore, by giving notice would in many instances be affording the Defendant an opportunity of doing that which an injunction would have prevented. I well remember that the late M.R., Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once.

His Lordship referred to *Upmann v. Elkan*, L. R. 12 Eq. 140, 7 Ch. App. 130, and continued:—

24 Ch. D.
236.

I therefore hold that it is clear on the authorities that it is not necessary in a case like the one before me to give notice. I have also held that there has been an infringement. The Plaintiffs,

therefore, are clearly entitled to their costs. The result of my decision, however, will not be, as the Defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the C. D. for infringing a patent or trade mark. I cannot pass over the fact that there is in the present case a large consignment of goods; 5,000 cigars is rather a large order for personal consumption, and the Plaintiffs were justified in suspecting that so large a consignment was intended for distribution. The Defendant merely says that they were intended for family use. The term is not very definite, and one which might easily cover a sufficiently wide distribution of the goods to establish clear evidence of user.

UPPER ASSAM TEA COMPANY v. HERBERT.

[C. A., July, 1889. 7 R. P. C. 183.]

Trade Mark—Trade name—Infringement.

Motion in an action for infringement.

In 1877, the Plaintiffs registered a device of an elephant as an old trade mark for tea. In 1876, the Defendant registered the device of an elephant as a new trade mark for coffee.

The two devices (illustrations of which appear, 7 R. P. C. 183—4) were different. In 1889, the Defendant commenced to put his trade mark on packets of tea, stating on the packets that it was the "Elephant Brand" for coffee.

STIRLING, J., granted an injunction. Appeal to the C. A. (Cotton, Fry, and Lopes, LJJ.). Appeal dismissed.

COTTON, L.J.—It is not a question of whether [that which the Defendant is doing] necessarily is deceptive, but whether there is not a strong probability of its causing deception, and whether the Plaintiffs do not make out a strong *prima facie* case which, in all probability, at the hearing they will succeed in converting into a final decision as against the Defendant. I think there is sufficient similarity. I do not say that the Plaintiffs can claim all elephant marks, but one looks only at these particular elephant marks, and although there is the difference of the elephant in the Defendant's mark turning his head in a most inconvenient way, yet I do not think that that, and the fact that the Plaintiffs' elephant is in profile, are sufficient to prevent this mark used by the Defendant from being passed off as the Plaintiffs'. 7 R. P. C.
186, l. 34.

RE VAN DUZER'S TRADE MARK ;
RE LEAF'S TRADE MARK.

[C. A., January, 1887. 4 R. P. C. 31 ; 34 Ch. D. 623 ; 56 L. J. Ch. 370 ;
56 L. T. 286 ; 35 W. R. 294.]

Trade Mark--*Fancy word*—*Act of 1883, s. 64, sub-s. 1 (c)—Costs.*

Motion to proceed.

In 1880, *S. R. Van Duzer* of London, invented and began to sell a preparation which he called and sold as “Melrose Favourite Hair Restorer,” and in 1885 he applied to register those words as a new trade mark for a toilet article in Class 48.

In 1878, *Leaf Son & Co.* began to use the word “Electric” in connection with their cotton velvets, and velveteens (in which they had done a trade for 40 years), and in 1886 they applied to register the words “Electric Velveteen” as a new trade mark for velvet and velveteens.

The Comptroller in each case refused registration. The Applicants appealed to the Board of Trade, and on the matter coming before the Court in the usual way, BACON, V.-C. directed registration of both trade marks (3 R. P. C. 241, 289).

Appeal to the C. A. (Cotton, Lindley, and Lopes, LJJ.) who held that neither of the words in question was a fancy word and reversed the V.-C. in each case. The evidence shewed that the trade had recognized goods to which the marks were affixed as being in each case the goods of the respective Applicants.

4 R. P.
35, l.

COTTON, L.J.—The evidence goes to this ; that if the Act had not been passed, [the Applicants] have on the evidence before the Court, made out such a case as would entitle them to protection in respect of the use of these particular words. To my mind that is not pertinent here. If they had been used before *August, 1875*, the Act would have given a right in consequence of that user, to have these words registered. What we have to consider is this : whether the words come within the description of those things which the Act allows to be registered before giving them the privileges of registration. (His Lordship read the Act of 1883, sect. 64, sub-sect. 3 (*supra*, p. 9), and continued :)—In my opinion that excludes the Respondents from relying on user as a trade mark subsequent to that date.

4 R. P. C.
35, l. 28.

It is said that the evidence shews that these words are now considered as fancy words in the trade. I do not think that is so, because it is only recognized as the trade mark of this individual ;

and in my opinion what Counsel put in reply was a matter to be considered,—Have the words lost their original meaning? No, and they have not come to be fancy words in any way except this, that they have been recognised by the trade as designating that the goods are the goods of the Applicants—that is, recognised as their trade marks.

I do not think one could say that no geographical term could possibly be “a fancy word or words” as applied to a particular article; but in my opinion here it would be wrong to allow the registration of these words, “Melrose Favourite Hair Restorer.” Why? It must be a fancy word; and in order to come within that description, it must be a word which obviously cannot have reference to any description or designation of where the article is made, or what its character is. * * * I give no opinion on what might be the result when a case comes before us where it is sought to register the name of a place which is known to all, and is obviously inapplicable to the articles—whether that should be registered or not, but here in my opinion it is not so obvious that this cannot be taken as describing the goods as made at Melrose; and that being so in my opinion the objection is right.

4 R. P. C.
36, l. 58.

Is the word “Electric” to be considered as a fancy word? * * * In my opinion a word may not be registered as a trade mark if it is fancifully used, but only if it is a fancy word; and in my opinion we must consider whether it can properly be said that “Electric” is a fancy word, even though applied to velvet or velveteen. If it was obviously meaningless as regards the particular goods, possibly it might be considered as a fancy word, but “Electric” is a word of description, not a fancy word. * * * When the word is, like this “Electric,” *primâ facie* a descriptive word, it is, in my opinion, wrong to say that it ought to be registered as a fancy word simply because it is used inappropriately and wrongly as regards the particular object.

4 R. P. C.
37, l. 38.

LINDLEY, L.J.—What is meant by a fancy word is not explained by the Act of Parliament, and we are left to ascertain its meaning as best we can. In order to do so I think we are entitled, upon every principle which we are in the habit of acting upon with reference to Acts of Parliament, to consider a little how this expression came into the Act. What was it that led to its insertion? As to this we are not in the dark. It was put in to cure the defect which came to light in the case of *Ex parte Stephens* (*supra*, p. 321), where, under the words of the Act of 1875, the M.R. found himself unable to cause to be registered a

4 R. P.
38, l. 35.

word which I suppose was intended to be Greek, but was certainly intended to be a fancy word, viz., "AEILYTON," with reference to ink. That he could not do, and he could not do it because under the Act of 1875 there was no provision for registering as a trade mark any word or words unless they have been used as trade marks before *August, 1875*. * * * To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word "Eureka" or the word "AEILYTON," or if it has any meaning at all, it must be obviously meaningless* when used as a trade mark.

R. P. C.
39, l. 16.

I am not prepared to go the length of saying that no word you can find in any map, in any part of the world would not do, but when you come to a well-known place that is a different matter; then it does suggest a meaning, and not being obviously meaningless, it is not a fancy word as I understand this expression in the Act of Parliament. If "Melrose" is not a fancy word *à fortiori* is not "Electric." "Electric" suggests a meaning. I do not mean to say it has a meaning.

4 R. P. C.
39, l. 50.

LOPES, L.J.—I think a word to be a fancy word must be obviously meaningless as applied to the article in question. I think it must be a word fanciful in its application to the article to which it is applied in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive, nor calculated to suggest the deception or description. Further than that, I think, that the word must have an innate and inherent character of fancifulness which must not depend on evidence, and cannot be supported by evidence to shew that in fact it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive. What I mean is that a fancy word, in my opinion, must speak for itself, it must be a fancy word of its own inherent strength.

Counsel for the Applicants asked that under the circumstances the Court would not order them to pay the Comptroller's costs.

4 R. P. C.
40, l. 26.

COTTON, L.J.—I think in these cases, taking them really as test cases brought forward by the Office, it is right, that there should be no costs, but we treat them as exceptional cases, and do not intend in any way to overrule the ordinary practice in such cases.

* Subsequently corrected by Cotton, L.J., with the consent of Lindley, L.J., to "obviously not intended to be descriptive." (See 34 Ch. D. p. 645.)

RE VIGNIER'S TRADE MARK.

[July, 1889. 6 R. P. C. 490.]

Trade Mark—Aggrieved person—Descriptive word—Act of 1883—International Convention, 1883.

Motion to rectify.

In 1884 (before the date of the International Convention), *P. L. F. E. Vignier* registered as a new trade mark for Champagne, &c. a black label with the word "Monobrut" in inverted commas in the middle, the words "Special Cuvée" in one corner, and the word "déposé" in another. The mark was not used to any extent till it was purchased in December, 1888, by *Lemaitre & Co.*, who in the following year commenced to advertise Champagne very extensively with the word "Monobrut." In May, 1889, *S. Richards & Co.*, the English agents of *Heidsieck & Co.* (wine merchants of Rheims), who had, since 1862, used the words "Monopole" and "Dry Monopole" as descriptive of their Champagnes, and had in 1883 registered in England these words as trade marks, moved to expunge the "Monobrut" trade mark. It was proved that "brut" means in the trade "raw or dry wine," and it was admitted that the word "Monobrut" was chosen as a special name for "dry" or "brut" Champagne prepared according to a particular process.

KAY, J., held that the word was descriptive, and that the trade mark must be expunged. The question was raised whether the Applicants had a *locus standi* as persons aggrieved.

KAY, J., said:—"Monopole" and "Monobrut" have, at the first blush, a sufficient similarity to make it possible (I need not go any further) that [Messrs. *Heidsieck's*] trade may be somewhat interfered with if Champagne is to be sold in this country under the name of "Monobrut." Therefore I consider they are persons aggrieved, and as such, they are persons who have a *locus standi* to make this application. 6 R. P. C.
492, l. 27.

The "Monobrut" mark had also been registered in France. It was therefore suggested, that as it could have been subsequently registered in England under the International Convention, the existing English registration must be treated as good.

KAY, J.—The simple answer to that is this—that it certainly was not put upon the register in consequence of the Convention, because the Convention had then no existence. If that is the only reason for putting it on the register, the right thing to do was before those four months had expired, to apply to expunge it from 6 R. P. C.
493, l. 22.

the register, and then to make an application within four months to have it put on the register in consequence of the Convention. The parties did not take that course. The conscience of the person was not sufficiently awakened to do that, and to ask me now, although no such application of that sort was made, to decide that it was properly put on the register, which is the only point before me now, because of the Convention made some time afterwards, is to ask me to do that which I cannot do. The question before me is, whether this was properly put on the register. As it was not properly put on the register when it was put on the register, I must order it to be expunged from the register.

RE THE WALKDEN AËRATED WATER COMPANY'S APPLICATION.

[June, 1877. 54 L. J. Ch. 394n.]

Trade Mark—Three mark rule—Act of 1875, s. 6.

Motion to proceed.

In 1876, *Thomas Cockcroft* of Birkenhead applied to register, and he subsequently registered, as an old trade mark for mineral and aërated waters, the device of a cock within a shield surrounded by a double circle bearing the words "*Cockcroft's Mineral Waters.*"

In the same year *Robert Thompson* of Bishop Auckland applied to register as an old trade mark, for the same waters, the device of a cock (about the same size as the cock in *Cockcroft's* mark) standing on a soda-water bottle and surrounded by a double circle bearing the words "*R. Thompson, Bishop Auckland.*"

An application was now made on behalf of the above-mentioned Company to register as a new trade mark for aërated waters of all kinds, the device of a cock (very much smaller than those contained in the two old marks) surmounting a dark disc in the centre of which was "*W.*" in white.

The Registrar refused registration. The Company having obtained *Cockcroft's* consent to their registration, moved that the Registrar might be directed to register their mark.

54 L. J.
Ch. 395n.

JESSEL, M.R.—The cock is one of the commonest birds in the world, and it is very difficult to understand why the Company should take it when others have done so before them. There is no end of the number of these birds in the different trade marks, and they are so common that they distinguish next to nothing. The Registrar could not help registering *Mr. Thompson's* mark as well

as Mr. *Cockcroft's*, because they are both old marks. This is a new one. I was much impressed, however, with the fact of Mr. *Cockcroft's* assent; and, if it is worth while, the Company may communicate with Mr. *Thompson* and see if they can get over the further difficulty occasioned by his trade mark. * *

If this mark is registered, then there will be the full number of three on the register. * * * I must require Mr. *Thompson's* consent to be obtained, for the marks are substantially the same, and I have no doubt that I should grant an injunction to restrain the Company from using their mark as against the other trader if I found that any mistake had occurred amongst the customers. If he consents, there will only be three then, and the Lord CHANCELLOR has intimated his opinion that where there are more than three, it ceases to be a distinctive trade mark.

[Mr. *Thompson's* consent appears to have been subsequently obtained, as the Company's mark was duly registered.]

RE WARD, STURT & SHARP'S TRADE MARKS.

[February, 1881. 50 L. J. Ch. 347; 44 L. T. 97; 29 W. R. 395.]

Trade Mark—Rectification—Act of 1875, s. 5.

The powers given to the Court by the Trade Marks Registration Acts, to rectify the register of trade marks, are only exercisable in cases where there has been some mistake or error in the registration, and not in cases where a change is desirable in consequence of a devolution of interest (Per Hall, V.-C.).

RE WATERMAN'S TRADE MARK;

WATERMAN *v.* AYRES.

[C. A. May, 1888. 5 R. P. C. 368; 39 Ch. D. 29; 57 L. J. Ch. 893; 59 L. T. 17; 37 W. R. 110.]

Trade Mark—Fancy word—Passing off—Act of 1883, s. 64, sub-s. 1 (c).

Cross motions.

In 1887, the Plaintiff registered the word "Reversi" as a new trade mark in Class 49, for "a game somewhat analogous to draughts." This game he had brought out in 1882, and had thenceforth sold in large quantities under the title of "Reversi." In 1886 the Defendant brought out a similar game under the name of "Annex," and in *February*, 1888, he began to call it "Annex, a game of reverses." Both games were modifications of a game called "Annexation," and though different in detail, were

identical in principle, namely, the reversal of any of the counters of the one player which came between two counters of the opposite player. It appeared that the word "reversi" or "reverses" was an obsolete French word for a game of cards in vogue in France in the 16th century. The Plaintiff brought an action against the Defendant to restrain infringement and passing off, and moved for corresponding interlocutory injunctions.

The Defendant denied any attempt to pass off his game as the Plaintiff's, and stated that he used the words "a game of reverses" to indicate the nature of the game, and moved to expunge the the Plaintiff's trade mark. KAY, J., granted both injunctions asked for by the Plaintiff, and refused the Defendant's motion.

Appeal to the C. A. (Cotton, Fry, and Lopes, L.JJ.), who discharged the injunctions and expunged the Plaintiff's trade mark.

5 R. P. C.
371, l. 15.

COTTON, L.J.—[The word "Reversi"] has been registered * * as a fancy word. I think that "distinctive" must apply to a fancy word as well as to the rest, and so we expressed our opinion in the *Melrose* case (*supra*, p. 334), but it is unnecessary to enter into the question of whether it is distinctive, or whether it is not in common use, because, in my opinion, it cannot properly be said, that within the meaning of the Act of Parliament, this word "Reversi" is a fancy word.

5 R. P. C.
371, l. 15.

His Lordship expressed his adherence to *Re Van Duzer's Trade Mark* (*supra*, p. 334), and said:—"Melrose" we thought might be —although when we heard the evidence it could not be in the particular case—descriptive of the place where the particular article in that case, namely, Hair Restorer was made. Here "Reversi," I agree, is not an English word, and except as a name applied to that particular game known in England, and known also in France, it is not a French word * * It is a word I find in the Dictionary—a substantive applied to a particular game.

Now is not this word obviously intended to describe the game in connection with which the Plaintiff uses it? In my opinion it is. It is very true that an ordinary Englishman must not be assumed to know French, and I should think an ordinary Englishman would not be assumed to know that the name had been used in connection with the game of cards to which it had been applied both in France and in England, but he would, most probably, consider the word "Reversi" to be in some way connected with reversing, and one finds that the word is used in the rules of the game issued by the Plaintiff in which he calls attention to how the game "Reversi" is to be played,

His Lordship read two of the rules of the Plaintiffs game, both of which contained the word "reverse," and continued :—Although I should not think an Englishman would understand that there was a French verb "*reverser*," which did not mean "turn over," yet an ordinary Englishman, not knowing French or foreign languages, would consider "Reversi" as in some way intending to describe turning over or reversing * * When I find that this word is used as the name of a game in which there is this description of how it is to be played, and used with reference to the necessity of reversing, I think that not only was the word "Reversi" obviously intended to describe what was to be done in the game, but the Plaintiff used it as intending to describe in some way the game in connection with which he was using it. Therefore, in my opinion, not only does this word not come within the definition which is laid down in the *Melrose* and *Electric* cases, but I think, it was intended to describe this particular game as a game of reversing your opponent's counters.

5 R. P. C.
372, l. 21.

Then, that being so, we come to the question of the injunction. I have always held, and I have no doubt at all about it, that if, independently of any trade mark right, a person has dressed up his goods in such a way as to deceive the public into the belief that they are the goods of another, namely, the Plaintiff, this Court ought to interfere, and to prevent it being done ; but there is nothing here in my opinion except the use of the words "Game of Reverses" which is done by the Defendant to pass off his article as that of the Plaintiff. In both there is to be a turning over of your opponent's counters, so as to show the under colour when you have surrounded him with two of your counters, and "A game of Reverses" is, on the Defendant's description, an intimation of what this kind of game is. It is not a mere application of that word "Reverses" to a game where there is nothing about reversing, or there is no reversing, and the get-up is different. As the Plaintiff in my opinion is not entitled to have the word "Reversi" as his trade mark, therefore, in my opinion, it cannot be said there is such an imitation of the Plaintiff's get-up by the Defendant as to justify us in granting an injunction against the Defendant to restrain him from doing that which Mr. Justice KAY has restrained him from doing—namely, using the word "Reverses" on the box which contains his game.

FRY, L.J., after expressing his concurrence in the decision in *Re Van Duzer's Trade Mark* (*supra*, p. 534).—Further than that, I think it was not a fancy word, for this reason—the Plaintiff had

R. P. C.
73, l. 22.

invented this new game, and he gave to the game the name "Reversi." He described it I suppose as the new game of Reversi, and he had a very large sale for this game. The consequence was that the word "Reversi" had, amongst persons conversant with games, come to describe this particular thing—this game. Now that which describes the thing cannot, it seems to me, be a fancy word with regard to it, and, therefore, I think this is not a fancy word, for this reason. The word "spade" describes the thing, and a word which describes a thing can never be a fancy word; you can never take the word "spade" and call it a fancy word for the thing—I think, therefore, on that ground it is not a fancy word, and I do not say whether it is distinctive.

RE WELLCOME'S TRADE MARK ;
RE BURROUGHS, WELLCOME & COMPANY'S TRADE MARK.

[March, 1886. 3 R. P. C. 76; 32 Ch. D. 213; 55 L. J. Ch. 542;
54 L. T. 493; 34 W. R. 453.]

Trade Mark—Registration by agent—Goodwill—Act of 1883, ss. 70, 78.

Motion.

During 1880 and 1882, two trade marks were registered in England by *Burroughs, Wellcome & Co.*, one in the name of the firm, and the other in that of a partner. *Burroughs, Wellcome & Co.* were the English agents of a New York firm, *McKesson & Robbins*. The two trade marks were registered by *Burroughs, Wellcome & Co.* for the benefit of *McKesson & Robbins*, and were in fact used solely in connexion with the goods of the latter sold in England by *Burroughs, Wellcome & Co.* In August, 1884, *Burroughs, Wellcome & Co.* by deed assigned the two trade marks (but nothing else) to *McKesson & Robbins*. Upon motion by *McKesson & Robbins*, under the Act of 1883, s. 78, for registration of this assignment,

CHITTY, J., made the order asked:

3 R. P. C.
78, l. 19.

CHITTY, J.—I am satisfied it would be too narrow a construction of the section to read it as if the assignment of the trade mark must be contemporaneous with the assignment of the goodwill.

* * * It appears to me that if I accede to the application in the present form, I shall not be inflicting on the public any injury within the fair meaning and the fair scope of the Act of Parliament, because I think that the goodwill having always belonged to the Applicants and the registration having been by their agents and for their benefit only, the case does fairly come

within the words of the section, and that the assignment really is only in connexion with the goodwill of the business. The section does not say in terms that the goodwill must have been assigned—certainly, as I have said, it does not say that it is to be assigned by any contemporaneous instrument.

RE WHITE ROSE TRADE MARK.

[June, 1885. 30 Ch. D. 505; 54 L. J. Ch. 961; 53 L. T. 33; 33 W. R. 796.]

Trade Mark—Similarity—Old mark—Act of 1883, s. 62.

Summons to proceed.

In November, 1884, an American firm of oil manufacturers applied to register in England a trade mark for illuminating oils, which mark had been used by them in America since 1872, and had been known in England as the "White Rose" mark prior to 1875. The application was refused by the Comptroller, upon the ground that there had been on the register since 1877 a similar mark for illuminating oils called the "Rosaline" mark of which an English firm were the proprietors.

Registration directed.

KAY, J.—If the mark now sought to be registered were altogether a new mark I should think it better not to allow it to be registered; for I cannot say that if both marks are upon the register there will be no chance of the one being mistaken for the other, not perhaps by dealers in the trade, but by members of the public who are ignorant of the marks used in the trade. But it appears that the "Rosaline" mark was not registered until *August*, 1877, while the "White Rose" mark has been used in this country since 1872, and was well known in the English trade before 1875, so that it would be a positive hardship to the American Company to compel them to change their mark because another firm has registered a mark somewhat like it.

Under these circumstances I shall direct the Comptroller to proceed with the registration of the mark, but I do so entirely on the footing of this being an old mark.

RE WHITELEY'S TRADE MARK.

[February, 1879. 29 W. R. 235n; 43 L. T. 627.]

Trade Mark—Entry on register of note as to user—Act of 1875.

Summons by *W. Whiteley*, of London, "Universal Provider," for the registration of an old trade mark consisting principally of

two geographical globes for goods comprised in Classes 12, and 13. *Whiteley* had for some years been accustomed to use this trade mark together with letterpress upon adhesive and metal labels, wrappers, and billheads, and as a general rule to attach the same to every article, or parcel, sent out from his establishment. *Whiteley's* application was opposed by a firm of cutlers, *Messrs. Ibbotson & Co.*, who were already registered as proprietors of three marks for goods in the classes in question. These marks consisted of (1) a single geographical globe; (2) a circle enclosing the word "Globe," and the word "Ibbotson;" and (3) the word "Globe" alone; and the manner of using them was by impressing them upon the metal of the goods sold.

29 W. R.
235 n.

JESSEL, M.R., made the following order:—The said William Whiteley, by his Counsel, undertaking not to stamp or impress his trade mark on the metal of the articles sold, forming the subject of this application, but to affix his trade mark on, or use it in connection with, the articles sold, falling within Classes 12 and 13, in the manner only in which he has hitherto been accustomed to affix or use the same, this Court doth order that the Registrar of Trade Marks do register the trade mark referred to in the above-mentioned application, and it is ordered that a note of the above undertaking be inserted in the register of such trade mark.

No order was made as to the costs of the application.

WILKINSON v. GRIFFITH.

[May, 1891. 8 R. P. C. 370.]

Common Law Trade mark.

Action to restrain infringement of a common law trade mark.

In 1883, the Plaintiffs, who were manufacturers of French polish in England, began to export it to Bombay under an English label on which were printed two red medals. This polish speedily acquired a high reputation. No other polish sold in Bombay had a mark on it containing red medals, and the Plaintiffs' polish became known in the Bombay market to the natives because of the red medals as "Lal Mohur" polish, or "Lal Chap;" "Lal Mohur" meaning red medal or coin and "Lal Chap" meaning "red stamp." Both terms were used to distinguish the Plaintiffs' polish from the other polishes in the market, and in the Bombay market denoted the Plaintiffs' polish and no other.

In 1889, the Plaintiffs obtained an injunction against a firm called "Taylors," who had begun to export French polish to

India under a label different in all respects from the Plaintiffs' label except that it had on it red medals like and in the same position as the red medals on the Plaintiffs' label. The effect of *Taylor's* label had been that the native retail purchasers, who do not generally know English, were deceived, merely because of the red medals, into buying *Taylor's* polish as "Lal Mohur" or "Lal Chap," thinking it to be the Plaintiffs' well-known polish. The wholesale merchants who bought polish, were as a rule not deceived.

Subsequently to the injunction being granted against *Taylor's*, the Defendants (who were also manufacturers of French polish in England and who had previously attempted to get their polish on the Bombay market under a label not containing any red medals), commenced to use a label with two red medals on it on the polish exported by them to Bombay.

This label was admittedly an imitation of *Taylor's* label, and was (with the exception of the medals) dissimilar to the Plaintiffs' label. The Judge held upon the facts of the case that the label had been adopted by the Defendants in order to get the benefit of the Plaintiffs' reputation, and that the Defendants' user thereof was fraudulent. The result of the evidence as to the effect of the Defendants' new label is stated by the Judge.

Injunction granted.

ROMER, J.—What the effect of the new label was I will now consider. In the first place, is it calculated to deceive? The Defendants' Counsel asked me to say that, looking at the label, it is impossible that any person should be deceived. No doubt the labels of the Plaintiffs and of the Defendants, put side by side, are quite distinguishable, and it is probable that most Englishmen would not be deceived into mistaking one for the other. But that is not the point. The case before me is one of those referred to by Lord CRANWORTH in *Seixo v. Provezende*, L. R. 1 Ch. App., p. 196, where he says this:—(His Lordship read the passage, and proceeded)—The question, therefore, in the case before me is what is the effect of the Defendants' label on the ordinary native purchasers in Bombay where the goods go? As to this, there is a considerable body of evidence to the effect, that though the wholesale merchants who buy direct from the manufacturers would not be deceived, the ultimate purchaser would be, and that the effect of allowing the Defendants to sell their polish with this label on will be to injure the Plaintiffs, because thereby the Defendants' polish, which is cheaper than the Plaintiffs', will be bought by unscrupulous persons for the purpose of being passed

8 R. P. C.
374, l. 3.

8 R. P. C.
374, l. 23.

off, and will be passed off as and for the Plaintiffs' polish. I need not refer to this evidence in detail, because it is not met by any evidence on the part of the Defendants; they not having ventured to call any witnesses on their behalf on this part of the case.

But the case does not rest merely on the evidence as to the probable effect of the label. There is the evidence of witnesses who prove that the Defendants' polish with the label on it has been ordered, because, by reason of the red medals on it, it could be passed off as the Plaintiffs'. There is also evidence proving that the Defendants' polish with this label on it has been in fact sold as "Lal Mohur" and "Lal Chap," by which terms, as above pointed out, the Plaintiffs' goods are known on the Bombay market.

8 R. P. C.
375, l. 1.

It is said that no native who was in fact deceived has come forward; but I am not surprised at that. The Plaintiffs could only get at them through the merchants who had deceived them, and who would certainly not be disposed to give up their names; and no one reading the depositions can fail to be struck with the obvious insurmountable objection of the native merchants to give up the names of their customers.

8 R. P. C.
375, l. 36.

I ought to refer to one argument on behalf of the Defendants. It was said that, because the natives who spoke Guzerati referred to the Plaintiffs' polish as "Lal Chap," which was a general term meaning red stamp, the Plaintiffs are endeavouring by this action to acquire a monopoly in the Bombay market for red marks of every kind. This is not so. The Plaintiffs make no such claim, and are not to be treated as making such claim because one witness called for them, stated that any purchaser asking for "Lal Chap" French polish would be satisfied if you gave him French polish with a red stamp of any shape on the label. The term "Lal Chap" is used by the Guzerati natives with reference to and because of the red medals on the Plaintiffs' label, which are also known as "Lal Mohur" to many natives, and what the Plaintiffs seek to protect themselves against in this action is the user by the Defendants of red medals on a label which the evidence satisfies me is, as it stands, deceptive. I by no means hold, nor do I think the evidence as a whole can fairly be said to establish, that any red mark on a label of the Defendants would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception. An argument similar to this was used by the unsuccessful party in the case of *Johnston v. Orr-Ewing*, and was specially dealt with by

Lord BLACKBURN in his observations in the case as reported in 7th App. Cas. at pages 230 and 231 (*supra*, p. 253), and to those observations I refer as being applicable to the case before me, and the Defendants' case does not fall within the class referred to by Lord SELBORNE at page 227 (*supra*, p. 252), for this label was not an old one formerly used by the Defendants, or one used by them rightfully or *bonâ fide*.

RE WILLS' TRADE MARKS.

[C. A., June, 1892. 9 R. P. C. 346; (1892) 3 Ch. 201; 67 L. T. 453.]

Trade Mark—Practice—Affidavit of documents.

In 1892 *R. J. Dexter* gave notice of motion to expunge certain trade marks registered by Messrs. *Wills*, and at the suggestion of the Judge delivered a statement of the grounds on which his notice of motion was based. The evidence on the motion was completed, with the exception of the cross-examination of a member of Messrs. *Wills'* firm, which was to take place in Court. *Dexter* took out a summons for an affidavit of documents to be made by the Messrs. *Wills*. KEKEWICH, J., held that an order for an affidavit of documents relevant to several of the matters mentioned as grounds on which the motion was based, ought to be made. The order was accordingly made, but in a special limited form as directed by the Judge.

Counsel for Messrs. *Wills* (who opposed the summons), stated before KEKEWICH, J., that they were willing to undertake to deliver to the other side a statement of the labels on which they intended to rely, and to produce samples of such labels; and also to produce all relevant documents in Court at the hearing of the motion, and not to take any objection that they had not had sufficient notice to produce them.

KEKEWICH, J.—It is obvious that to make an order in a trade mark case in the common form used in actions might be productive of great hardship. If a trader were bound to set forth in a schedule all the labels and other documents relating to a particular trade mark from time to time used in his business, his task would be one of extreme difficulty, equivalent to practical impossibility, and he would expend thereon a vast amount of labour and time, incommensurate with the advantage of his opponent or the advancement of justice between them; and the costs of what is intended to be a summary proceeding might and probably would be enormously increased.

9 R. P. C.
347, l. 58.

9 R. P. C.
348, l. 21.

I think that the discovery to be enforced in this class of applications must depend upon the particular circumstances of each case. As at present advised, I should not, in any case, be disposed to refer to the affidavits as containing the limits of the discovery required, and if I had not any statements of the questions in writing, I should be disposed to require one before making the order. Here I have a written statement of Mr. *Dexter's* grounds, and it seems possible to frame an order on that basis, which will answer all practical purposes. I do not say that it is necessarily final, and that some addition or variation may not afterwards be required, but it will be sufficient for the moment, and I hope altogether. This, or any like order, ought, I think, to be guarded in such a manner as to prevent as far as possible the inconvenience with its attendant delay and expense to which reference has above been made. The order will follow the usual form as far as possible, the modifications to be now stated, and which explain themselves, being incorporated therein.

Appeal to the C.A. (Lindley, Bowen, and Kay, L.JJ.).

9 R. P. C.
349, l. 45.

LINDLEY, L.J.—The tendency to extend the power of the Court to order discovery to the extent to which it is tried to extend it in modern times is a tendency which ought to be at least very carefully checked and certainly not encouraged. Now-a-days a man cannot run over another in the street without there being an affidavit of documents. It is an extension of the principle which, as I say, has given rise to frightful expense and frightful oppression. In this particular case I am satisfied that no oppression is desired, but having had considerable experience, as most of us have had, in drawing affidavits of documents and answers to interrogatories, I feel perfectly convinced that a fairly conscientious man would be grievously oppressed by having to make such an affidavit as he has been ordered to make by the order of the Court below. It appears from Mr. *Dexter* that he knows of two labels already which tend to invalidate Messrs. *Wills'* case, according to his view of it. He does not want notice of those. He knows all about those already, and therefore it appears to me that the right mode of proceeding will be this:—Let this order be discharged, but without prejudice to any order which the Judge at the trial may think fit to make with respect to the discovery of documents. This must be done on the terms that the Defendants renew the undertaking which they gave in the Court below.

WOOD v. BUTLER;
RE WOOD'S TRADE MARK.

[C. A., January, 1886. 3 R. P. C. 81; 32 Ch. D. 247; 55 L. J. Ch. 377;
54 L. T. 314.]

Trade Mark—Special and distinctive—Act of 1875, s. 10.

Cross motions.

Prior to 1875 the Plaintiffs (Messrs. *Wood*) manufactured and sold cigarettes of a particular size called "Etons." It appeared, however, that they had also sold or permitted cigarettes to be sold to the public in boxes marked with the word "Eton," but bearing labels representing the cigarettes either to have been manufactured at Constantinople by *Jancal Tachta*, or at St. Petersburg by *Mavrogordato & Co.*, and not containing the Plaintiffs' name at all.

In 1876, the Plaintiffs registered the word "Eton" for cigarettes as an old mark.

In 1883, the Plaintiffs commenced an action against the Defendants for infringement, and moved for an injunction. The Defendants thereupon moved to expunge the Plaintiffs' trade mark.

PEARSON, J., granted an injunction, and refused the Defendants' motion.

Appeal to the C. A. (Lindley, Fry, and Lopes, LJJ.) who allowed the appeal in both cases.

LINDLEY, L.J., read the Act of 1875, sect. 10 (*supra*, p. 5), and said:—The question of fact which we have to consider is narrowed down to this: whether this word "Eton" was, when registered—and that appears to me to be the true construction of the Act—a special and distinctive word denoting that "Etons" were cigarettes manufactured by Messrs. *Wood*. I observe in passing that the expression in the passage I have just read, "used as a trade mark before the passing of this Act," would not authorise, in my view, at all events, the registration of that which was not a distinctive mark at the time of registration. You must have the two things; you must have the distinctive mark as a trade mark at the time of registration; and it must have been used previously to the passing of the Act.

What do you mean by a distinctive trade mark? It must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark. Well, now, the evidence is perfectly plain and perfectly clear, and perfectly uncontradicted, that before, and at the time

3 R. P. C.
89, 1. 49.

3 R. P. C.
90, 1. 16.

when this mark was registered, Messrs. *Wood* had not only permitted but done these two things.

His Lordship referred first to the Plaintiffs' use of the " *Mavrogordato* " label, and continued :—I quite agree that there is a great deal of evidence, a mass of evidence so great as to satisfy me, as it satisfied PEARSON, J., that persons in the cigarette trade knew perfectly well what all this meant, and that they did know that *Mavrogordato* was nothing at all, and that these things were made by *Wood*. But it appears to me that is not sufficient ; it is not sufficient to show that those who are in the trade knew the facts, but the question is what the public knew. Upon this how is it conceivable that any mere cigarette smokers would understand by these labels, or by the word " Eton " or anything else—how would they assume or come to the conclusion that " Eton " meant cigarettes made by Messrs. *Wood* ?

His Lordship referred secondly to the Plaintiffs' use of the *Jancal Tachta* label, and said :—It would be perfectly impossible for any purchasers of cigarettes not in the secrets of the trade, to understand by this, that it meant Messrs. *Wood's* cigarettes ; and Messrs. *Wood* have so acted in connexion with the word " Eton," and so used the word " Eton," and so allowed other people to use the word " Eton," as to destroy the value of the word " Eton " as a distinctive mark to the public of goods made by Messrs. *Wood*. It appears to me therefore that * * Messrs. *Wood* were not entitled when they registered this word " Eton " to say that the word " Eton " was their distinctive trade mark. * * The trade itself knew it was a juggle, but the public knew nothing about it.

FRY, L.J., read sect. 10 of the Act of 1875, and said :—It appears to me that, to satisfy the requirements of that definition, the word or words must be distinctive in this sense, that they distinguish the manufacture of a person who registers the trade mark from the manufacture of all other persons. * * I say " manufacture," but of course there may be cases in which they distinguish, not the manufacture, but the selection of, or some other operation upon, the goods ; but in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons ; and it appears to me that it must have that distinctive character at the time of registration.

How is it possible for the Plaintiffs to say that the word " Eton " is distinctive of their manufacture, when they for a second time have represented it as being the manufacture of another person ? In my judgment, where a person uses a word and represents that

word to be applicable to the product of a manufacturer or manufacturers other than himself, so as to produce the belief that the goods are the manufacture of a third person or persons, he cannot say that the word is distinctive of his own manufacture. Nor do I think that the principle applies the less because the Plaintiff may be false in the assertion that there is any such firm or firms as the manufacture represents. He who has made the goods has taken upon himself to represent two things: in the first place, that they are not his manufacture but somebody else's; in the second place, that a firm exists which does not exist at all. It appears to me the Plaintiff has by that conduct entirely precluded himself from contending in this case that the word is a distinctive word or words.

RE WORTHINGTON'S TRADE MARK.

[C. A., February, 1880. 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. 563; 28 W. R. 747.]

Trade Mark—Similarity—Act of 1875, s. 6.

Motion to restrain registration.

Worthington & Co. proposed to register as a new trade mark for ale a triangle with a double outline inscribing within the double outline the words "Beccles Brewery, Established 1830," the inner triangle having within it a conspicuous figure of a church. *Bass & Co.*, whose trade mark for pale ale was a plain triangle which, in use, was coloured red, opposed on the ground that the proposed trade mark was so similar to theirs as to be calculated to deceive.

JESSEL, M.R., granted the motion and refused registration.

JESSEL, M.R.—Here the business of *Worthington & Co.* is represented to me as an old established business, which makes a good article, and must be anxious that such good article should be distinguished from all other articles made in the same trade. If the proprietor of that business is an honest man, and honestly desirous of distinguishing his goods by a trade mark from the goods of everybody else, he will choose a mark not in the slightest degree resembling that of anybody else, because his anxiety and desire must be that the public shall by no possibility mistake his goods for the goods made by anybody else. 14 Ch. D. 10.

Appeal to the C. A. (James, Brett, and Cotton, L.JJ.).

Appeal dismissed (Cotton, L.J., dissentiente).

JAMES, L.J.—Now the proposed trade mark of Messrs. *Worthington*, no doubt, as it stands in black and white, seems to be very 14 Ch. D. 13.

substantially different from that of Messrs. *Bass & Co.* But then, I think, we must look at this, that the Trade Marks Act says nothing about the colour, and the Appellants might use exactly the same colour upon their trade mark which Messrs. *Bass* have used upon theirs ; that is to say, each of the marks might be a mass of red, on one of which masses of red there would be a design of a church. Of what colour that design of a church might be, I do not know ; it might be red of the same shade or a different red ; but there might be a mass of red with a design on it which would be, with that difference, the same as *Bass's* triangular mass of red.

14 Ch. D.
14.

I cannot help thinking that if such designs in a triangle were allowed to be registered, there would be great danger that the design within the red triangle would get fainter and fainter, and the solid red would get stronger and stronger, so that in a very short time there would be substantially nothing but a solid red triangle. I also think that great weight is to be attributed to the observation of the M. R., that there is no mischief done here by refusing registration ; the mark that it is sought to register is not a trade mark which has been used, the Appellants have not acquired any right or reputation by means of it, they are only seeking a new registration of it, and it would be as well and quite right to have a device which does not in any way resemble, and is not like the triangle, by which Messrs. *Bass's* ales are generally known.

14 Ch. D.
15.

BRETT, L.J.—It is obvious that there is nothing in the Statute to prevent the trade mark which is registered from being used in any colour. Therefore, it seems to me that the proper construction is that where a trade mark is registered, it is not merely the outline or design as printed in the advertisement in black, or black and white, which is to be protected, but that which is to be protected is the trade mark as it may be used or will be used in the ordinary course of trade, that is, in any colour. That being so, it seems to me that the proper test is this : assume both trade marks to be registered, and let it be supposed that each person registering is ignorant of the other's trade mark, would any fair use of the second be calculated to deceive ? I quite agree that we ought not to take into consideration an obliteration or a fraudulent alteration of the second design. The question is whether any fair use of the second would be calculated to deceive ? Now, if the first may be used in any colour, so also the second if registered may be used in any colour, and, supposing the parties to be ignorant of each other's marks, they might both with a perfectly

fair intention use them of the same colour. The question would then be whether, supposing them both to be registered, and supposing them both to be fairly used with the same colour, would the second be calculated to deceive any person who only used ordinary observation? That brings us to a matter of fact to be considered in each particular case. * * In each particular case you must do the best you can to come to a right decision as to what would be calculated to deceive, it being assumed that the two marks are not identical. Then one has to exercise one's own eyes. * * * Supposing both [the trade marks] to be red, even as at first presented and when quite fresh, I think they might be mistaken for each other by an ordinary observer, but certainly, if the design of the second one were to be at all worn I should say that they would present nearly the same appearance.

RE WRAGG'S TRADE MARK.

[February, 1885. 29 Ch. D. 551; 54 L. J. Ch. 391; 52 L. T. 467.]

Trade Mark—Five years—Common to trade—Act of 1883, ss. 74, 76, 90.

Motion to expunge a new mark that had been on the register for aërated waters for over 5 years, consisting of a syphon bottle with a hand pressing down the tap handle and a glass on the opposite side into which the liquid was flowing from the spout, the whole being surrounded by a circular border upon which were printed the words, "J. Wragg, Birmingham."

At the date of the registration there were more than three similar, though not identical, marks in use for aërated waters. These marks consisted of different combinations of a syphon and glass, or a syphon and hand, or a syphon and hand and glass. In some of the cases the mark was not actually placed on the goods, but was only used on bill-heads, trade circulars, advertisements, or show cards.

Mark expunged.

PEARSON, J.—To my mind, the syphon being the material part of the mark, whether you have all the three things, the hand, the syphon, and the glass, used, or only two of them, the syphon being one, is immaterial. * * * Now, this mark being used before 1875, how was it used? To my mind it was used in a manner which exactly corresponds with the language of the 74th section of the Act. * * * [It is said] that I must find a user as a trade mark, and, that inasmuch as none of the persons referred to

29 Ch. D.
555.

could prove that they themselves had used the mark as an exclusive trade mark, therefore, there had been no public user within the meaning of that section. But the section speaks of a public user by more than three persons on the same or a similar description of goods. It is quite plain that if more than three persons, if twenty persons, in the trade are all using the same device, it would be impossible to treat it as the exclusive trade mark of any one of them. * * * I hold, therefore, that when Mr. *Wragg* registered this mark he registered that which he had no right whatever to register, and that he has acquired no title whatever by the lapse of time, and, inasmuch as the mark was not properly registered when it was registered in 1876, it ought to come off the register now. It ought to come off for this reason, that, so long as it remains on the register, it apparently gives the person who has registered it an exclusive right to use it.

TRADE MARKS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules :—

PRELIMINARY.

1. These Rules may be cited as the Trade Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1889.

INTERPRETATION.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpre-
tation.

FEES.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the First Schedule hereto. Fees.

FORMS.

4. The Form F in the First Schedule to the Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution thereof of the Form F in the Second Schedule to these Rules. Forms.

5. (1.) An application for registration of a trade mark shall be made in the Form F in the Second Schedule to these Rules ; (2.) The remaining forms in such Schedule may be used in all cases to which they are applicable.

CLASSIFICATION OF GOODS.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classifica-
tion of
goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

APPLICATION FOR REGISTRATION.

7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be. Applica-
tion by
firm.

If the application be made by a body corporate it may be signed by the Secretary or other principal officer of such body corporate.

8. Where a trade mark for registration of which application is made is in Classes 23, 24 or 25 of the Third Schedule to these Rules, the Address of
applica-
tion.

applicant shall address and send his application to the Manchester Trade Marks Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under Section 81 of the said Acts should be made to the Cutlers Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

Agency. 9. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

Acknowledgment of application. 10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application. 11. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

Size, &c., of documents. 12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Representations of trade mark. 13. Subject to any other directions that may be given by the Comptroller, three representations of each trade mark, except in the case of marks applied for in Classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.

In the case of marks applied for in Classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

Representations of a series of trade marks. 14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application and also upon each of the separate half sheets of paper aforesaid,

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

Translation of foreign characters.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

Mode of sending notices, &c.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

EXERCISE OF DISCRETIONARY POWERS.

17. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a trade mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

Hearing by Comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notice of wish to be heard before Comptroller.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Notification of decision.

APPEAL TO THE BOARD OF TRADE.

20. When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention.

Notice of appeal.

21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Grounds of appeal to be stated.

22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be.

Transmission of notice.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Directions by Board.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any par-

Hearing of appeal.

ticular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be.

No appeal unless notice duly given.

25. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller.

ADVERTISEMENT OF APPLICATION.

Advertisement of application.

27. Every application shall be advertised by the Comptroller in the official paper, during such times, and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Definition of official paper.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade mark to be supplied to official paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

OPPOSITION TO REGISTRATION.

Notice of opposition.

31. (1.) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the Second Schedule to these Rules, with such variations as circumstances may require.

Opposition on the

(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical

with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register.

ground of
trade
mark
already
on the
register.

(3.) Within two months after the expiration of one month or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade Marks Branch, such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and deliver to the applicant copies thereof.

Oppo-
nent's
evidence.

(4.) * Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

Appli-
cant's
evidence.

Evidence
in reply.

(5.) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him.

Closing of
evidenced.

(6.) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Applica-
tions for
leave to
adduce
further
evidence.

(7.) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Appoint-
ment of
time for
hearing.

(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the register of the said trade mark already on the register have been duly specified in the notice of opposition.

Disallow-
ance of
opposition
in certain
cases.

(9.) The decision of the Comptroller in the case shall be notified to the parties.

Decision
to be
notified
to parties.

REGISTER OF TRADE MARKS.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description

Time of
registra-
tion of
trade
marks.

* The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition.

of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

Entries to be made in register.

Notice of registration.

Request by subsequent proprietor.

Signature of request.

Contents of request.

Declaration to accompany request.

Further proof of title if required.

Body corporate.

33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

34. Upon registering any trade mark the Comptroller shall enter in the register the date on which the application for registration was received by the Comptroller and such other particulars as he may think necessary.

35. The Comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade mark shall be addressed to the Comptroller, and left at the Patent Office, Trade Marks Branch.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered.

39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request.

40. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

41. A body corporate may be registered as proprietor by its corporate name.

42. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark. Definition of applicant.
43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. Comptroller may require statement from rival claimants
44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case ; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct. Submission to Court of conflicting claims
45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller on payment of the prescribed fees. Settlement of special case.
46. Where an order has been made by the Court in either of the following cases, viz. :—
 (a) allowing an appeal under section 62 of the said Acts ;
 (b) disallowing an opposition to registration under section 69 ; or,
 (c) under the provisions of sections 72, 90, or 92 of the said Acts,
 the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register as the case may be. Order of Court.
47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Acts, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof. Removal of mark from register.
48. If the registered proprietor of a trade mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the register accordingly. Alteration of address in register.
49. Four clear days' notice of every application to the Court under section 90 of the said Acts, for rectification of the register, shall be given to the Comptroller. Notice to Comptroller of applications to rectify register.
50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register. Publication of rectification or variation of register.

Notice to
Comptroller of
order of
Court for
alteration
of trade
mark
under
section 92
of Acts.

51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark under section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade mark as altered as he may deem sufficient.

INSPECTION OF REGISTER.

Hours of
inspection.

52. The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every weekday, between the hours of ten and four, except on the days and at the times following :—

- (a) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
- (c) Times when the register is required for any purpose of official use.

POWER TO DISPENSE WITH EVIDENCE.

Dispensing
with evi-
dence.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

AMENDMENTS.

Amend-
ment of
docu-
ments.

54. Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

ENLARGEMENT OF TIME.

Comp-
troller
may en-
large time.

55. The time prescribed by these Rules for doing any act, or taking any proceedings thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

CUTLERS COMPANY.

56. All applications to the Cutlers Company for registration of a trade mark, under section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Sheffield applications in duplicate.

57. The Cutlers Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Notice to Comptroller.

58. (1.) The time within which the Comptroller shall give notice to the Cutlers Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Comptroller of the notice from the said Company of the making of the application.

Time within which Comptroller may object to application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Advertisement of application made at Sheffield.

(3.) The manner in which the Comptroller shall notify to the Cutlers Company an application and proceedings thereon made as mentioned in subsection 8 of section 81 of the said Acts shall be by sending to the Cutlers Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Manner of notifying to Cutlers Company application received by Comptroller.

59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers Company, and to all proceedings subsequent thereon.

Similarity of proceedings at London and at Sheffield.

CERTIFICATES.

Certificate by Comptroller.

60. The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country.

DECLARATIONS.

61. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows :—

Manner in which, and persons before whom, declaration is to be taken.

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding ;

- (b) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and
- (c) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

Notice of
seal of
officer
taking
declara-
tion to
prove
itself.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

REPEAL.

Previous
rules re-
pealed.

63. All general rules as to the registration of trade marks heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date.

M. E. HICKS-BEACH,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register a trade mark for one or more articles included in one class	0	5	0
2. For registration of a trade mark for one or more articles included in one class	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively.	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of 14 years	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee	1	0	0
12. For altering address on the register, for every mark	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under section 91	0	5	0
16. For certificate of refusal to register a trade mark under section 77	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
18. For certificate of registration to be used in legal proceedings	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of Comptroller under section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller	2	0	0
23. For inspecting register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
25. For office copy of documents, for every 100 words, (but never less than one shilling).	0	0	4
26. For certifying office copies, MS. or printed.	0	1	0
27. In cases where the wood-block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or breadth and depth—For every inch or part of an inch over 2 inches in breadth	0	2	0
For every inch or part of an inch over 2 inches in depth	0	2	0

28. Manchester Trade Marks Office	£ s. d.
29. Sheffield Marks	Same as above
30. On appeal from Cutlers Company, Sheffield, to Comptroller	1 0 0

M. E. HICKS-BEACH,
President of the Board of Trade.
Approved,
FRANK MOWATT,
Assistant Secretary for the Lords
Commissioners of Her Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

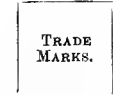
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Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Opposition, &c.



(a) Here insert full address.

SIR,
of (a) , hereby apply to be heard in reference to and
request that I may receive due notice of the day fixed for the hearing.

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM F.

APPLICATION FOR REGISTRATION OF TRADE MARK.

TRADE
MARKS.

One representation to be fixed within this square, and two others to be sent on separate half sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accompanying Trade Mark in Class ,
in respect of (a) in the name of (b) who claims to be the proprietor
thereof (c).

The essential particulars of the Trade Mark are the following (d) and
disclaim any right to the exclusive use of the added matter.

Dated the day of , 18 . Signed (e).

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

[Or where the application is for a mark in Classes 23, 24 or 25.]

To the Comptroller,
Manchester Trade Marks Branch,
48, Royal Exchange, Manchester.

NOTE.—If the Trade Mark has been in use in respect of the goods since before
August 13th, 1875, state length of such user.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM G.

ADDITIONAL REPRESENTATION OF TRADE MARK, TO ACCOMPANY APPLICATION
FOR REGISTRATION.

(a) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(b) Here insert legibly the full name, address and description of the individual firm or company. Add trading style (if any).

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(d) See Subsections (2) and (3) of Section 64 of the Acts.

(e) To be signed by the applicant or by an agent duly authorised.

One representation of the trade mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

TWO of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany each Form of Application.

In the case of a Trade Mark claimed in one of the CLASSES 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the Mark must accompany the Form of Application.

TRADE MARKS RULES, 1890 [FORMS].

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM H.

TRADE
MARKS.

FORM OF APPEAL FROM THE COMPTROLLER TO THE BOARD OF TRADE.

I, (a) of (a) hereby give notice of my intention to appeal to the
Board of Trade from (b) of the Comptroller of the day of
18, whereby he (c).
Accompanying this notice is a statement of my case for the decision of the Board
of Trade.

(a) Here insert
full name and
address of appel-
lant.

(b) Here insert
"the decision"
or that part of
the decision as
the case may be.

(c) Here insert
the decision com-
plained of.

Dated day of , 18 . (Signed) .
To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London,
and to
[Name of Respondent to Appeal.]

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM I.

TRADE
MARKS.

FEE FOR REGISTRATION OF A TRADE MARK.

SIR, In reply to your request I hereby transmit the prescribed fee for the
registration of the Trade Mark No. in Class .

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM J.

TRADE
MARKS.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION.

[To be accompanied by an unstamped duplicate.]

* Here state
full name and
full address.

* I, hereby give notice of my intention to oppose the Registration of the
Trade Mark advertised under the above number for Class in the Trade
Marks Journal of the day of 18, No. , page .
The grounds of opposition are as follows:—

In the matter of an Application,
No. by
of

Dated the day of 18 . (Signed) .

Address for Service:—

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

I, (a) hereby request that you will enter (b) name (c) in the Register of Trade Marks as proprietor of the Trade Mark No. in Class .
 (d) entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

(e) .
 And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

(f) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at this day of 18 . (g)
 Before me,
 (h)

To the Comptroller,
 Patent Office, Trade Marks Branch,
 25, Southampton Buildings,
 London.

TRADE MARKS.

(a) Or We
 Here insert name, full address, and description.

(b) My or our.
 (c) Or names.
 (d) I am or We

are.
 (e) Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as e.g., "by deed dated the day of 18 , made between So-and-So of the one part."

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE 13 AUGUST, 1875.

In the matter of an Application for registration of an old Trade Mark, No. .
 in Class .

SIR,
 I, of , the Applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to register the said Trade Mark.

*
 Dated this day of 18

To the Comptroller,
 Patent Office, Trade Marks Branch,
 25, Southampton Buildings,
 London.

TRADE MARKS.

(f) This paragraph is not required when the declaration is made out of the United Kingdom.

(g) To be signed here by the person making the declaration.

(h) Signature and title of the authority before whom the declaration is made.

* Signature of applicant.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM M.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON REGISTER OF TRADE MARKS.

In the matter of the Trade Mark, No. .
 in Class .

SIR,
 Notice is hereby given that I of the registered proprietor of the Trade Mark numbered as above desire that my address on the register of Trade Marks be altered to .

Dated this day of 18 .

To the Comptroller,
 Patent Office, Trade Marks Branch,
 25, Southampton Buildings,
 London.

TRADE MARKS.

* Signature of proprietor.

TRADE MARKS RULES, 1890 [FORMS].

*Patents, Designs, and Trade Marks Acts, 1883—1888.*TRADE
MARKS.

FORM N.

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS.

In the matter of the Trade Mark,
No. _____, registered in
Class _____ in the name of _____

SIR,

Notice is hereby given that by an Order of the Court made on the day of _____ 18____, it was directed that the entry on the Register of Trade Marks in respect of the Trade Mark numbered as above should be rectified in the manner therein specified.

An Office Copy of the Order of the Court is enclosed herewith.

Dated this _____ day of _____ 18____.

* To be signed
by the person
interested or his
agent.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

*Patents, Designs, and Trade Marks Acts, 1883—1888.*TRADE
MARKS.

FORM O.

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE MARK TO CANCEL ENTRY ON REGISTER.

Trade Mark No. _____ Class _____ advertised in Trade Marks Journal
No. _____, page _____
Name of Registered Proprietor or Firm _____
Place of Business _____
I, the undersigned, _____ of _____ [or I, the undersigned, _____ a member
of the Firm of _____ of _____ on behalf of my said Firm] apply that
the entry upon the Register of the Trade Marks in Class _____ of the Trade Mark
No. _____ may be cancelled.

The _____ day of _____ 18____.

(Signed) _____

This is the statement marked "O" referred to in the Declaration of _____ made
before me the _____ of _____ 18____.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM P.

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR CANCELLATION OF TRADE MARK BY OWNER.

I, _____ of _____; [or I, _____ a member of the Firm of _____ of _____]
do hereby solemnly and sincerely declare, to the best of my knowledge and belief,
as follows:—

(1) The Application signed by me, and dated the _____ day of _____ 18____,
and marked with the letter "O." and shown to me at the time of making this
Declaration, is true.

(2) I am the person whose name appears on the Register of Trade Marks as the
Proprietor of the Trade Mark referred to in the said Application marked with the
letter "O."

[or My said Firm is the Firm whose name appears on the Register of Trade Marks
as the Proprietor of the Trade Mark referred to in the said Application marked with
the letter "O."]

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed)

Declared at
this day of
18 .

Before me

If the declaration he made before a Commissioner to administer oaths it will require to be stamped with a 2s. 6d. impressed Inland Revenue stamp.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM Q.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR PERMISSION
TO AMEND APPLICATION UNDER SECTION 91.

SIR,

I hereby request that

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

TRADE
MARKS.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM R.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN
OBTAINING REGISTRATION ABROAD.

In the matter of the Trade Mark
No. _____, registered in
Class _____ in the name of _____

SIR,

I, _____, of _____ the registered proprietor of the above Trade Mark hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in *

Dated this day of 18 .

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

* Here state name of country in which registration is to be sought.

+ Signature.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM S.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK TO BE USED IN
LEGAL PROCEEDINGS.

In the matter of the Trade Mark,
No. _____, registered in
Class _____ in the name of _____

SIR,

Sir, I, _____, of _____, the registered proprietor of the above Trade Mark hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings.

Dated this day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE
MARKS.

Signature

TRADE MARKS RULES, 1890 [FORMS].

TRADE
MARKS.*Patents, Designs, and Trade Marks Acts, 1883—1888.*

FORM T.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON APPLICATION TO REGISTER
A TRADE MARK.In the matter of the Application
of _____ and
of the Application of _____

SIR,

Notice is hereby given that I, _____, of _____, and I, _____, of _____, are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

Dated this _____ day of _____ 18 ____.

* To be signed
by both parties.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE
MARKS.*Patents, Designs, and Trade Marks Acts, 1883—1888.*

FORM T 1.

REQUEST FOR GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

In the matter of the Trade Mark No. _____ in Class _____.

SIR,

I, _____ of _____ hereby request you to furnish me with your certificate

(a) Here set
out the partic-
ulars which the
Comptroller is
requested to
certify.

that (a) _____.

(b)

Dated this _____ day of _____ 18 ____.

(b) Signature.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE
MARKS.*Patents, Designs, and Trade Marks Acts, 1883—1888.*

FORM U.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN
LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).Patent Office, Trade Marks Branch,
London,I,
certifyComptroller-General of Patents, Designs, and Trade Marks, hereby
_____ 18 ____.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM V.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRATION OF
TRADE MARK.

TRADE
MARKS.

In the matter of the Trade Mark,
No. , registered
in Class .

SIR,
I, , of , the registered proprietor of the Trade Mark above
named hereby request that you will furnish me with a copy of the official notification
of the registration of the same.

Dated this day of 18 .

* Signature.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM W.

FORM OF APPEAL FROM CUTLERS COMPANY AT SHEFFIELD TO COMPTROLLER.

[To be accompanied by an unstamped duplicate.]

SIR,
I hereby give notice of appeal against the decision of the Cutlers
Company of Sheffield in regard to my application for registration of a Trade Mark
No. in Class for and I beg to submit my case* for your
decision accordingly.

Dated this day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

* The state
ment of the case
to be written
upon foolscap
paper (on one
side only), with
a margin of two
inches on the
left-hand side
thereof.

† Signature.

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM X.

CONTINUANCE OF MARK AT EXPIRATION OF 14 YEARS FROM THE DATE OF
REGISTRATION.

TRADE
MARKS.

SIR,
In pursuance of the notice received from you, I hereby transmit the pre-
scribed fee of £1 for continuance on the Trade Marks Register of the Trade Mark
No. , in Class .

Dated the day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

* Signature of
Proprietor.

TRADE MARKS RULES, 1890 [FORMS].

TRADE
MARKS.*Patents, Designs, and Trade Marks Acts, 1883—1888.*

FORM Y.

ADDITIONAL FEE OF 10s. TO ACCOMPANY "CONTINUANCE FEE" (FORM X),
WITHIN 3 MONTHS AFTER EXPIRATION OF 14 YEARS.

SIR,

In pursuance of the notices issued by you, and of the provisions of Section 79 (3), of the above Acts, I hereby transmit the additional fee of 10s. (along with Form X) for the continuance on the Trade Marks Register of the Trade Mark No. , in Class .

Dated the day of * 18 .

* Signature of
Proprietor.

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

Patents, Designs, and Trade Marks Acts, 1883—1888.

FORM Z.

RESTORATION OF TRADE MARK WHERE REMOVED FOR NON-PAYMENT OF FEE.

(To accompany Form X.)

SIR,

In pursuance of the notices issued by you, and of the provisions of Section 79 (4), of the above Acts, I hereby transmit the additional fee of £1 (along with Form X) for restoration to the Trade Marks Register of the Trade Mark No. in Class .

Dated the day of * 18 .

* Signature of
Proprietor.

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

Patents, Designs, and Trade Marks Acts, 1883—1888.

APPLICATION FOR REGISTRATION OF OLD CORPORATE TRADE MARK.

CORPO-
RATE
TRADE
MARK.

You are hereby requested to register the accompanying old Corporate Trade Mark in Class , in respect of in the name of who claims to be the proprietor thereof.

(Signed) .

Dated the day of 18 .

*To the Cutlers Company,
Cutlers' Hall, Sheffield.*

M. E. HICKS-BEACH,
President of the Board of Trade.

THIRD SCHEDULE.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire.

CLASSIFICATION OF GOODS.

Illustrations.

Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

CLASS 1.

Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.

Such as—

Acids, including vegetable acids.
Alkalies.
Artists' colours.
Pigments.
Mineral dyes.

CLASS 2.

Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.

Such as—

Artificial manure.
Cattle medicines.
Deodorisers.
Vermine destroyers.

CLASS 3.

Chemical substances prepared for use in medicine and pharmacy.

Such as—

Cod liver oil.
Medicated articles.
Patent medicines.
Plasters.
Rhubarb.

CLASS 4.

Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.

Such as—

Resins.
Oils used in manufactures and not included in other classes.
Dyes, other than mineral.
Tanning substances.
Fibrous substances (*e.g.*, cotton, hemp, flax, jute).
Wool.
Silk.
Bristles.
Hair.
Feathers.
Cork.
Seeds.
Coal.
Coke.
Bone.
Sponge.

CLASS 5.

Illustrations.

Unwrought and partly wrought metals
used in manufacture.

Such as—
Iron and steel, pig or cast.
Iron, rough.
,, bar and rail, including rails for
railways.
,, bolt and rod.
,, sheet, and boiler and armour
plates.
,, hoop.
Lead, pig.
,, rolled.
,, sheet.
Wire.
Copper.
Zinc.
Gold, in ingots.

CLASS 6.

Machinery of all kinds, and parts of
machinery, except agricultural and
horticultural machines included in
Class 7.

Such as—
Steam engines.
Boilers.
Pneumatic machines.
Hydraulic machines.
Locomotives.
Sewing machines.
Weighing machines.
Machine tools.
Mining machinery.
Fire engines.

CLASS 7.

Agricultural and horticultural machinery,
and parts of such machinery.

Such as—
Ploughs.
Drilling machines.
Reaping machines.
Thrashing machines.
Churns.
Cyder presses.
Chaff cutters.

CLASS 8.

Philosophical instruments, scientific in-
struments, and apparatus for useful
purposes. Instruments and apparatus
for teaching.

Such as—
Mathematical instruments.
Gauges.
Logs.
Spectacles.
Educational appliances.

CLASS 9.

Musical instruments.

CLASS 10.

Horological instruments.

CLASS 11.

Instruments, apparatus, and contrivances,
not medicated, for surgical or curative
purposes, or in relation to the health
of men or animals.

Such as—
Bandages.
Friction gloves.
Lancets.
Fleams.
Enemas.

CLASS 12.	<i>Illustrations.</i>
Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws.
CLASS 13.	
Metal goods not included in other classes.	Such as— Anvils. Keys. Basins (metal). Needles. Hoes. Shovels. Corkscrews.
CLASS 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases and pencil cases of such metals. Sheffield and other plated goods. Gilt and ormolu work.
CLASS 15.	
Glass.	Such as— Window and plate glass. Painted glass. Glass mosaic. Glass beads.
CLASS 16.	
Porcelain and earthenware.	Such as— China. Stoneware. Terra Cotta. Statuary porcelain. Tiles. Bricks.
CLASS 17.	
Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalt.
CLASS 18.	
Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.
CLASS 19.	
Arms, ammunition, and stores not included in Class 20.	Such as— Cannon. Small arms. Fowling pieces. Swords. Shot and other projectiles. Camp equipage. Equipments.

CLASS 20.	<i>Illustrations.</i>
Explosive substances.	Such as— Gunpowder. Gun-cotton. Dynamite. Fog-signals. Percussion caps. Fireworks. Cartridges.
CLASS 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats. Anchors. Chain cables. Rigging.
CLASS 22.	
Carriages.	Such as— Railway carriages. Waggon. Railway trucks. Bicycles. Bath chairs.
CLASS 23.	
(a) Cotton yarn, and sewing cotton not on spools or reels. (b) Sewing cotton on spools or reels.	
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.
CLASS 25.	
Cotton goods not included in Classes 23, 24, or 28.	Such as— Cotton lace. Cotton braids. Cotton tapes.
CLASS 26.	
Linen and hemp yarn and thread.	
CLASS 27.	
Linen and hemp piece goods.	
CLASS 28.	
Linen and hemp goods not included Classes 26, 27, and 50.	
CLASS 29.	
Jute yarns and tissues, and other articles made of jute not included in Class 50.	
CLASS 30.	
Silk, spun, thrown, or sewing.	

CLASS 31.

Illustrations.

Silk piece goods.

CLASS 32.

Other silk goods not included in Classes
30 and 31.

CLASS 33.

Yarns of wool, worsted, or hair.

CLASS 34.

Cloths and stuffs of wool, worsted, or
hair.

CLASS 35.

Woollen and worsted and hair goods not
included in Classes 33 and 34.

CLASS 36.

Carpets, floor-cloth, and oil-cloth.

Such as—
Drugget.
Mats and matting.
Rugs.

CLASS 37.

Leather, skins unwrought and wrought,
and articles made of leather not in-
cluded in other classes.Such as—
Saddlery.
Harness.
Whips.
Portmanteaus.
Furs.

CLASS 38.

Articles of clothing.

Such as—
Hats of all kinds.
Caps and bonnets.
Hosiery.
Gloves.
Boots and shoes.
Other ready-made clothing.

CLASS 39.

Paper (except paperhanging), stationery,
and bookbinding.Such as—
Envelopes.
Sealing wax.
Pens (except gold pens).
Ink.
Playing cards.
Blotting cases.
Copying presses.

CLASS 40.

Goods manufactured from india-rubber
and gutta-percha not included in other
classes.

CLASS 41.

Furniture and upholstery.

Such as—
Paper hangings.
Papier-mâché.
Mirrors.
Mattresses.

CLASS 42.

Illustrations.

Substances used as food, or as ingredients in food.

Such as—
Cereals.
Pulses.
Olive oil.
Hops.
Malt.
Dried fruits.
Tea.
Sago.
Salt.
Sugar.
Preserved meats.
Confectionery.
Oil cakes.
Pickles.
Vinegar.
Beer clarifiers.

CLASS 43.

Fermented liquors and spirits.

Such as—
Beer.
Cyder.
Wine.
Whisky.
Liqueurs.

CLASS 44.

Mineral and aerated waters, natural and artificial, including ginger-beer.

CLASS 45.

Tobacco, whether manufactured or un-manufactured.

CLASS 46.

Seeds for agricultural and horticultural purposes.

CLASS 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches, and starch, blue, and other preparations for laundry purposes.

Such as—
Washing powders.
Benzine collas.

CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

CLASS 49.

Games of all kinds and sporting articles not included in other classes.

Such as—
Billiard tables.
Roller skates.
Fishing nets and lines.
Toys.

CLASS 50.

Illustrations.

Miscellaneous, including—

Such as—

Coopers' wares.

- (1.) Goods manufactured from ivory, bone, or wood, not included in other classes.
- (2.) Goods manufactured from straw or grass, not included in other classes.
- (3.) Goods manufactured from animal and vegetable substances not included in other classes.
- (4.) Tobacco pipes.
- (5.) Umbrellas, walkingsticks, brushes, and combs.
- (6.) Furniture crean, plate powder.
- (7.) Tarpaulins, tents, rick-cloths, rope, twine.
- (8.) Buttons of all kinds, other than of precious metal or imitations thereof.
- (9.) Packing and hose of all kinds.
- (10.) Goods not included in the foregoing classes.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

PRELIMINARY.

1. All communications relating to Trade Marks, not being marks in Classes 23, 24, or 25, or Sheffield Marks, should be addressed to the Comptroller, Patent Office, Trade Marks Branch. All applications should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C. (*See also paragraphs 8 and 33.*)

2. The fees in relation to Trade Marks Registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

(a.) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(b.) The following Post Offices in London:—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

” 226, Commercial Road, E.

” 9, Blackman Street, Borough, S.E.

” Charing Cross, W.C.

” 28, Eversholt Street, Camden Town, N.W.

Post Office, 12, Parliament Street, S.W., or

(c.) The Chief Post Office of the undermentioned cities and towns :—

IN ENGLAND AND WALES.

Accrington.	Croydon.	Lichfield.	St. Helen's.
Altrincham.	Darlaston.	Lincoln.	Scarborough.
Ashton-under-Lyne.	Derby.	Liverpool.	Sedgley.
Barnsley.	Dewsbury.	Macclesfield.	Sheffield.
Barrow-in-Furness.	Doncaster.	Manchester.	Southampton.
Bath.	Dorchester.	Middlesbrough.	Stafford.
Bedford.	Driffield.	Nantwich.	Stalybridge.
Beverley.	Droitwich.	Newcastle.	Stockport.
Birkenhead.	Dudley.	Newport (Mon.).	Stoke-on-Trent.
Birmingham.	Durham.	Northallerton.	Stourbridge.
Blackburn.	Exeter.	Northampton.	Stourport.
Bolton.	Gateshead.	Nottingham.	Sunderland.
Bradford.	Goole.	Nuneaton.	Swansea.
Brighton.	Greenwich.	Oldbury.	Tamworth.
Bristol.	Guildford.	Oldham.	Truro.
Bromsgrove.	Halifax.	Pattingham.	Tunstall.
Burnley.	Hartlepool.	Plymouth.	Wakefield.
Burslem.	Huddersfield.	Pontefract.	Walsall.
Burton-on-Trent.	Hull.	Portsmouth.	Warrington.
Bury.	Ipswich.	Prescot.	Wednesbury.
Cambridge.	Keighley.	Preston.	West Bromwich.
Cardiff.	Kendal.	Reading.	Whitby.
Carlisle.	Kidderminster.	Redditch.	Widnes.
Clatham.	Knaresboro'.	Richmond (Yorks).	Wigan.
Chester.	Knutsford.	Ripon.	Wolverhampton.
Clitheroe.	Lancaster.	Rochdale.	Wolverton.
Congleton.	Leamington.	Rotherham.	Woolwich.
Coventry.	Leeds.	Rugby.	York.
Crewe.	Leicester.	Salford.	

IN SCOTLAND.

Aberdeen.	Inverness.
Dumbarton.	Lanark.
Dundee.	Leith.
Edinburgh.	Paisley.
Glasgow.	Perth.
Greenock.	Renfrew.

IN IRELAND.

Belfast.	Limerick.
Cork.	Londonderry.
Dublin.	Waterford.
Dundalk.	Wexford.
Galway.	

NOTE.—Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above list.

3. The following is a list of the stamped forms under the Patents, Designs, and Trade Marks Acts, 1883—1888, which relate to Trade Marks, and which may be obtained at the places mentioned above :—

TRADE MARKS.

Letter.	Title of Form.	Fee.
		£ s. d.
E	Application for Hearing by Comptroller	1 0 0
F	Application for Registration of Trade Mark	0 5 0
G	Additional Representation Form	No stamp.
H	Appeal to Board of Trade from decision of Comptroller	1 0 0
I	Registration Fee	1 0 0
J	Notice of Opposition to Application for Registration	1 0 0
K	Request to enter Name of Subsequent Proprietor, with Declaration in support thereof	1 0 0
L	Request for Certificate of Refusal to Register a Trade Mark	1 0

TRADE MARKS—*continued*.

Letter.	Title of Form.	Fee.
		£ s. d.
M	Notice of Application for Alteration of Address	0 5 0
N	Notice of Order of Court for Alteration or Rectification of Register	0 10 0
O	Application to Cancel Entry of Mark on Register	0 5 0
Q	Request for Correction of Clerical Error or for Amendment of Application under Section 91	0 5 0
R	Request for Certificate of Registration for use Abroad	0 5 0
S	Request for Certificate of Registration for use in Legal Proceedings	1 0 0
T	Application for Settlement of a Special Case	2 0 0
T ¹	Request for General Certificate of Comptroller	0 5 0
V	Request for Copy of Official Notification	0 2 0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1 0 0
X	Fee for Continuance of Trade Mark at expiration of fourteen years	1 0 0
Y	Additional Fee where fee is paid within three months after expiration of fourteen years	0 10 0
Z	Additional Fee for Restoration of Trade Mark where removed for non-payment of fee	1 0 0

Of the above forms, those bearing the letters F, G, and I, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

SALE OF OFFICIAL PUBLICATIONS.

4. The Patents, Designs, and Trade Marks Acts, 1883—1888, and the Trade Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C. The price of the Acts and Rules together is 2s. 6d., postage, 2d.; of the Acts alone, 2s., postage, 1½d.; and, of the Rules alone, 6d., postage, 1d. Sums exceeding 1s. should be remitted by Postal Order or Post Office Order.

5. Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C.

The price of the *Trade Marks Journal* is :—

Nos. 1 to 509 (Years 1876 to 1887). 1s. per number.

Nos. 510 to 561 (Year 1888) 1s. 6d. „

No. 562 and following Nos. from 1 January, 1889, 6d. „

DEFINITION OF A TRADE MARK.

6. The definition of a Trade Mark is given in the 64th section of the Acts, as follows :—

“(1.) For the purposes of this Act, a Trade Mark must consist of or contain at least one of the following essential particulars :

(a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a Trade Mark; or

- (c.) A distinctive device, mark, brand, heading, label, or ticket ;
or
 - (d.) An invented word or invented words ; or
 - (e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.
- (2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.
- (3.) Provided as follows :—
- (i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :
 - (ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a Trade Mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a Trade Mark under this part of this Act."

SEARCHES.

7. A person wishing to adopt a Trade Mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application at the Trade Marks Branch of the Patent Office with the view of ascertaining whether his proposed Mark is already registered, or whether, from its being calculated to deceive by a resemblance to other Marks already on record, it would be refused registration under the 72nd section of the Acts.

The fee payable by a person making a search amongst the classified representations of Trade Marks is 1s. for each quarter of an hour. The fee for a formal application is 5s. See paragraphs 9 and 3 of these Instructions as to the mode of making formal application.

The Comptroller does not undertake to make searches amongst the Trade Marks recorded at his office, *except in connexion with formal application for registration.*

APPLICATIONS FOR REGISTRATION.

8. Applications sent by post should be addressed—

The Comptroller,
The Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

In the case of Marks claimed in Classes 23, 24, or 25, applications should be addressed—

The Comptroller,
Manchester Trade Marks Branch,
48, Royal Exchange,
Manchester.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a Trade Mark consists of :—

(a.) An Application Form (Form *F'*) bearing an impressed stamp of 5s. (*see* paragraph 3).

(The applicant should, before filling up the form, carefully read the marginal notes.)

(b.) Certain Additional Representations of the Trade Mark, mounted on Forms (Form *G'*) (*see* paragraphs 3 and 15).

10. A *separate* Application Form is required for *each* class in cases where the same Trade Mark is claimed in more than one class of goods.

11. If the Mark be the property of a firm, the Form *F'* should be signed by a member of the firm, who should add, after his signature, "A Member of the firm ;" if of a Company, by the Secretary or other principal officer, who should add, after his signature and designation, "For the Company."

12. Applications may be made by agents in the names of and on behalf of the owners of Trade Marks. The agent must be duly authorised by the owner or owners ; the necessary authority should be signed by the owner or owners.

Applications made by agents should have, after the name of the agent, the description "Agent."

13. When an applicant for the registration of a Trade Mark, otherwise than under an International Convention, is out of the United Kingdom at the time of making the application, he must give the Comptroller an address for service in the United Kingdom.

14. When the Mark consists of or includes words printed in other than Roman characters, there should be given upon the Forms a translation of such words, signed by the applicant or his agent.

In the case of Marks claimed in Classes 23, 24, or 25, the Applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

ADDITIONAL REPRESENTATION OF MARK.

15. Each of the additional representations should be placed in the centre of a separate Form *G*.

In the case of a Trade Mark which is not claimed in Classes 23 to 35, *two* Additional Representations are required for *each* class claimed.

In the case of a Trade Mark claimed in any one or more of the Classes 23 to 25, *four* Additional Representations should be sent for *each* of such classes. In the case of a Trade Mark claimed in any one or more of the Classes 26 to 35, *three* Additional Representations should be sent for each of such classes.

The representations of the Mark on the Forms *G* must agree *in every respect* with each other, and with that on the Form *F*.

16. Representations of a Mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

SERIES OF TRADE MARKS.

17. By Section 66 of the Acts, the Comptroller is empowered to register under one registration a series of Trade Marks which, whilst they resemble each other in the material particulars, differ from each other in respect of the statements of the goods for which they are used, of the statements of numbers, of the statements of price, of the statements of quality, or of the statements of names of places. When an application is made for such a series, a representation of *each* of the marks included in the series must be affixed to the Form *F*, and also to each of the Forms *G*.

COMMON OR OPEN MARKS.

18. In the case of a Trade Mark used before the 13th August, 1875, Common or Open Marks of any kind may be registered in connection with it, but in the case of a Trade Mark not so used, Common or Open Marks consisting of *a word or combination of words only* can be registered as a part of the Mark.

In each case, the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the Application Form, such note to be signed by the applicant or his agent.

See Section 74 of the Acts, sub-section 3, for definition of Common Marks.

CLASSIFICATION OF GOODS.

19. A Guide to the Classification of Goods under the Trade Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the Applicant feels any difficulty in determining to which of the Classes set out in the Third Schedule to the Rules the goods for which he uses his Mark belong.

ADVERTISEMENT IN THE TRADE MARKS JOURNAL.

20. A Trade Mark cannot in any case be entered upon the Register until one month after its advertisement in the Official Paper.

21. A Wood-block or Electrotpe must be furnished for each Mark in each Class claimed, except in the case of Class 23A (Cotton Yarn and Sewing Cotton, not on spools or reels), and Classes 24 and 25, for which no Blocks or Electrotypes are required.

A Wood-block or Electrotpe will be required for an application in Class 23 whenever it is in respect of, or covers, Sewing Cotton on spools or reels.

No block or Electrotpe should be forwarded until a formal demand for it is sent by the Comptroller.

22. In the case of a series of Trade Marks differing only in respect of the particulars mentioned in Section 66 of the Acts, a Wood-block or Electrotpe must be furnished for each Mark in the series, for each class claimed.

23. The Wood-blocks or Electrotypes furnished must correspond *exactly* with the Representations, must afford *perfectly distinct* impressions of the Marks, and must be upon a scale sufficiently large to repro-

duce the Marks faithfully. Worn or mutilated Blocks or Electrotypes cannot be accepted.

24. The largest space available for the insertion of any single Block or Electrotpe is five and a half inches broad by seven and a half inches deep.

When a Block or Electrotpe *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The number given by the Comptroller should *not* be cut on the face of the Block or Electrotpe, but should be *marked upon the side* in such a manner as to secure its identification.

26. All Blocks or Electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form 2," and with the representation of the Mark sent for the guidance of the Applicant in preparing the Block or Electrotpe.

27. The Blocks or Electrotypes supplied for the advertisement of Trade Marks cannot in any case be returned to Applicants.

RESTRICTIONS ON REGISTRATION.

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a Mark unless such groundwork be included within the Mark by some border or lines.

29. The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," will not be registered under the Acts, and should not, therefore, appear upon the Representations of Trade Marks forming part of an application.

30. The following will not be registered as Trade Marks, or as prominent parts of Trade Marks, unless the Marks have been used before 13th August, 1875:—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain.

31. When there appears on the face of a Trade Mark an indication of the goods to which the Mark is applied, the claim for its registration must be in respect of *those goods only*.

OPPOSITIONS.

32. Notice of Opposition to the Registration of a Trade Mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the Mark in the *Trade Marks Journal*.

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the Mark in the *Trade Marks Journal*, and a copy forthwith sent to the applicant.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence, and a copy forthwith sent to the opponent.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence, and a copy forthwith sent to the applicant.

On the completion of the evidence, either party may apply (upon Form *E*) for the case to be heard by the Comptroller.

FORM OF COUNTER-STATEMENT.

The following is a form of Counter-statement :—

Patents, Designs, and Trade Marks Acts, 1883—1888.

Trade Marks.

In the Matter of an Application No.

and of the Opposition thereto No. .

In reply to the Notice of Opposition in this matter by , of
 , I give notice by way of Counter-statement that I rely
 for my Application on the following grounds :—

(To be dated and signed by the *Applicant* or his *Solicitor*.)

To the Comptroller,

Patent Office, Trade Marks Branch,

25, Southampton Buildings, London.

CUTLERS' COMPANY.

33. By Section 81 of the Acts application for the registration of Trade Marks used on metal goods shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company. See Rules 56 to 59.

Applications made to the Cutlers' Company in pursuance of Section 81 of the Acts should be made on Form *F*, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. See Rule 56.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,

The Cutlers' Hall,

Sheffield.

MANCHESTER OFFICE.

34. For the convenience of merchants and manufacturers engaged in the Cotton Trade, and for the purpose of facilitating the recording of Trade Marks used in respect of Cotton Goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1s. for each quarter of an hour, for Marks in classes of Textiles from Class 23 to Class 35.

CERTIFICATES.

35. The Comptroller's Certificate in relation to a Trade Mark is of four kinds, viz. :—

- (i.) For use in legal proceedings.
- (ii.) For use in applying for registration in Foreign Countries.
- (iii.) Of any application made and of proceedings thereon.
- (iv.) A certificate of refusal of a Mark in use before 13th August, 1875, and not registerable.

36. A person desirous of obtaining any of the above Certificates should forward Form *S*, Form *R*, Form *T*¹, or Form *L* (*see* paragraph 3), as the case may be, to the Comptroller, giving the Comptroller's official number of the Mark, and stating whether the Certificate is required for use in legal proceedings, or for use in applying for the registration of the Mark in a Foreign Country, or for what other purpose.

37. In every case where a certificate is required in respect of a Cotton Mark, or in respect of any Trade Mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the Mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the Comptroller.

REGISTRATION OF SUBSEQUENT PROPRIETORS OF REGISTERED
TRADE MARKS.

38. The Request and Declaration to be made by a subsequent Proprietor on application for the registration in his name of a registered Trade Mark must be made on Form *K* (*see* paragraph 3).

H. READER LACK,
Comptroller.

July, 1890.

TRADE MARKS RULES (REPEALED)

REFERRED TO IN THE ABSTRACT.

TRADE MARKS RULES, 1876.

ADVERTISEMENT OF APPLICATION.

12. As soon as may be after the receipt of an application made as provided by these Rules, the Registrar shall require the applicant to insert an advertisement of the application in the official paper, during such time, and in such form, and generally in such manner as the Registrar may think desirable, and distinguishing whether the mark has or has not been used before the thirteenth day of August one thousand eight hundred and seventy-five.

Advertise-
ment of
applica-
tion.

See p. 222, *supra*.

NOTICE OF OPPOSITION.

Notice and
proceed-
ings for
opposition.

16. A notice of opposition may be given by sending to the Registrar, together with the prescribed fee, a written notice in duplicate, on foolscap paper of such size as aforesaid, stating the grounds of the opposition. The Registrar shall acknowledge the receipt of such notice of opposition, and shall send one copy of such notice to the Applicant.

Within three weeks after the receipt of such notice, or such further time as the Registrar may allow, the Applicant may send to the Registrar, on foolscap paper of such size as aforesaid, a counter statement of the grounds on which he relies for his application, and, if he does not do so, shall be deemed to have withdrawn his application.

If the Applicant sends such counter-statement, the Registrar shall require the person who gave notice of opposition to give security, in such manner and to such amount as the Registrar may require, for such costs as may be awarded in respect of such opposition, and if such security is not given within fourteen days after such requirement was made, or such further time as the Registrar may allow, the opposition shall be deemed to be withdrawn.

If the person who gave notice of opposition duly gives such security as aforesaid, the Registrar shall send him one copy of the counter statement sent by the Applicant, and thereupon the case shall be deemed to stand for the determination of the Court.

See p. 81, *supra*.

REGISTRATION OF TRADE MARKS.

Prohibition of
registration of
identical
trade
marks.

18. Where a trade mark has been already registered in respect of any goods or description of goods belonging to one particular class, a trade mark identical with such trade mark, or so nearly resembling the same as to be calculated to deceive, shall not, without leave of the Court, be registered in the name of another person as proprietor thereof with respect to any goods in that class.

See p. 216, *supra*.

Similar
trade
mark for
similar
goods not
to be regis-
tered in
two
classes.

19. Where goods may be considered as belonging to two or more classes, and the trade mark has been already registered in respect of such goods as belonging to one particular class, a trade mark identical with such trade mark, or so nearly resembling the same as to be calculated to deceive, shall not, without leave of the Court, be registered in the name of another person as proprietor thereof with respect to the same or similar goods as belonging to another class.

See pp. 149, 249, *supra*.

APPLICATION TO THE COURT.

Definition
of Court.

42. The Court for the purposes of this Act is hereby declared to be the Chancery Division of Her Majesty's High Court of Justice.

See p. 249, *supra*.

COTTON GOODS.*

57. For the purpose of facilitating the granting of trade marks in respect of cotton goods in (a) Classes 23, 24, and 25, there shall be established by the Commissioners of Patents, and subject to their control, an Office at Manchester for the exhibition of all devices, marks, headings, labels, tickets, letters, words, or figures, or combinations of letters, words, or figures used in the cotton trade, and in these Rules included under the expression "cotton marks."

(a) Class 23 contained "cotton yarn and thread."

Class 24 contained "cotton piece goods of all kinds."

Class 25 contained cotton goods not included in Classes 23, 24, or 38.

Class 38 contained articles of clothing, such as hats, caps and bonnets, hosiery, gloves, boots and shoes, and other ready made clothing.

Establishment of office for exhibition of cotton trade marks at Manchester.

58. Every person who at the date of the passing of the Act used any cotton mark shall, if resident in the United Kingdom, on or before the first day of January, one thousand eight hundred and seventy-seven, and if resident elsewhere, on or before the first day of March, one thousand eight hundred and seventy-seven, send to the Manchester Office three representations of such cotton mark, in such form and with such a description as may be from time to time required by the (b) Commissioners of Patents.

(b) Previous to 1st Jan. 1884, the registration of trade marks was under the control of the Commissioners of Patents, now no longer in existence.

Representations of cotton marks to be sent by owners resident in the United Kingdom on or before Jan. 1, 1877; by owners resident abroad on or before March 1, 1877.

58A (c). Every person who at the date of the passing of the Trade Marks Registration Act, 1875, used any "combination stamp" for cotton piece goods, shall on or before the first day of February, one thousand eight hundred and seventy-nine, send to the Manchester Branch of the Trade Marks Registry Office, four representations of such "combination stamp," in such form and with such a description as may be from time to time required by the Commissioners of Patents.

(c) This rule was made on Dec. 28th, 1878.

Extended time for sending representations of combination stamp for cotton piece goods. Committee of experts to be appointed, and to divide cotton marks into two classes. Committee to form list of marks sent in to Manchester office.

59. A committee of persons versed in the usages of the cotton trade shall be appointed by the Commissioners of Patents, consisting of such number of persons as may from time to time be determined by them; and it shall be the duty of such committee, on or before a time to be named by the Commissioners of Patents, to divide the cotton marks, representations of which have been sent into the Manchester Office, into two Classes, the first class consisting of such of the said cotton marks as are, in the opinion of the Committee, trade marks within the meaning of the Act, and the second class consisting of such of the said cotton marks as are not, in the opinion of the committee, trade marks within the meaning of the Act.

60. The said Committee shall form a (d) list of the cotton marks sent in to the Manchester Office in each of the aforesaid classes, and shall transmit such lists to the Commissioners of Patents, accompanied by two representations of each of the marks specified in the second class in such list.

The third representation of each of the marks in the second class in such list shall be retained for reference in the Manchester Office.

(d) *I.e.*, the A. list and the B. list.

* See pp. 82, 254, 295, 323, *supra*.

Marks
may be
added to
list.

61. The Commissioners of Patents may from time to time add to the aforesaid list any cotton marks as they may think just, and such addition shall be deemed to be part of the original list.

Any per-
son claim-
ing to be
the pro-
prietor of
a cotton
mark in
Class 1
may apply
to be regis-
tered.

Advertise-
ment of
cotton
marks.

62. Any proprietor of a cotton mark not specified in the second class in such list may apply to be registered as proprietor of such cotton mark in manner and subject to the conditions in which he may apply to be registered as proprietor of any trade mark, but it is not to be lawful for the Registrar to register any person as proprietor of any cotton mark in the second class of the aforesaid list except in pursuance of an order of the Court.

62A (e). As soon as may be after the receipt of an application, made as provided by the Trade Marks Rules, for the registration of a mark in Classes 23, 24, 25 aforesaid, or in any one or more of such classes, the Registrar shall insert in the official paper an advertisement of such application, shewing the name and address of the Applicant, the class in which he applies, the number given to the mark by the Registrar, the places in London and Manchester respectively where a specimen of such work is deposited for exhibition, and distinguishing whether the mark has or has not been used prior to the thirteenth day of August, one thousand eight hundred and seventy-five.

(e) This and Rule 62b were made on 26th Feb. 1877.

Time of
registra-
tion of
cotton
marks.

62B. On the expiration of three weeks from the date of the first appearance of the advertisement of a mark in Classes 23, 24, 25, or in any one or more of such classes, in the official paper, the Registrar may, if he is satisfied that the applicant is entitled to registration, register such mark in respect of the description of goods for which he may be entitled to be registered, and the applicant as the proprietor thereof, on payment of the prescribed fee.

Cotton
mark not
to be regis-
tered ex-
cept in
manner
herein
prescribed.

63. A cotton mark shall not be registered except in manner and subject to the conditions prescribed by these Rules with respect to the registry of cotton marks.

Applica-
tions for
registra-
tion of
new trade
marks for
cotton
goods
(Classes
23, 24, and
25) to be
made in
the same
manner as
for all
other
classes of
goods.

63A (f). The Rules numbered 57 to 63 as aforesaid do not apply to such trade marks in respect of cotton goods in Classes 23, 24, and 25 as are not cotton marks which were in use at the date of the passing of the Trade Marks Registration Act, 1875 ; and applications for the registration of trade marks in respect of goods in Classes 23, 24, and 25, and which marks were not cotton marks in use at the date of the passing of the Trade Marks Registration Act, 1875, shall be made in manner and subject to the conditions in and subject to which applications for trade marks other than cotton marks may be made in conformity with the Rules in that behalf for the time being in force.

Provided that where application is made for the registration as a trade mark in respect of any goods in Classes 23, 24, or 25 of any mark being a cotton mark contained in the second class of the list mentioned in Rule 59 aforesaid, such registration shall not take place except in pursuance of an Order of the Court.

(f) This rule was made on 21st Oct. 1879.

TRADE MARKS RULES, 1883.

REGISTER OF TRADE MARKS.

32. Upon registering any trade mark the Comptroller shall enter in the register the date on which the application for registration was received by the Comptroller (which day shall be deemed to be the date of registration), and such other particulars as he may think necessary.

Entries to be made in register.

See p. 191, *supra*.

COTTON MARKS.

57. [This Rule is identical with T. M. R. 1876, Rule 57, *supra*, p. 391.]

Establishment of office for exhibition of cotton marks at Manchester.

58. The Commissioners of Patents may from time to time add to the first and second class lists of cotton marks formed by the late Manchester Committee of Experts any cotton marks as they may think just, and such addition shall be deemed to be part of the original lists.

Marks may be added to the first and second class lists of cotton marks.

59. Any proprietor of a cotton mark in the first class may apply to be registered as proprietor of such cotton mark in manner and subject to the conditions in which he may apply to be registered as proprietor of any other trade mark, but it shall not be lawful for the Registrar to register any person as proprietor of any cotton mark in the second class aforesaid, except in pursuance of an order of the Court.

Any person claiming to be the proprietor of a cotton mark in the first class may apply to be registered.

60. [This Rule is identical with T. M. R. 1876, Rule 62A, *supra*, p. 392.]

Advertisement of cotton marks.

61. [This Rule is identical with T. M. R. 1876, Rule 62B, *supra*, p. 392.]

Time of registration of cotton marks.

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